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TRANSCRIPT OF RECORD

Supreme Court of the United States

OCTOBER TERM, 1942

No. 327

FRED FISHER MUSIC CO., INC., AND GEORGE
GRAFF, JR., PETITIONERS,

vs.

M. WITMARK & SONS

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT
OF APPEALS FOR THE SECOND CIRCUIT

PETITION FOR CERTIORARI FILED AUGUST 21, 1942.

CERTIORARI GRANTED OCTOBER 12, 1942.

SUPREME COURT OF THE UNITED STATES

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[fol. 1]

**IN DISTRICT COURT OF THE UNITED STATES FOR
THE SOUTHERN DISTRICT OF NEW YORK**

M. WITMARK & SONS, Plaintiff-Appellee,

against

FRED FISHER MUSIC CO. INC., GEORGE GRAFF, JR., Defendants-Appellants,

and

MILLS MUSIC, INC., Defendant

STATEMENT UNDER RULE 13, SUBDIVISION 4

This action was commenced on the 18th day of October, 1940.

The names of the parties are stated above; and there has been no change of parties.

The complaint was filed in the office of the Clerk of the United States District Court for the Southern District of New York on October 18th, 1940.

The defendants were not arrested, no bail was taken, and no property attached or arrested.

The interlocutory decree against the defendants Fred Fisher Music Co. Inc. and George Graff, Jr. was made by Hon. Edward A. Conger, and entered on May 26, 1941. No question was referred to any commissioner, master or referee.

The defendants Fred Fisher Music Co. Inc. and George Graff, Jr. filed their notice of appeal on June 24th, 1941.

The defendant Mills Music Inc. was not affected by the interlocutory decree and did not file a notice of appeal therefrom.

[fol. 2] **IN DISTRICT COURT OF THE UNITED STATES**

{Title omitted}

NOTICE OF MOTION FOR INJUNCTION—Oct. 18, 1940

Sms:

Please take notice that upon the annexed affidavit of Herman Starr duly sworn to the 18th day of October, 1940, and

upon the summons and complaint herein, and the exhibits thereto annexed, the undersigned will move this court at a Motion Term thereof to be held at the United States Courthouse, Foley Square, Borough of Manhattan, City of New York, in Room 506 thereof, on the 29th day of October, 1940, at 10:30 o'clock in the forenoon, or as soon thereafter as counsel can be heard, for an order enjoining and restraining pendente lite defendant, Fred Fisher Music Co., Inc., its officers, employees, agents and servants, and defendant, George Graff, Jr., his agents and servants from printing, publishing, copying, vending or making any use whatsoever of the song entitled "When Irish Eyes Are Smiling", and from making any claim that they have any rights in this song, and for such other and further relief as to the Court may seem just and proper in the premises.

[fol. 3] Dated, New York, October 18th, 1940.

Yours, etc., R. W. Perkins, Attorney for Plaintiff,
Office & P. O. Address, 321 West 44th Street, Borough of Manhattan, City of New York.

To: George Graff, Jr. Fred Fisher Music Co. Inc.

[fol. 4] IN DISTRICT COURT OF THE UNITED STATES

[Title omitted]

AFFIDAVIT OF HERMAN STARR, IN SUPPORT OF MOTION

STATE OF NEW YORK,

County of New York, ss.:

HERMAN STARR, being duly sworn, deposes and says: I am the President of M. Witmark & Sons, the plaintiff in the above entitled action.

This affidavit is in support of plaintiff's motion for an injunction pendente lite restraining defendants, Fred Fisher Music Co., Inc. and George Graff, Jr. from printing, publishing, copying or vending, and from making any use whatsoever of the song entitled "When Irish Eyes Are Smiling". No preliminary relief is being requested against defendant, Mills Music Inc., because it has not threatened any immediate publication of the song.

This motion is made simultaneously with the commencement of this action by the service of a summons and complaint and these motion papers.

[fol. 5] I beg leave to refer to the complaint and exhibits thereto annexed, which are also annexed to this affidavit, and desire to incorporate the contents of the same into this affidavit with the same force and effect as if all of the allegations therein recited were repeated in this affidavit.

Plaintiff, M. Witmark & Sons is engaged in the business of publishing musical compositions. It is one of the oldest companies in the music publishing field, having started in business as early as 1885. It has built up a very large repertory of many of the world's most famous secular and sacred ballads and is probably unequalled in this field of musical compositions.

The song which is the subject of this litigation is entitled "When Irish Eyes Are Smiling". It is one of the most celebrated ballads of our times, being known probably in every household in America. I shall refer to it hereafter as the "song".

The song was written in 1912, being the joint composition of Ernest Ball, who wrote the music, and George Graff, Jr. and Chauncey Oleott, who wrote the lyrics. Ball and Graff at that time were under a general contract to Witmark.

Ball's general agreement with Witmark is dated January 2, 1908, and under it he agreed to deliver to Witmark all musical compositions which he would write, either alone or in conjunction with others, during the five (5) year period commencing January 2, 1908, and he agreed that upon the song being written, it would become the "sole and absolute property" of Witmark and he granted to Witmark "the copyright or copyrights of, with renewals and with right to copyright and renew, and property," in all the musical compositions which he would write within that five (5) year period. In consideration, Witmark agreed to pay Ball certain royalties. This agreement is annexed to the complaint as Exhibit "A".

[fol. 6] The Graff general contract with Witmark is dated July 1, 1910, and under it he also agreed to deliver to Witmark all musical compositions which he, alone or in conjunctions with others, would write during the five (5) year period commencing July 1, 1910, and he covenanted and agreed that the musical compositions which he wrote during that period would become the "sole and absolute property" of Witmark, and he granted to Witmark "the copyright or copyrights of, with renewals and with right to copyright and renew, and property" in all the musical compositions

which he would write during the ensuing five (5) year period. Witmark in turn agreed to pay Graff royalties of 2c for each copy sold of any standard number of which Graff wrote the words. (A copy of the agreement between Graff and Witmark is annexed to the complaint as Exhibit "B").

The song was written in the year 1912, prior to August 12th of that year and obviously is covered in the aforesaid general contracts of Graff and Ball. Olcott was not at the time under general contract to Witmark but he made an oral grant of his rights to Witmark which he confirmed by written agreement of January 17, 1913, which is annexed to this affidavit as Exhibit "1".

After the song was jointly written by Messrs. Ball, Graff and Olcott, it was delivered to Witmark which, on August 12, 1912 copyrighted it in its name. Witmark then launched its publication of the song and, as stated above, it became a great success. Royalties were paid to the writers pursuant to their separate agreements with Witmark. Nothing further happened until about five (5) years after the work was copyrighted.

Then, on May 19, 1917, for the sum of One Thousand Six Hundred (\$1,600.00) Dollars, Graff released Witmark from any further obligation to pay royalties for this song and [fol. 7] certain other songs, and in the same instrument for the same consideration, he sold, assigned, transferred and delivered to Witmark the song "When Irish Eyes Are Smiling", "to have and to hold the same absolutely unto the said publisher (Witmark) * * * together with all rights therein for all countries * * * and all copyrights and renewals of copyright and the right to secure all copyrights and renewals of copyrights * * *, and any and all rights therein that I or my heirs, executors, administrators or next of kin, may at any time be entitled." Mr. Graff further agreed "and I do, for myself, my heirs, executors, administrators and next of kin, hereby irrevocably authorize and appoint the publisher, its successor, successors and assigns, my attorneys and representatives, *in my name* or in the names of my heirs, executors, administrators and next of kin, or in its own names, to take and do such actions, deeds and things, and make, sign, execute and acknowledge all such documents, as may from time to time be necessary to secure to the publisher (Witmark), its successor, successors and assigns, the renewals and extensions of the

copyrights in said compositions and of rights therein for the term of such renewals and extensions" (italics ours)

It is scarcely conceivable that any clearer language could be used to express Mr. Graff's intent to vest the renewal rights in the song in Witmark.

On November 21, 1935, the aforesaid instrument of May 19, 1917 was recorded in the copyright office.

August 12, 1939 ushered in the beginning of the 28th year of the original copyright, and with it the beginning of the yearly period within which the renewal could be secured. Mr. Graff was the only survivor of the writers of this song. Both Mr. Ball and Mr. Olcott had previously passed away, each survived by his respective widow. Thereupon Wit-[fol. 8] mark, on August 12, 1939, acting upon the authority of Mr. Graff contained in the said instrument of May 19, 1917, as well as upon authority from Mrs. Olcott, made an application in the name of Mr. Graff and Mrs. Olcott for the registration of the renewal copyright, and the renewal copyright was thus registered in the name of Mr. Graff and Mrs. Olcott on that day. The same day, further acting under the authority of the May 19, 1917, instrument, Witmark acting in the name of Mr. Graff, assigned his renewal copyright to itself, and this assignment was recorded on August 14, 1939, in the office of the Register of Copyrights. It is annexed to the complaint as Exhibit "F". Mrs. Olcott for fixed royalties also assigned her renewal interest to Witmark on August 29, 1939 and that assignment was recorded in the copyright office on August 29, 1939. It is annexed to the complaint as Exhibit "G".

For more than twenty (20) years after the instrument of May 19, 1917 was executed, Graff did and said nothing in repudiation thereof. Then on August 23, 1939, Graff purported to obtain a renewal copyright in the song in his own name although, if he had examined the records of the Copyright Office, he would have ascertained that eleven (11) days earlier, Witmark had taken out the renewal in his name and Mrs. Olcott's and had assigned the renewal to itself. Finally, on October 24, 1939, being two months later, he executed a document to defendant, Fred Fisher Music Co., Inc. (hereinafter referred to as Fisher) which is annexed to the complaint as Exhibit "I" in which he purports for \$1.00 and other good and valuable consideration to sell his renewal copyright in the song to Fisher. And

this he did in brazen violation of his agreements with Witmark of July 1, 1910 and May 19, 1917, in both of which in the clearest of language, he vested his renewal rights in [fol. 9] Witmark. The conduct of Fisher is equally reprehensible. Fisher must be charged with notice of the prior renewal registration of August 12, 1939 and the prior recorded assignment of that renewal to Witmark of the same date. It must also be charged with knowledge of the recorded instrument of May 19, 1917. There can be no question but that Graff and Fisher acted with the utmost bad faith in their transaction and with full knowledge of Witmark's prior and superior rights.

On August 13, 1940, Fisher wrote to Witmark (a copy of the letter being annexed to this affidavit marked Exhibit "2") claiming that it was the owner of the George Graff renewal rights in the song and asking Witmark to remove the song from its catalogue. On August 26, 1940, Witmark answered Fisher notifying it that Fisher was not the owner of Graff's renewal rights, and calling upon Fisher to remove the song from its catalogue, to cease and desist from publishing the same and to retract publicly any claim made by it to the effect that it had the right to publish the song. That letter is annexed to this affidavit marked Exhibit "3". On September 5, 1940, Fisher replied to Witmark (a copy of which reply is annexed hereto and marked Exhibit "4"), wherein among other things it advised that it was publishing and would continue to publish the song. A copy of said Fisher's infringing song is annexed to the complaint and marked Exhibit "M."

During all of this period, Fisher has sent letters to the trade claiming ownership of the renewal copyright in the song. Annexed hereto and marked Exhibit "5" is a photostatic copy of such a letter which Fisher wrote to Lyon & Healy Inc. of Chicago, a jobber of sheet music, which sells sheet music to retailers. Lyon & Healy Inc. forwarded this letter to Witmark inquiring as to the validity of Fisher's [fol. 10] claim. Obviously because of Fisher's claim, Lyon & Healy Inc. which has always been a customer of Witmark in purchasing sheet music of this song, is now placed in a position of not knowing with whom to deal for the song. Annexed hereto and marked Exhibit "6" is a letter received by Witmark from the American Society of Composers, Authors and Publishers, advising Witmark of a letter received

by the Society from Fisher in which Fisher makes the same claim. The Society is an organization composed of writers and publishers (of which Graff and Witmark are members), which is engaged in the business of licensing radio companies, hotels, night clubs and other users of music to perform publicly for profit, the musical compositions of its members. Its revenues, which run into the millions, are divided among its members, and in the division of its revenue, the uses of each song over the air constitute a factor. Last year alone there were 6,335 radio uses of the song, "When Irish Eyes Are Smiling." Fisher now seeks to have the Society credit such uses to Fisher. Thus the Society also is in a position as a result of Fisher's claim, of not knowing to whom to credit the uses of this song. Deponent has been informed and verily believes that similar claims have been made by Fisher to manufacturers of phonograph records and other users of music.

It is apparent that Fisher's claim is a definite cloud upon plaintiff's title to the renewal rights, and Fisher's conduct in advising the trade that it owns the renewal copyright in this song has created considerable confusion among the customers of Witmark which must result, unless a preliminary injunction is granted, in the curtailment if not stoppage in the use of this song. And unless Fisher is immediately stopped by the granting of a preliminary injunction, plaintiff will suffer substantial monetary damage by [fol. 11] reason of Fisher's interference with plaintiff's ability to exploit fully the various rights it has in the song, which include not only the publication rights, but also the right to license it for use on phonograph records, electrical transcriptions for radio broadcasting, use in motion pictures, and use over the radio. The reputation of Witmark as publisher of the world's most famous ballads including the song in question, is being jeopardized by Fisher's claim of right to publish this song. Moreover, we are informed and believe that Fisher's financial position is such that it cannot satisfy a judgment for the amount of damages that it has caused and will cause defendant by virtue of its conduct.

Deponent submits that irreparable injury is being done to this plaintiff and deponent, therefore, respectfully prays that a preliminary injunction issue enjoining defendants Graff and Fisher from printing, publishing, copying or

vending the song, and from making any use thereof whatsoever, and from making any claim that it has any rights in this song.

Herman Starr.

Sworn to before me this 18th day of October, 1940.
Joseph J. McLaughlin, N. Y. County, No. 247.
Commission expires March 30, 1941.

• [fol. 12] EXHIBIT "1," TO AFFIDAVIT OF HERMAN STARR

Duplicate

WORDS & MUSIC

Executive Offices of M. Witmark & Sons, Publishers, Witmark Building, New York

In Consideration of the sum of One Dollar to me in hand paid by M. Witmark & Sons and the further payment by it to me of Three Cents (3c) upon each and every copy of said musical composition for Voice & Piano, hereafter sold by it, (no royalties, however, to be paid on copies sold as new issues, nor upon any arrangements, except as above specified), except such copies as are sold in foreign countries, upon which half royalties shall be paid,* I do hereby sell, assign, set over and transfer to and unto the said M. Witmark & Sons, its successors and assigns, a certain song, words, music and musical composition, bearing the title

1. "When Irish Eyes Are Smiling"
2. "Kathleen Aroon"
3. "Isle O'Dreams"

and the copyright of the same, the right to take out a copyright, also renewal of copyright, for or upon the same, and each and every part thereof, including the title thereof, in its own name as owner and proprietor of said song, words, music and musical composition, to the same full extent in [fol. 13] all respects as I might, could, would or should do, or be able to do, had this present instrument not been made, together with all mechanical reproducing rights in said composition, for which rights M. Witmark & Sons agree to collect and pay me, and all persons jointly interested with me

in said composition, one-half of all sums realized by it from said rights, and I do hereby for myself and heirs, executors, administrators covenant to and with the said M. Witmark & Sons, its successors and assigns, that I have not sold, assigned, set-over, transferred, hypothecated or mortgaged said song, words, music or musical composition, or any interest therein, nor in the copyright thereof, and that there is not now and has not been any contract existing between me and any other person, firm or corporation whomsoever, affecting any rights, title, or interest in said song, words, music or musical composition or in or to the copyright thereof, and I do hereby certify that it is upon the faith of these representations, that the said M. Witmark & Sons has purchased said song, words, music and musical composition from me and has agreed to copyright and publish the same.

Settlements under this contract shall be made on the 15th day of January and July in each year during the existence of said copyright:

And the said M. Witmark & Sons hereby covenants and agrees to pay the royalties aforesaid, to Chauncey Olcott upon the faith of the representations herein made.

Should M. Witmark & Sons desire to publish the aforesaid composition in a collection of music in book or album form, they may do so without the payment of any royalty on said books.

[fol. 14] In witness whereof the parties hereto have executed this agreement in duplicate at New York in the State of New York this Seventeenth day of January, 1913.

* On copies sold at less than regular rates, it is understood and agreed that half royalty is to be paid.

M. Witmark & Sons, Julius P. Witmark, Sec'y;
Chauncey Olcott.

STATE OF —

County of —, ss.:

On this — day of —, 19— before me came and appeared personally — to me known to be one of the persons mentioned and described in the foregoing instrument, and who executed the same, and he duly acknowledged to me

that he executed the same for the uses, intents and purposes, therein mentioned.

N. B.—“New Issues” are sample copies sent to the trade at five cents (which just about covers the cost of production, etc.) and are filed by the dealer for record. No number is ever sent out in “new issues” more than once, and not more than one thousand copies are ever, under any circumstances, sent in this way by us.

[fol. 15] EXHIBIT “2,” TO AFFIDAVIT OF HERMAN STARR

Phone: Columbus 5-1976.

Fred Fisher Music Co., Inc.

Music Publishers

1619 Broadway, New York City

August 13, 1940.

Music Publishers Holding Co., 1250 Sixth Avenue, New York, N. Y.

GENTLEMEN:

This is to advise you that we are the owners of the George Graff renewal rights to the musical composition entitled:

When Irish Eyes Are Smiling

As you know, the original copyright on the aforementioned composition has expired and we are the assignees of the renewal copyright on said composition.

Will you please remove this composition from your catalog.

Very truly yours, Fred Fisher Music Co., Inc., Fred Fisher.

FF:FB.

[fol. 16] EXHIBIT "3;" TO AFFIDAVIT OF HERMAN STARR

Copy

August 26th, 1940.

Fred Fisher Music Co., Inc., 1619 Broadway, New York,
N. Y.

GENTLEMEN:

We have your letter of August 13, 1940, wherein you state that you are the owners of the George Graff renewal rights in the song entitled "When Irish Eyes Are Smiling," and wherein you request us to remove this song from our catalogue.

We herewith notify you that you are not the owner of Mr. Graff's renewal rights in this song, for the reason that Mr. Graff had assigned to us his renewal rights in this song prior to any time that you may purport to have acquired any rights from him, viz: by instrument dated May 19th, 1917, recorded in the U. S. Copyright Office on November 19th, 1935, and by instrument dated August 12, 1939, recorded in the U. S. Copyright Office on August 14, 1939, and you are, therefore, charged with notice of these assignments. Consequently, any assignment which he may have purported to make to you is a nullity.

In addition, we want you to know that we are also the assignee of the renewal copyright in this song of Margaret O'Donovan Olcott, widow of Chauncey Olcott, who was a joint author of the song.

Accordingly, we hereby call upon you forthwith to remove this song from your catalogue, to cease and desist from publishing the same, and to retract publicly any [fol. 17] claim which may have been made by you to the trade to the effect that you have the right to publish this song. Upon your failure to do so, we shall take appropriate legal steps to protect our interests.

Very truly yours, M. Witmark & Sons, by ———

Registered mail.

Return receipt requested.

EXHIBIT "4," TO AFFIDAVIT OF HERMAN STARR

Phone: Columbus 5-1976.

Fred Fisher Music Co., Inc.

Music Publishers

1619 Broadway, New York City

September 5, 1940.

Music Publishers Holding Corporation, R. C. A. Building,
1250 Sixth Avenue, New York City.

GENTLEMEN:

We are in receipt of your letter of August 26, 1940, with reference to the renewal rights in the song entitled "When Irish Eyes Are Smiling."

[fol. 18] In the event that you are an assignee of a renewal copyright in the song secured by Margaret O'Donovan Olcott, widow of Chauncey Olcott, then, of course, you may have a non-exclusive right to publish.

We again wish to point out that we are publishing the song as assignee of the renewal copyright secured by Mr. George Graff, Jr., one of the co-authors.

In your letter of August 26, 1940, you refer to a certain instrument executed by Mr. Graff and dated May 19, 1917. We wish to call your attention to the fact that this instrument is presently the subject of litigation in *Whitmark v. Fisher et al.* now pending in the United States District Court. You are, therefore, familiar with construction which we place upon this instrument. Accordingly, it is our intention to continue to publish the song as assignee of the renewal copyright of George Graff, Jr.

Very truly yours, Fred Fisher Music Co., by Fred Fisher.

[fol. 19] EXHIBIT "5," TO AFFIDAVIT OF HERMAN STARR

Phone: Columbus 5-1976.

Fred Fisher Music Co., Inc.
Music Publishers
1619 Broadway, New York City

August 13, 1940.

Lyon & Healy, Inc., Wabash Ave. at Jackson Blvd., Chicago, Ill.

GENTLEMEN:

This is to advise you that we are the owners of the renewal copyright of the musical composition entitled:

When Irish Eyes Are Smiling

As you know, the original copyright on the aforementioned song has expired and we are the assignees of the renewal copyright on said composition.

Very truly yours, Fred Fisher, Fred Fisher Music Co., Inc.

[fol. 20] EXHIBIT "6," TO AFFIDAVIT OF HERMAN STARR

American Society of Composers, Authors and Publishers
Thirty Rockefeller Plaza
New York City

September 25th, 1940.

M. Whitmark & Sons, 1250 Sixth Avenue, New York, N. Y.

GENTLEMEN:

In re: "When Irish Eyes Are Smiling," words by Chauncey Olcott & George Graff, Jr., music by Ernest R. Ball

Under date of August 13th, 1940, Fred Fisher Music Co., Inc., wrote us as follows:

"This is to advise you that we are the owners of the George Graff renewal rights to the musical composition entitled:

"When Irish Eyes Are Smiling"

As you know, the original copyright on the aforementioned composition has expired and we are the assignees of the

renewal copyright on said composition. Please see that all points due us are recorded."

May we please have your comment?

Yours very truly, American Society of Composers,
Authors and Publishers, A. W. Klingmann. A.
W. Klingmann.

awk:ovb.

[fol. 21] IN DISTRICT COURT OF THE UNITED STATES

COMPLAINT—Filed Oct. 18, 1940

Plaintiff herein, by R. W. Perkins, its solicitor, for its complaint against defendants herein, respectfully shows to the court and avers:

1. That the cause of action herein arises under the Copyright Laws of the United States.

2. That plaintiff, at all times hereinafter mentioned, was and still is a corporation duly organized and existing under and by virtue of the laws of the State of New York, a resident of the City and State of New York, and of the Southern District of New York, and at all times hereinafter mentioned, was and still is engaged in the business of printing, publishing and vending copyrighted musical compositions.

3. Upon information and belief, that defendant, Fred Fisher Music Co., Inc., at all the times hereinafter mentioned, was and still is a corporation duly organized and existing under and by virtue of the laws of the State of New York, a resident of the City and State of New York, and of the Southern District of New York, and at all times hereinafter mentioned, was and still is engaged in the business of printing, publishing and vending copyrighted musical compositions.

[fol. 22] 4. Upon information and belief that defendant Mills Music, Inc., at all the times hereinafter mentioned was and still is a corporation duly organized and existing under and by virtue of the laws of the State of New York, a resident of the City and State of New York, and of the Southern District of New York, and at all times hereinafter

mentioned, was and still is engaged in the business of printing, publishing and vending copyrighted musical compositions.

5. Upon information and belief that defendant, George Graff, Jr., was at all times hereinafter mentioned and still is a citizen of the United States, a resident of the State of New York, County of New York and Southern District of New York.

6. That heretofore and on or about the 2nd day of January, 1908, plaintiff entered into a certain agreement with one, Ernest R. Ball, a copy of which said agreement is annexed hereto and marked Exhibit "A." That under said agreement, Ball covenanted and agreed to deliver to plaintiff any and all musical compositions which he alone, or in conjunction with others, would compose during the period of five (5) years commencing January 2nd, 1908, and he covenanted and agreed that all musical compositions thus composed by him during said five (5) year period would immediately upon being composed become and be the sole and absolute property of plaintiff, and he granted and conveyed to plaintiff "the copyright or copyrights of, with renewals and with right to copyright and renew, and property in any and all musical compositions which he would compose during the said five (5) year period."

7. That on or about the 1st day of July, 1910, plaintiff entered into a certain agreement with one, George Graff, [fol. 23] Jr., a copy of which agreement is annexed hereto and marked Exhibit "B." That under said agreement Graff covenanted and agreed to deliver to Witmark any and all compositions which he alone, or in conjunction with others, would compose during the period of five (5) years beginning July 1, 1910, and he covenanted and agreed that any and all musical compositions which he would thus compose during said five (5) year period would immediately upon the same being composed become the sole and absolute property of plaintiff, and he granted and conveyed to plaintiff "the copyright or copyrights of, with renewals and with right to copyright and renew and property in any and all musical compositions which he would compose during said five (5) year period."

8. That thereafter and prior to August 12, 1912, and while said agreements were in full force and effect, the said Ernest R. Ball and the said George Graff, Jr. and one Chauncey Olcott hereinafter respectively referred to as "Ball" and "Graff," and "Olcott," jointly composed a certain musical composition entitled "When Irish Eyes Are Smiling," hereinafter referred to as "said song," the music thereof having been written by the said Ball and the lyrics thereof by the said Graff and Olcott.

9. That thereafter and prior to August 12, 1912, by agreement between Olcott and plaintiff, for valuable consideration, said Olcott sold and assigned to plaintiff said song and the copyright thereof and the right to take out copyright thereof in the name of plaintiff.

10. That thereafter said Graff and Ball and Olcott pursuant to said agreements delivered said song to plaintiff.

11. That said song was new and original with Graff, Ball and Olcott and is copyrightable subject matter under the laws of the United States.

[fol. 24] 12. Upon information and belief that Graff, Ball and Olcott were, at the time herein mentioned, citizens of the United States.

13. That thereafter plaintiff, pursuant to the rights acquired by it under said agreements, and in compliance in all respects with the provisions of the Act of March 4th, 1909, governing copyright, and all other laws governing copyright, did duly copyright said song in its name on August 12, 1912 by publishing the same on said date, and offering the same for sale to the general public with the following notice of copyright applied on the page immediately following the title page:

"Copyright MCMXII by M. Witmark & Sons."

14. That after publication of said song with the said notice of copyright, plaintiff promptly and on the 14th day of August, 1912, duly deposited in the Copyright Office in Washington, District of Columbia, two complete copies of the best edition of said song then published accompanied by a claim of copyright, and paid to the Register of Copyrights the fee prescribed by law for the registration of said song; and said song was duly regis-

tered for copyright in the name of plaintiff by said Register of Copyrights, and the Register of Copyrights issued to plaintiff a certificate of copyright registration of said composition. That annexed hereto and marked Exhibit "C" is a copy of said certificate of copyright registration.

15. That plaintiff complied in all respects with the Act of March 4, 1909 governing copyrights, and all other laws and regulations governing copyright and secured the exclusive rights and privileges in and to the copyright of said song.

[fol. 25] 16. That since August 12, 1912, said song has been published by plaintiff, and upon each copy thereof published or offered for sale in the United States by authority of plaintiff there was affixed the notice of copyright set forth in paragraph "13" hereof on the page immediately following the title page.

17. That thereafter and on or about the 19th day of May, 1917, said Graff did execute a certain instrument dated May 19, 1917, a copy of which is annexed hereto and marked Exhibit "D" whereby he conveyed to plaintiff, for good and valuable consideration, the copyright and renewal copyright of said song, including the right to secure renewal of the copyright thereof, and any and all rights in said song that Graff might at any time be entitled to, and Graff did by the same instrument irrevocably authorize and appoint plaintiff as his attorney and representative in his name or in its own name to take and do such actions, deeds and things and to make, sign, execute and acknowledge all such documents as might from time to time be necessary to secure to plaintiff the renewal and extension of the copyright in said song and all rights therein for the term of such renewal and extension.

That said instrument of May 19, 1917, was duly recorded in the United States Copyright Office on November 19, 1935 in book 340, pages 217-219 in conformity with the laws of the United States respecting copyrights as appears from the copy of the certificate of recordation annexed to said instrument of May 19, 1917.

18. That said Graff was alive on August 11, 1940, the date on which the original twenty-eight year period of said copyright in said song expired and Graff is still alive.

[fol. 26] 19. That said Ball died prior to August 11, 1939, leaving a surviving widow named Maud L. Ball who is still alive.

20. That said Olcott died prior to August 11, 1939 leaving a surviving widow named Margaret O'Donovan Olcott who is still alive.

21. That pursuant to the rights and authority granted to plaintiff by Graff in said instrument of May 19, 1917, and pursuant to authority granted to plaintiff by said Margaret O'Donovan Olcott, plaintiff did on August 12, 1939, being within the one year period prior to the expiration of the said copyright in said song, duly file in conformity with the said Act of March 4, 1909 governing Copyright and all other laws and regulations governing copyright, in the Copyright Office in Washington, D. C., an application for the renewal and extension of the copyright in said song in the name of Graff and said Margaret O'Donovan Olcott and said application was duly registered in the Copyright Office by the Register of Copyrights, and the Register of Copyrights did duly issue a certificate of said registration dated August 12, 1939, a copy of which is annexed hereto and marked Exhibit "E".

22. That pursuant to the rights and authority granted to plaintiff in said instrument of May 19th, 1917, plaintiff, as the attorney and representative of Graff did duly assign to plaintiff the said renewal copyright by instrument dated August 12, 1939, a copy of which is annexed hereto and marked Exhibit "F". That said instrument dated August 12, 1939 was duly recorded in the Copyright Office on August 12, 1939 in book 422, page 150, in conformity with the laws of the United States respecting copyrights, as appears from the copy of the certificate of recordation attached to said instrument dated August 12, 1939.

[fol. 27] 23. That said Margaret O'Donovan Olcott also did duly assign to plaintiff said renewal copyright by instrument dated August 28, 1939, in consideration for which plaintiff agreed to pay said Olcott by an agreement of the

same date, fixed royalties. A copy of the said assignment is annexed hereto and marked Exhibit "G". That said assignment dated August 28, 1939 was duly recorded in the Copyright Office on August 29, 1939 in book 423, page 93, in conformity with the laws of the United States respecting copyrights, as appears from the copy of the certificate of recordation attached to said instrument dated August 28, 1939.

24. That by virtue of said acts, plaintiff became and now is the sole owner of the renewal copyright in said song and all rights of every name and nature whatsoever in said renewal copyright.

25. Upon information and belief on or about August 23, 1939, defendant Graff, having previously assigned the renewal copyright in said song to plaintiff, in derogation and in violation of his previous agreements with and grants to plaintiff and without any authority whatsoever from plaintiff, and in violation of plaintiff's rights, filed an application for the renewal and extension of the copyright in said song in the name of said Graff which application was registered in the Copyright Office by the Register of Copyrights, and the Register of Copyrights did issue to said Graff what purports to be a certificate of said registration dated August 23, 1939, a copy of which is annexed hereto and marked Exhibit "H".

26. Upon information and belief that by instrument dated October 24, 1939, a copy of which is hereunto annexed and marked Exhibit "I", defendant Graff with full [fol. 28] knowledge of the rights of plaintiff, and in violation of plaintiff's rights, and in derogation and violation of the aforesaid agreements and grants theretofore entered into between himself and plaintiff, purported to sell and assign to defendant Fred Fisher Music Co. Inc., which also had full knowledge of plaintiff's rights, the purported renewal copyright in the said song mentioned in paragraph "25" hereof. That said instrument of October 24, 1939 was recorded in the Copyright Office in Washington, D. C. on January 24, 1940 in book 432, page 123.

27. Upon information and belief that, on or about November 15, 1939 Mand Lambert Ball without any authority whatsoever from plaintiff and in violation of plaintiff's rights, filed an application for the renewal and extension

of the copyright in said song in the name of said Ball, which application was registered in the Copyright Office by the Register of Copyrights, and the Register of Copyrights did issue to said Ball what purports to be a certificate of said registration dated November 15, 1939, a copy of which is annexed hereto and marked Exhibit "J".

28. Upon information and belief that by instrument dated July 8, 1940, a copy of which is hereunto annexed and marked Exhibit "K", Maud Lambert Ball, with full knowledge of the rights of plaintiff and in derogation and violation of plaintiff's rights purported to sell and assign to defendant Mills Music Inc., who also had full knowledge of plaintiff's rights, the renewal copyright in said song mentioned in paragraph "27". That said instrument of July 8, 1940 was recorded in the Copyright Office in Washington, D. C. on July 13, 1940 in book 443, pages 95-96.

29. Upon information and belief that since on or about August, 1940, defendant Fred Fisher Music Co., Inc. has been infringing and continues to infringe the renewal copyright in said song as follows: since said date said defendant, without the authority or consent of plaintiff and with full knowledge of plaintiff's rights in the premises, and acting solely in virtue of the aforesaid invalid assignment from Graff mentioned in paragraph "26" heretof, and without any authority from the plaintiff or anyone else other than the said Graff, has (a) been publishing, offering for sale and vending copies of said song, (b) made an arrangement of said song, (c) been publishing, offering for sale and vending copies of said arrangement, and said defendant continues and will continue and threatens to continue to do the aforesaid infringing acts unless prevented by the decree of this court.

30. That a copy of plaintiff's copyrighted song is hereto annexed as "Exhibit "L", and a copy of defendant, Fred Fisher Music Co. Inc.'s infringing copy thereof and arrangement thereof is hereto annexed as Exhibit "M".

31. That plaintiff has heretofore notified defendant, Fred Fisher Music Co. Inc., in writing, that said defendant has infringed said renewal copyright of plaintiff, and that said infringements should cease, but said defendant, Fred Fisher Music Co. Inc. has continued to infringe the said renewal copyright after receipt of said written notice.

32. Upon information and belief that since on or about August, 1940, defendant Mills Music Inc. without the authority or consent of plaintiff has asserted that it has the right to publish the said song and threatens to publish the same and will publish the same unless prevented by the decree of this court.

Wherefore plaintiff demands judgment as follows:

1. That defendant Fred Fisher Music Co., Inc. its officers, employees, agents and servants, defendant Mills [fol. 30] Music Inc., its officers, employees, agents and servants and defendant George Graff, Jr., his agents and servants, be enjoined during the pendency of this action and permanently from infringing said renewal copyright of plaintiff in any manner.

2. That said defendant Fred Fisher Music Co., Inc. and defendant Graff be required to pay to plaintiff such damages as plaintiff has sustained in consequence of their infringement of said renewal copyright and to account and pay over to plaintiff all the gains, profits and advantages derived by said defendant from their infringement of plaintiff's renewal copyright or such damages as to the court shall appear proper within the provisions of the Copyright Statutes, but not less than Two Hundred Fifty (\$250.00) Dollars.

3. That said defendant Fred Fisher Music Co., Inc. and Graff be required to deliver up to be impounded during the pendency of this action all copies in their possession or under their control infringing said renewal copyright and to deliver up for destruction all infringing copies of all plates, molds, and other matter for making such infringing copies.

4. That this court declare null and void the purported renewal registration of defendant Graff dated August 23, 1939, and the purported assignment from defendant Graff to defendant Fred Fisher Music Co., Inc. dated October 24, 1939; that said purported renewal copyright registration and said assignment be cancelled of record and that this court declare that said defendant Fred Fisher Music Co., Inc. and said defendant Mills Music Inc. and said defendant Graff have no rights of any nature whatsoever in the renewal copyright in said song.

[fol. 31] 5. That defendants Fr  d Fisher Music Co., Inc., Mills Music Inc., and Graff pay to plaintiff the costs of this action and reasonable attorney's fees to be allowed to the plaintiff by the court.

6. That plaintiff have such other and further relief as is just.

R. W. Perkins, Attorney for Plaintiff, Office & P. O.

Address: 321 West 44th Street, Borough of Manhattan, City of New York.

EXHIBIT "A", TO COMPLAINT

Agreement, made this 2nd day of January, 1908, by and between M. Witmark & Sons, party of the first part, doing business in the Borough of Manhattan, City of New York, and Ernest R. Ball, composer, of the Borough of Manhattan, City of New York, party of the second part.

Wherefore, the party of the first part is desirous of acquiring the copyright of and property in all the musical compositions which the party of the second part may write [fol. 32] or compose alone, or in conjunction with others, or secure control of during the period of five (5) years from the date hereof:

Now, in consideration of the sum of One Dollar, by each of the parties hereto to the other in hand paid, the receipt whereof is hereby reciprocally acknowledged, and also in consideration of the covenants and conditions hereinafter contained.

This Agreement Witnesseth:

First: The party of the second part does hereby covenant and agree to deliver to the party of the first part any and all musical compositions which the party of the second part alone or in conjunction with others, may write or compose or acquire control of during the period of five (5) years, beginning from the date of this agreement, and the said party of the second part hereby expressly covenants and agrees that any and all musical compositions which said party of the second part may or shall write or compose or acquire control of during the period of five (5) years beginning from the date of this agreement, including the title words and music of any and all

such musical compositions, shall immediately upon the same being written or composed, or control thereof being secured, become and be the sole and absolute property of the party of the first part; and the party of the second part hereby expressly grants and conveys to the party of the first part, the copyright or copyrights of, with renewals and with right to copyright and renew, and property in any and all musical compositions which he may write or compose or acquire control of during said period of five (5) years, including the titles, words and music thereof. And the party of the second part hereby con- [fol. 33]veys, sells, transfers, assigns and delivers unto the party of the first part any and all musical compositions which he has heretofore written or composed, or has control of, either alone or in conjunction with others, and which are not subject to any contract for their sale or publication with any person, firm or corporation. And said party of the second part covenants and agrees not to write, compose or deliver to any person, firm or corporation other than the party of the first part, any musical composition at any time during the period of five (5) years beginning from the date of this agreement, or the titles, words or music of any such composition or any part thereof, and he will not permit any publisher, person, firm or corporation other than the party of the first part, to publish or in any manner use any such composition, title, words or music or any part thereof.

Second: The party of the second part hereby declares and covenants that he is entirely free and has good right to make this agreement; that he has not entered into any contract or agreement of any description which prevents him or could prevent him from carrying out in full the purposes of this contract. And the said party of the second part further covenants and agrees to protect and defend the right, title and interest of M. Witmark & Sons, to the fullest extent, in any composition or compositions which the said M. Witmark & Sons may acquire from the party of the second part.

Third: The party of the second part agrees that during each year of the term of this agreement, he will submit to the party of the first part for publication, all the new and original compositions written and composed by him alone, or in conjunction with others, or controlled by him, but

not less than twelve (12) compositions each year. The [fol. 34] party of the first part agrees to publish not less than six (6) of the compositions acquired from the party of the second part during each year of the term of this agreement. It is fully understood and agreed that complete works, such as comic operas, musical comedies or groups of numbers that may be written for either, and cycles are to be considered as single compositions.

Fourth: The party of the first part agrees to pay to the party of the second part for himself and those who ~~may~~ be jointly interested with him, a gross sum of four (4¢) cents when he furnishes both words and music, and a gross sum of two (2¢) cents when he furnishes either the words or music only, upon each and every copy sold by it of any composition which the party of the second part shall have written, composed or acquired control of either alone or in conjunction with others; also a gross sum of four (4¢) cents upon each and every copy sold by it of any instrumental number for piano, that may be written, composed or controlled by him alone, or in conjunction with others. It is fully understood that no royalties are to be paid upon arrangements of any kind, excepting for piano, upon which four (4¢) cents shall be paid on every copy sold by it, and that no royalties are to be paid upon copies disposed of as "new issues"; also that a sum equal to one-half of the above mentioned royalties is to be paid to the party of the second part by the party of the first part upon copies sold by the party of the first part in foreign countries. The party of the second part hereby assigns, transfers, sets over and delivers unto said party of the first part all mechanical rights in his compositions published by the party of the first part, and the said party of the first part agrees to pay to said party of the second part one-half of his share of all sums realized by it from the mechanical reproduction of such compositions.

[fol. 35] Fifth: The party of the first part hereby further agrees that it will render unto said party of the second part semi-annual statements on the 15th days of January and July of each year, showing all sales and royalties earned by said party of the second part, and any moneys which at any time may appear from such statements to be due, shall be paid to the party of the second part within thirty days thereafter.

Sixth: On the expiration of this agreement the party of the second part will renew this agreement for a further term of five (5) years upon the same terms and conditions as set forth and provided for in this agreement, provided that the said party of the first part shall at least six (6) months before the expiration of this agreement notify said party of the second part in writing of its intention to renew this agreement.

In Witness Whereof the parties hereto have hereunto executed this agreement in duplicate the day and year first above written.

M. Witmark & Sons, Julius P. Witmark Sec'y.
Ernest R. Ball.

In presence of: Henry Hart, Notary Public 47, N. Y. Co.

[fol. 36]

EXHIBIT "B", TO COMPLAINT

Agreement made this 1st day of July, 1910, by and between M. Witmark & Sons, doing business in the Borough of Manhattan, City of New York, party of the first part, and George Graff, Jr., author, of the Borough of Manhattan, City of New York, party of the second part.

Whereas, the party of the first part is desirous of acquiring the copyright of and property in all the musical compositions which the party of the second part may write or compose, alone or in conjunction with others, or secure control of during the period of five (5) years from the date hereof;

Now, in consideration of the sum of One Dollar by each of the parties hereto to the other in hand paid, the receipt whereof is hereby reciprocally acknowledged, and also in consideration of the covenants and conditions hereinafter contained,

This Agreement Witnesseth:

First: The party of the second part does hereby covenant and agree to deliver to the party of the first part any and all musical compositions which the party of the second part, alone or in conjunction with others, may write or compose or acquire control of during the period of five (5) years, beginning from the date of this agreement, and the said party of the second part hereby expressly covenants

and agrees that any and all musical compositions which said party of the second part may or shall write or compose or acquire control of during the period of five (5) years beginning from the date of this agreement, including the titles, words and music of any and all such musical compositions, shall, immediately upon the same being written or composed or control thereof being secured, become and be the sole and absolute property of the party of the first part; and the party of the second part hereby expressly grants and conveys to the party of the first part the copyright or copyrights of, with renewals and with right to copyright and renew, and property in any and all musical compositions which he may write or compose or acquire control of during the said period of five (5) years, including the titles, words and music thereof. And said party of the second part covenants and agrees not to write, compose for or deliver to any person, firm or corporation other than the party of the first part, any musical composition at any time during the period of five (5) years beginning from the date of this agreement, or the titles, words or music of any such composition or any part thereof, and he will not permit any publisher, person, firm or corporation other than the party of the first part to publish or in any manner use any such composition, title, words or music of any part thereof.

Second. The party of the second part hereby declares and covenants that he is entirely free and has good right to make this agreement; that he has not entered into any contract or agreement of any description which prevents him or could prevent him from carrying out in full the purposes of this contract. And the said party of the second part further covenants and agrees to protect and defend the right, title and interest of M. Witmark & Sons to the fullest extent of any composition or compositions which the said M. Witmark & Sons may acquire from the party of the second part.

Third. The party of the second part agrees that during each year of the term of this agreement, he will submit [fol. 38] to the party of the first part for publication, all the new and original compositions written and composed by him, alone or in conjunction with others, or controlled by him, but not less than six (6) compositions each year.

The party of the first part agrees to publish not less than three (3) of the compositions acquired from the party of the second part during each year of the term of this agreement. It is fully understood and agreed that complete works, such as comic operas, musical comedies, or groups of numbers that may be written for either, and cycles, are to be considered as single compositions.

Fourth. The party of the first part agrees to pay to the party of the second part as royalty the sum of four (4¢) cents when he furnishes both words and music, and the sum of two (2¢) cents when he furnishes either the words or music only, upon each and every copy sold by it of any "standard" and "operatic" numbers which the party of the second part shall have written, composed or acquired control of either alone or in conjunction with others; and the sum of three (3¢) cents when he furnishes both words and music, and the sum of one and one-half (1½¢) cents when he furnishes either the words or music only, upon each and every copy sold by it at the regular rate, of any "popular" number which the party of the second part shall have written, composed or acquired control of either alone or in conjunction with others. However, upon copies of "popular" numbers sold by the party of the first part at less than the regular rate down to ten cents, the party of the second part will accept as royalty the sum of one and one-half (1½¢) cents per copy, provided he has supplied both the words and music, and the sum of three-fourth (¾¢) cents per copy if he has supplied either the words or music only; and upon copies sold at less than ten cents the party of the second part will accept as royalty the sum of one (1¢) cent per copy if he has supplied [fol: 39] both the words and music, and the sum of one-half (½¢) cent if he has supplied either the words or music only. It is fully understood that no royalties shall be paid upon arrangements of any kind and that no royalty shall be paid upon copies disposed of as "new issues"; also that a sum equal to one-half of the above-mentioned royalties is to be paid upon copies sold by the party of the first part in foreign countries.

The said party of the second part hereby assigns, transfers sets over, sells and conveys to the party of the first part all mechanical rights in any composition which the said party of the second part has heretofore written or

composed either alone or jointly with others or in which he has, either alone or jointly with others, acquired mechanical rights, and in any compositions which he, the said party of the second part may hereafter either alone or in conjunction with others write or compose during the life of this agreement, or in which he may, either alone or jointly with others, acquire mechanical rights during the life of this agreement; and the said party of the first part hereby agrees to collect such royalties as may accrue from the mechanical reproduction of the compositions of the party of the second part and to pay to the party of the second part, for himself and all others who may jointly be interested with him, one-half of all moneys received by the party of the first part from or on account of such mechanical rights.

Fifth. The party of the first part hereby further agrees that it will render unto said party of the second part, semi-annual statements on the 15th days of January and July of each year, showing all sales and royalties earned by said party of the second part, and any moneys which at any time may appear from such statements to be due shall be paid to the party of the second part within thirty days thereafter.

[fol. 40] Sixth. On the expiration of this agreement the party of the second part will renew this agreement for a further term of five (5) years upon the same terms and conditions as set forth and provided for in this agreement, provided that the said party of the first part shall at least six (6) months before the expiration of this agreement notify said party of the second part in writing of its intention to renew this agreement.

In Witness Whereof the parties hereto have hereunto executed this agreement in duplicate the day and year first above written.

In the presence of: (Signature not legible.)

(Signature not legible.) L. S. (Signature not legible.) L. S.

EXHIBIT "C", TO COMPLAINT

M. Witmark & Sons, New York, N. Y.

Title of music: When Irish Eyes Are Smiling

Lyric by Chauncey Olcott and Geo. Graff, Jr.

Music by Ernest Ball

Date of publication Aug. 12, 1912. Copies received Aug. 14, 1912.

Entry: Class E. XXc., No. 292131. Thorvald Solberg, Register of Copyrights. (Seal.)

[fol. 41]

E1

Copyright Office of the United States of America

Library of Congress—Washington

Certificate of Copyright Registration

This is to certify, in conformity with section 55 of the Act to Amend and Consolidate the Acts respecting Copyright approved March 4, 1909, that two copies of the MUSICAL COMPOSITION named herein have been deposited in this Office under the provisions of the said Act, and that registration for copyright for the first term of 28 years from the date of publication thereof has been duly made in the name of

(Seal.)

EXHIBIT "D", TO COMPLAINT

For and in consideration of the sum of Sixteen Hundred (\$1600.00) Dollars, to me in hand paid, receipt of which is hereby acknowledged, I do hereby sell, assign, transfer and deliver to M. Witmark & Sons, hereinafter designated as the Publisher, all my rights, title, interest and royalties in and to my lyrics and musical compositions that are published by it; also all rights, title and interest in and to all my lyrics and musical compositions that they have contracted for and which may be unpublished, including the following:

While Rivers of Love

Come To Me

Love Wins Always

[fol. 42] Homeward Bound
 Until Life Shall Be Done
 'Tis I My Love Who Dreams
 Give Praise In Gladsome Song
 'Twas Night Before Xmas
 Calling of the Sea
 When Irish Eyes Are Smiling
 I Love The Name Of Mary
 Lost Melody
 Shine Oh, Holy Light
 Let Us Have Peace
 Baby of the Lagoon
 Little Chief of Seven Moons
 Little Fur Baby
 My Wee My Bonnie Bairn
 My Little Pickinny
 Sleep Little Angel Sleep
 My Little Maid of Tokio
 Why That Tear
 Cradle Song
 I'd Love To Be Loved By A Girl
 Keep All Your Love For Me
 Yankee Girl Is Queen Of All
 As Long As The World Rolls On
 Farming Up to date
 When I Hear Those Dear Old Southern Songs
 Isle O' Dreams
 Where Is Love Of Yesterday
 Across The Rio Grande
 Angel of Light Lead On
 Honey Don't You Know
 Roll On Oh Beautiful World
 Tale Of An Orange Blossom
 All The World Loves A Lover
 My Baby Boy

[fol. 43] I Come To Thee
 In A Little While
 Here's Love and Success
 While The Church Bells Are Chiming
 My Sweet
 'Till The Sands of the Desert Grow Cold
 Teach Me To Pray
 Vain Is My Strength

True Heart
 Would You Care To Do That
 'Till We Meet Again
 Yankee Flyer
 Oh The Circus
 Three Simple Words "I Love You"
 If you'll Remember Me
 To The End of the World
 Star of Heaven
 I Do Believe
 Sugar Rose
 Roses O' Mine
 I'll Change The Shadows
 I Never Met Before A Girl Like You
 Me Little Ludeen
 Good-bye My Love
 In Dreams My Own
 I Want A Home For My Heart
 Sleep Little Angel Sleep
 Sonny
 The Frolic of the Leaves
 Daddy Was A Grand Old Man
 Isle O' Dreams

to have and to hold the same absolutely unto the said
 Publisher, its successor, successors and assigns, together
 with all rights there in for all countries, including the pub-
 [fol. 44] lishing rights, the performing and cinematograph
 rights, the right of reproduction upon mechanical instru-
 ments of every description, the right to make, publish and
 perform any arrangement or adaption of the same, and
 all copyrights and renewals of copyrights and the right to
 secure all copyrights and renewals of copyrights in the
 same or in any arrangements or adaptations thereof, and
 any and all rights therein that I or my heirs, executors,
 administrators or next of kin may at any time be entitled to.

And I do, for myself, my heirs, executors, administrators
 and next of kin, hereby irrevocably authorize and appoint
 the Publisher, its successor, successors and assigns, my
 attorneys and representatives, in my name or in the names
 of my heirs, executors, administrators and next of kin,
 or in its own names to take and do such actions, deeds and
 things, and make, sign execute and acknowledge all such
 documents as may from time to time be necessary to

secure to the Publisher, its successor, successors and assigns, the renewals and extensions of the copyrights in said compositions and all rights therein for the terms of such renewals and extensions. And I agree, for myself any for my heirs, executors, administrators and next of kin, upon the expiration of the first term of any copyright in said compositions, in this or in any other country, to duly make, execute, acknowledge and deliver or to procure the due execution, acknowledgement and delivery to the Publisher, its successor successors or assigns, of all papers necessary in order to secure to it the renewals and extensions of all copyrights in said compositions and all rights therein for the terms of such renewals and extensions.

And I do hereby covenant and warrant that said compositions are original work, that no part thereof is in the public domain, that I am the sole owner of said compositions and of all the rights therein, and have not sold, assigned, set over, hypothecated or mortgaged any right, title or interest in or to said compositions, or any part thereof, and that I have not entered into any contract with any party whomsoever, affecting said compositions or any right, title or interest therein, but have full right to make this present instrument and sale.

I further covenant and agree to protect and defend the right, title and interest of the said Publisher, and its successors and assigns in the compositions hereby sold to the fullest extent.

In Witness Whereof I have hereunto subscribed my name and affixed my seal at N. Y., in the State of N. Y. this 19 day of May, 1917.

Geo. Graff, Jr. (L. S.).

In presence of: O. H. Jordan:

STATE OF —,

County of —, ss.:

On this — day of May, 1917, before me personally came George Graff, Jr., to me known and known to me to be the person mentioned and described in the foregoing instrument, and who executed the same, and he duly acknowledged to me that he executed the same for the uses, intents and purposes therein mentioned.

[fol. 46] Copyright Office of the United States of America
Library of Congress—Washington

The foregoing assignment of copyright, dated May 19, 1917, and received for record in the Copyright Office on November 19, 1935, has been recorded in the Copyright Office book 349, pages 217-219, in conformity with the laws of the United States respecting copyrights.

In Witness Whereof, the seal of this Office has been hereto affixed this twenty-first day of November, 1935.

Wm. L. Brown, Register of Copyrights. (Seal.)

EXHIBIT "E," TO COMPLAINT

The copyright is claimed by one of the authors of words, and the widow of the other author of words.

The work is described as a Musical Composition and is entitled When Irish Eyes Are Smiling Lyric by Chauncey Olcott and Geo. Graff, Jr. Music by Ernest R. Ball.

The date of original publication was Aug. 12, 1912.

Entry No. Exxu-292131.

Application filed Aug. 12, 1939. Renewal registration No. 78644.

C. L. Bouvé, Register of Copyrights. (Seal.)

[fol. 47] Library of Congress—Washington
Copyright Office of the United States of America

Certificate of Copyright Registration

This is to certify, that in conformity with section 23 of the Act to Amend and Consolidate the Acts respecting Copyright approved March 4, 1909, an application for the renewal of the Copyright now subsisting in the work named herein for the term of 28 years has been duly registered in the name of George Graff, Flushing, L. I., N. Y., and Margaret O'Donovan Olcott, New York, N. Y.

EXHIBIT "F," TO COMPLAINT

Assignment of Copyright

Vol. 422, Page 150.

Know all men by these presents, for and in consideration of the sum of One Dollar (\$1.00) and other good and

valuable considerations, to me in hand paid, receipt of which is hereby acknowledged, I, George Graff, by my appointed attorney M. Witmark & Sons, do hereby sell, assign, transfer and set over unto M. Witmark & Sons, its successors and assigns, the renewal copyright of the composition entitled:

"When Irish Eyes Are Smiling"

In Witness Whereof, I have hereunto set my hand and seal this 12th day of August, 1939.

George Graff, by M. Witmark & Sons, by A. M. Wattenberg, Assistant Secretary.

[fol. 48] STATE OF NEW YORK,
County of New York, ss.:

On this 12th day of August, 1939, before me personally came A. M. Wattenberg, Assistant Secretary of M. Witmark & Sons, to me known and known to me to be the person who executed the foregoing assignment as Assistant Secretary of M. Witmark & Sons, Attorney for George Graff under and by virtue of an instrument in writing, dated the 19th day of May, 1917.

Joseph A. McLaughlin, Notary Public, Kings County,
No. 160. Certificate filed in N. Y. County No. 247.
Commission expires March 30, 1941. (Seal.)

Copyright Office of the United States of America
Library of Congress—Washington

The foregoing assignment of copyright, dated August 12, 1939, and received for record in the Copyright Office on August 14, 1939, has been recorded in the Copyright Office, book 422, page 150, in conformity with the laws of the United States respecting copyrights.

In Witness Whereof, the seal of this Office has been hereto affixed this nineteenth day of August, 1939.

C. La Bouvé, Register of Copyrights. (Seal.)

[fol. 49] EXHIBIT "G," TO COMPLAINT

Assignment of Copyright

Vol. 423, Page 93.

Know all men by these presents, for and in consideration of the sum of One Dollar (\$1.00) and other good and valu-

able considerations, to me — hand paid, receipt of which is hereby acknowledged, I, Margaret O'Donovan Olcott (widow of Chauncey Olcott), do hereby sell, assign, transfer and set over unto M. Witmark & Sons, its successors and assigns, the renewal copyright of the following compositions:

“When Irish Eyes Are Smiling”

“The Callin' Of The Sea”

In Witness Whereof, I have hereunto set my hand and seal this 28th day of August, 1939.

Margaret O'Donovan Olcott.

In the presence of: ———

A

Copyright Office of the United States of America

Library of Congress—Washington

The foregoing assignment of copyright, dated August 28, 1939, and received for record in the Copyright Office on [fol. 50] August 29, 1939, has been recorded in the Copyright Office, book 423, page 93, in conformity with the laws of the United States respecting copyrights.

In Witness Whereof, the seal of this Office has been hereto affixed this sixth day of September, 1939.

C. L. Bouvé, Register of Copyrights. (Seal)

EXHIBIT “H,” TO COMPLAINT

Copyright Office of the United States of America

Library of Congress, Washington

Certificate of Copyright Registration

This is to certify, in conformity with section 23 of the Act to Amend and Consolidate the Acts respecting Copyright approved March 4, 1909, an application for the renewal of the copyright now subsisting in the work named herein, for the term of twenty-eight years has been duly registered in the name of George Graff whose address is 3301 164 St. Flushing, L. I., N. Y. The renewal copyright is claimed by One of the Authors of Words. The work

is described as a Musical Composition and is entitled When Irish Eyes are Smiling. Lyric by Chauncey Olcott and Geo. Graff, Jr.² Music by Ernest R. Ball. The date of publication was August 12, 1912. Entry No. Exxc 292131. The name of the original claimant was M. Witmark & Sons. Renewal registration No. 78706.

Date August 23, 1939.

C. L. Bouvé, Register of Copyrights. (Seal.)

[fol. 51]

EXHIBIT "I," TO COMPLAINT

Vol. 432, Page 123.

In consideration of the sum of \$1.00 and other good and valuable consideration, receipt whereof is hereby acknowledged, I do hereby sell, assign, transfer and set over to Fred Fisher Music Co. Inc. its successors and assigns, all of my right, title and interest in and to renewal copyright number E292131 on the musical composition entitled "When Irish Eyes Are Smiling."

Dated this October 24, 1939.

Geo. Graff.

Ben Schulte, Witness.

EXHIBIT "J," TO COMPLAINT

Copyright Office of the United States of America

Library of Congress, Washington

Certificate of Copyright Registration

This is to certify, in conformity with section 23 of the Act to Amend and Consolidate the Acts respecting Copyright approved March 4, 1909, an application for the renewal of the Copyright now subsisting in the work named herein for the term of twenty-eight years has been duly [fol. 52] registered in the name of Mand Lambert Ball. Whose address is 184 West Fourth St., New York, N. Y. The renewal copyright is claimed by the Widow of the Author of Music. The work is described as a Musical Composition and is entitled When Irish Eyes are Smiling. Lyric by Chauncey Olcott & George Graff, Jr. Music by Ernest

R. Ball. The date of publication was August 12, 1912. Entry No. Exxc 292131. The name of the original claimant was M. Witmark and Sons. Renewal registration No. 79651. Date November 15, 1939.

C. L. Bouvé, Register of Copyrights. (Seal.)

EXHIBIT "K," TO COMPLAINT

Vol. 443, Page 95.

Know all men by these presents, that the undersigned, Maude Lambert Ball, (widow of Ernest R. Ball) residing in New York, N. Y. in consideration of the sum of One (\$1.00) Dollar and other good and valuable consideration, to her in hand paid by Mills Music, Inc., a domestic corporation having its principal place of office at 1619 Broadway, in the Borough of Manhattan, City of New York, herein called the "Purchaser" receipt whereof is hereby acknowledged, hereby assigns to the "Purchaser" all her right, title and interest in and to the musical compositions in detail set out in "Schedule A," attached hereto and made part hereof, including all the renewal copyrights thereof secured under the laws now in force and effect in the United States, and including all her interest in and to all copyrights thereof heretofore secured under the laws in force and effect in any other country or countries throughout the world.

And, the said Maude Lambert Ball, in order to induce the said "Purchaser" to accept this assignment and make [fol. 53] this purchase to pay a good and valuable consideration therefor, does hereby represent and warrant to the said "Purchaser" as follows:—

1. That all the said renewal copyrights to all the musical compositions listed in Schedule A are valid and subsisting renewal copyrights in the United States.
2. That she has a right to make this Assignment and sale.
3. That she has not heretofore assigned or pledged or attempted to assign or pledge her interest in and to any of the musical compositions and renewal copyrights thereof listed in Schedule A.

And, Maude Lambert Ball, further agrees upon demand to sign, execute and acknowledge any or all other papers or instruments that may be necessary to effectuate this assignment and sale or carry out the purposes thereof.

In Witness Whereof, Maude Lambert Ball, has hereunto set her hand and seal this 8 day of July, 1940.

Maude Lambert Ball.

STATE OF NEW YORK,

City of New York,

County of New York, ss:

On this 8th day of July, 1940, before me personally appeared Maude Lambert Ball, to me known and known to me to be the individual mentioned and described in the foregoing instrument, and she duly acknowledged to me that she executed the same.

Louis Schwartz, Notary Public, Bronx Co. Clk's
No. 162, Reg. No. 211-S-41. Cert. filed in N. Y.
Co. No. 207, Reg. 1-S-566. Commission expires
March 30, 1941. (Seal.)

[fol. 54]

Vol. 433 Page 96

SCHEDULE A TO EXHIBIT "K"

SUGAR ROSE, Words by Jack Kingsley, Music by George Christie (Ernest R. Ball) date of original publication, January 27th, 1913, #Exxe-301486, renewal copyright, June 3rd, 1940, #87352.
M.L.B.

BECAUSE HE DID HIS DUTY, Words by J. Will Callahan, Music by George Christie (Ernest R. Ball) date of original publication, March 3rd, 1913, #Exxe-305166 renewal copyright, June 3rd, 1940, #87354.
M.L.B.

AT THE TEN CENT MOVIE SHOW, Words by Leo J. Curley, Music by George Christie (Ernest R. Ball) date of original publication, March 10th, 1913, #Exxe-305372 renewal copyright, June 3rd, 1940, #87355.
M.L.B.

TO HAVE, TO HOLD, TO LOVE, Lyric by Darl MacBoyle, Music by Ernest R. Ball, date of original publication, Jan-

uary 13th, 1913, #Exxc-301344, renewal copyright, June 3rd, 1940, #87350.
M.L.B.

MY DAYS ARE IN HIS HANDS, Text by Fred G. Bowles, Music by Ernest R. Ball, date of original publication, March 31st, 1913, #Exxc-305897, renewal copyright, June 3rd, 1940, #87357.
M.L.B.

I'LL CHANGE THE SHADOWS TO SUNSHINE, Words by Geo. Graff, Jr. Music by Ernest R. Ball, date of original publication, March 25th, 1913, #Exxc-305601 renewal copyright, June 3rd, 1940, #87356.
M.L.B.

I DO BELIEVE, Lyric by George Graff, Jr. Music by Ernest R. Ball, with Violin obligato, date of original publication, March 3rd, 1913, #Exxc-305164, renewal copyright, June 3rd, 1940, #87353.
M.L.B.

MY EVENING SHRINE, Lyric by Arthur Angyalfi, Music by Ernest R. Ball, date of original publication, September 4th, 1912, #Exxc-293151, renewal copyright November 15th, 1939, #79653.
M.L.B.

ON A GOOD OLD TIME STRAW RIDE, Lyric by Dave Reed, Music by Georgie Christie (Ernest R. Ball) date of original publication, July 12th, 1912, #Exxc-288925 renewal copyright, November 15th, 1939, #79650.
M.L.B.

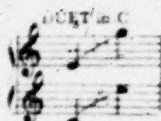
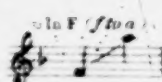
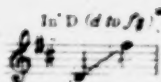
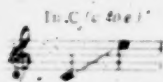
WHEN IRISH EYES ARE SMILING, Lyric by Chauncey Olcott & George Graff, Jr. Music by Ernest R. Ball, date of original publication August 12th, 1912, #Exxc-292131, renewal copyright, November 15th, 1939, #79651.
M.L.B.

THE ISLE OF APTERWHILE, Lyric by Gulielma D. Orr, music by Ernest R. Ball, date of original publication, January 13th, 1913, #Exxc-301361, renewal copyright, June 3rd, 1940, 87351.
M.L.B.

Exhibit "L" to Complaint

40

WHEN IRISH EYES ARE SMILING



SUNG BY
Mr. CHAUNCEY OLCOTT



Soprano or
Tenor (C to E)
and
Alto or
Baritone (D to F)

SONG

LYRIC BY

CHAUNCEY OLCOTT AND GEO. GRAFF JR.

MUSIC BY

ERNEST R. BALL

SOLO 50c

DUET 60c

The following are the available choral arrangements

SSA 15c

SSAA 16c

SATB 15c

TTBB 15c



OPERAIC

M. WITMARK & SONS,
NEW YORK

PRINTED IN U.S.A.

Some of the GREAT Songs

by

VICTOR HERBERT

TRAMPI TRAMPI TRAMPI

Lyric by RIDA JOHNSON YOUNG



Copyright MCMXIII by M. Witmark & Sons

VOCAL: Solo—Eb, 50c

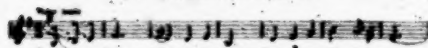
CHORAL: TTBB, 16c

SYMPHONY BAND: "A" band, \$4.00; "B" band, \$3.00; "C" band, \$2.00; Extra parts, 20c each

Easy piano solo arrangement, 50c

KISS ME AGAIN

Lyric by HENRY BLOSSOM



Copyright MCMXIII by M. Witmark & Sons

VOCAL: Solos—F, G, A, Bb, 50c ea

DUETS: A, 60c

CHORAL: SSAA, 18c; SATB, 16c; TTBB, 20c

SYMPHONY BAND: "A" Band, \$4.00; "B" Band, \$3.00; "C" Band, \$2.00; Condensed Score, 75c

Extra Parts, 20c ea

INSTRUMENTAL: Violin and Piano, 60c; Cello and Piano, 60c; Violin, Cello and Piano, 75c; Bb Sax. and Piano, 60c; Eb Alto Sax. or Clarinet and Piano, 60c; Bb Trumpet and Piano, 60c; Bb Clarinet and Piano, 60c; C Sax. and Piano, 60c; Cornet or Trombone and Piano, 75c; Piano Solo (Waltz), 50c

MARCH OF THE TOYS



Copyright MCMXIII by M. Witmark & Sons

PIANO: Solo, 50c; 4 Hands (Two Pianos), \$1.25

CHORAL: SSA, 25c; TTBB, 35c

BAND: Standard Band, \$2.00

ORCHESTRA: S.O., \$1.50; F.O., \$2.00

TOYLAND

Lyric by GLEN MAC DONOUGH



Copyright MCMXIII by M. Witmark & Sons

VOCAL: Solo—F, 50c

CHORAL: SA, 15c; SSAA, 75c

Easy piano solo arrangement, 50c

A KISS IN THE DARK

Lyric by B. G. DE SYLVA



Copyright MCMXIII by M. Witmark & Sons

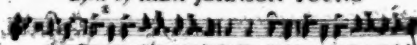
VOCAL: Solo—C, D, Eb, 50c ea

DUETS: Eb, C, 60c ea

CHORAL: SATB, 16c; TTBB, 16c

AHI SWEET MYSTERY OF LIFE

Lyric by RIDA JOHNSON YOUNG



Copyright MCMXIII by M. Witmark & Sons

VOCAL: Solo—Ab, Bb, C, D, 50c ea

DUETS: Bb, D, 60c ea

CHORAL: SA, W-2160, 15c; SSA, W-2161, 15c; SSAA, 18c; TBB, 16c; SAB, 15c; SATB, 16c; TTBB, 16c

INSTRUMENTAL: Violin and Piano, 60c; Cello and Piano, 60c; Violin, Cello and Piano, 75c; Piano Solo, 50c

ROSE OF THE WORLD

Lyric by GLEN MAC DONOUGH



Copyright MCMXIII by M. Witmark & Sons

VOCAL: Solo—C, 50c

M. WITMARK & SONS

NEW YORK

When Irish Eyes Are Smiling

Lyric by
CHAUNCEY OLCOTT
& GEO. GRAFF Jr.

Music by
ERNEST R. BALL

Valse moderato espressivo

The musical score is written for piano and voice. It features a key signature of one sharp (F#) and a 2/4 time signature. The tempo and mood are indicated as 'Valse moderato espressivo'. The score includes a piano introduction, followed by the vocal melody with lyrics, and a piano accompaniment. The lyrics are: 'There's a tear in your eye, And I'm won-der-ing why, For it For your smile is a part, Of the love in your heart, And it nev-er should be there at all. With such pow'r in your smile, Sure a makes e-ven sun-shine more bright. Like the lin-nets sweet song, Croon-ing stone you'd be-guile, So there's nev-er a tear-drop should fall-- When your all the day long, Comes your laugh-ter so ten-der and light. For the'.

5772

W. RASONS 19407-3

Copyright MCMXII by M. Witmark & Sons
Copyright Renewed
International Copyright Secured

sweet lilt-ing laugh-ter's like some fair-y song, And your eyes twink-le
spring-time of life is the sweet-est of all, There is ne'er a re

bright as can be; You should laugh all the while and all
care or re-gret; And while spring-time is ours through-out

oth-er times, smile, And now smile a smile for me
all of youth's hours, Let us smile each chance we get.

CHORUS

When I-rish eyes are smi-ling, Sure it's like a morn-m

M. & SONS 1843-7

Spring — In the lilt of I - rish laugh-ter, You can hear the

an - gels sing. When I - rish hearts are hap - py, All the

world seems bright and gay, And when I - rish eyes are smil-

ing, Sure they steal your heart a - way. When way.

REASON 1907-2

WARNING: Any person who shall willfully and for profit copy the words or music of this song or any portion thereof, shall be liable to criminal prosecution under the United States Copyright Law.

• FAMOUS IRISH SONGS •

MOTHER MACHREE



- A Little Bit Of Heaven, Sun
They Call It Ireland!
- My Wild Irish Rose
- Mother Machree
- Too Ra Loo Ra Loo Ral
- Where The River Shannon
Flows

- At The End Of An Irish Lane
- Bells Of Killarney
- Colleen O' My Heart
- That Old Irish Mother
Of Mine
- That's How The Shannon
Flows

M. WITMARK & SONS
NEW YORK

MY WILD IRISH ROSE



Exhibit "M" to Complaint

WHEN IRISH EYES ARE SMILING

New Arranged in Fox-Trot Rhythm

"When Irish Eyes Are Smiling" belongs for all time to the folk lore of Ireland. Yet it was in this country, and less than thirty years ago that George Graff wrote his lovely poem.

Later Ernest Ball touched it with the magic of music giving it a simple melody that matched the inspiration of the poet.

Chauncey Olcott sang it for a year or two and then having lived its hour it seemed destined to be forgotten.

But a Dublin minstrel, returning to his native isle—where Irish eyes so often smile thru burning tears—took the song with him. It echoed so fully the lovable characteristics of that courageous, romantic race the people of Ireland took it to their hearts and made it their own. Irish mothers sang it to their babies; sweethearts to their colleens—patriots to their heroic wives.

And whenever Erin's sons and daughters left the homeland they carried their song with them—in their hearts and on their lips—and soon every corner of the earth knew and sang the glory of smiling Irish eyes.

So it came back to the land of its birth to take its place among the world's immortal ballads.

In a long career as writer and publisher I have issued many famous songs but I am most proud of the privilege that is mine to-day: To publish the greatest of all Irish songs—"When Irish Eyes Are Smiling."

Fred Fisher

Fred Fisher Music Co., Inc.

1619 Broadway

New York City

WARNING!

PROFESSIONAL COPY
This copy is intended for the use of PROFESSIONAL SINGERS ONLY, and any
one found using it in connection with a performance, or in any other manner
without the express permission of the Copyright Owner, will be prosecuted under the Copyright Law of the U.S.A.

When Irish Eyes Are Smiling

For Trio

ORF. GRAFF, Jr.
CHAUNCEY OLCOTT
and ERNEST R. HALL

Fast



VERSE

There's a tear in your eye, And I wonder why, For it
For your smile is a part of the love in your heart, And in

Why should he there at all, With such
Makes a man's sun shine more bright, Like the

Power in your smile, Sure as stone you'll be true, So, there's
In this sweet song, Crying all the day long, Comes your

Copyright 1912 by M. Witmark & Sons
Copyright renewed to FRED FISHER MUSIC Co., Inc. 1940 Broadway New York, N.Y.
International Copyright Secured. Revised Version Copyrighted 1940 by Fred Fisher Music Co., Inc.
All Rights Reserved, including the right of public performance for profit. Made in U.S.A.

nev-er a tear-drop should fall. When your sweet smile is
 laugh-ter so ten-der and light. For the spring-time of

laugh-ter like some fair-y song. And your eyes twink-le bright as can
 life-is the sweet-est of all. There is neer a real care or re-

be- You should laugh all the while and all oth-er times, smile.
 gret. And while spring-time is ours through-out all of youth's hours.

And now smile a while for me.
 let us smile each chance we get.

When Irish Eyes Are Smiling 3

CHORUS

WHEN I RISH EYES ARE SMILING Sure its like a morn in
 spring In the lilt of I rish laugh-ter You can hear the
 an geis sing When I rish hearts are hap py All the
 world seems bright and gay And WHEN I RISH EYES ARE SMILING
 Sure they steal your heart a way WHEN way

When Irish Eyes Are Smiling

[fol. 60] IN DISTRICT COURT OF THE UNITED STATES

AFFIDAVIT OF GEORGE GRAFF, JR., IN OPPOSITION TO MOTION

STATE OF NEW YORK

County of New York, ss.:

GEORGE GRAFF, JR., being duly sworn, deposes and says:

I am one of the defendants in the above entitled action, and one of the authors of "When Irish Eyes Are Smiling," the song involved in the instant case.

This affidavit is submitted in opposition to plaintiff's motion for an injunction pendente lite to restrain the Fred Fisher Music Co., Inc., and myself from printing, publishing, copying or vending, or from making any use whatsoever of the song "When Irish Eyes Are Smiling."

I do not deny that on July 1, 1910, I entered into the agreement with the plaintiff, a copy of which is annexed to the complaint marked Exhibit "B".

In 1912, while my agreement with the plaintiff was in force, I, together with one Chauncey Olcott and one Ernest R. Ball, jointly composed the musical composition entitled "When Irish Eyes Are Smiling", the music thereof having been written by Mr. Ball and the lyrics thereof by Mr. Olcott and myself.

During the early part of 1917 I was in desperate financial straits. I stated to the plaintiff that I would be willing to release it from its obligation to pay me royalties on "When Irish Eyes Are Smiling" as well as on many other songs of mine which it was then publishing, in consideration of a lump sum payment in cash.

[fol. 61] At this time I had approximately seventy songs with the plaintiff and my royalties from these songs had amounted in previous years to as much as \$5000. annually. On May 19, 1917, I entered into an agreement with plaintiff, copy of which is annexed to the complaint herein and marked Exhibit "D". In this agreement I released the plaintiff from the obligation to pay any further royalties on a group of some seventy songs. In return I received a lump sum payment of \$1600. The copyrights on many of these songs had been secured just prior to 1917 and the plaintiff, therefore, was released from the duty to pay royalties thereon for a period of over twenty-five years thereafter. Among these seventy songs were included certain com-

positions which have now become world famous. Among these were "When Irish Eyes Are Smiling," "Till The Sands Of The Desert Grow Cold," "I Love The Name Of Mary," "As Long As The World Rolls On," "All The World Loves A Lover," "I Come To Thee," "Teach Me To Pray," "To The End Of The World With You," "Goodbye, My Love, Goodbye," and many others.

Naturally, the agreement of May 19, 1917, as well as the agreement of July 1, 1910, speak for themselves. I do wish to point out, however, that at the time these agreements were executed, neither the plaintiff nor I had any discussion regarding the disposal of my renewal copyrights.

In the year 1939, the question of the ownership of the renewal copyrights of some of my most important songs arose for the first time. The right to file application for a renewal copyright of "When Irish Eyes Are Smiling" came into being on August 19, 1939.

At this time I was advised by counsel that the renewal copyright to this song could only be obtained by me as [fol. 62] author and that this right was inalienable prior to the time when application for the renewal copyright could be filed. I was advised that the language contained in the agreements of July 1, 1910 and May 19, 1917 was ineffective to transfer any interest in my renewal copyrights.

I notified the plaintiff that I intended to make a new bargain with respect to my renewal copyright of "Irish Eyes", and I notified the plaintiff that it did not have any rights in the renewal copyright by virtue of its previous agreements with me.

I thereupon made a contract with the defendant, Fred Fisher Music Co., Inc., for the exploitation of the renewal copyright of the song. All of the facts regarding my prior agreements with the plaintiff were fully disclosed to the Fisher Company.

I believe it important on the present motion to refer briefly to some of the significant changes which have taken place in the music industry since "When Irish Eyes Are Smiling" was first copyrighted. These facts graphically illustrate the importance of the renewal copyright to the author.

In 1912, when the song was written and first published, the principal income to song writers from the exploitation of their work came from sheet music and phonograph records. For this reason, contracts dealing with the ex-

exploitation of songs dealt almost exclusively with these two main sources of revenue.

Since 1912, however, the invention of the radio, the talking motion picture, and of other mechanical devices for the production of music have materially changed the conditions under which music is exploited. As a result of these changed conditions, authors are now entitled to receive revenues from new sources by virtue of new uses of their music and contracts made for the exploitation of music in [fol. 63] 1912 are not longer applicable to the changed conditions of today.

For example, the licensing of synchronization rights of music for use in sound motion pictures results in a net revenue to song writers and publishers of approximately \$500,000 per year. This source of revenue only came into existence in 1927.

At the present time, music is electrically transcribed for broadcasting and other purposes. This use of music only originated in 1932 and since that date has yielded a net revenue to authors and publishers of approximately \$150,000 a year.

Income to song writers and publishers from radio broadcasting of popular music, as reflected in payments made to the American Society of Composers, Authors & Publishers, which was not in existence in 1912, amounts to over \$5,000,000 annually.

At this very moment, there is considerable discussion in the music industry about a totally new use for popular music called "Phonovision". This new method of exploitation contemplates the use of popular music in connection with small individual strips of film which are to be played in coin operated machines to be installed in bars, restaurants, dance halls and other places of popular music.

It is estimated that the revenue from this new source alone will run into many millions of dollars annually.

Not only have there been a great many new uses, with their attendant new sources of revenue to song writers, but the old uses, which were in existence in 1912, have become very much less important. For example, in 1912 and for a considerable time thereafter, a normal "hit" song sold at least 1,000,000 copies of sheet music. At the present time, even the very biggest hits will only sell about 50,000 copies of sheet music. Similarly, in 1912, the annual income to [fol. 64] song writers and publishers from the sale of

phonograph records was in the neighborhood of \$2,000,000. At the present time, this income is only about \$750,000.

Under the terms of my original publishing agreement with the plaintiff executed in 1912, I have no control over the exploitation of my song in connection with these uses, nor is there any definite provision covering the payment of royalties for the use of my music by these new methods. In brief, neither the plaintiff nor myself ever contracted with respect to these new uses.

The coming into being of renewal copyright, however, gives me the opportunity of making a new bargain for my song in the light of these new developments as well as in the light of the present intrinsic value of the song, which was obviously unknown at the time when it was first published.

Finally, I should like to point out that if I am deprived of the right to make a new bargain with respect to my renewal copyright I will lose not only the opportunity to take advantage of the new uses for music which have come into existence, but also I will not receive a single cent of royalties during the twenty-eight years of the renewal term. The agreement of May 19, 1917, if effective to transfer my renewal copyright to the plaintiff, would also transfer with it the right to receive any royalties during the renewal term.

I believe that as a matter of law I had the right to secure a renewal copyright and the right to thereupon assign it to the defendant, Fred Fisher Music Co., Inc. It may well be that the plaintiff is likewise entitled to publish the song at the present time as the assignee of Margaret O'Donovan Olcott, the widow of my co-author, Chauncey Olcott. The application, however, for an injunction pendente lite should [fol. 65] be denied, since irrespective of the plaintiff's right to publish the song the defendant, Fred Fisher Music Co., Inc., likewise has that right as the assignee of my renewal copyright.

Geo. Graff, Jr.

Sworn to before me this 5th day of December, 1940.
Morris Shilensky, Notary Public, Kings County,
Kings Co. Clks. No. 294, Reg. No. 2311, N.Y. Co.
Clks. No. 1348, Reg. No. 2 S 817. Commission
expires March 30, 1942.

[fol. 66] IN DISTRICT COURT OF THE UNITED STATES
 AFFIDAVIT OF JOHN SCHULMAN, IN OPPOSITION TO MOTION
 STATE OF NEW YORK,
 County of New York, ss.:

JOHN SCHULMAN, being duly sworn, deposes and says:

I am an attorney at law and a member of the firm of Hays, St. John, Abramson & Schulman, attorneys for the defendants, Fred Fisher Music Co., Inc. and George Graff, Jr., in the above entitled action.

This affidavit is submitted in opposition to plaintiff's motion for an injunction pendente lite.

Prior to July, 1938, Mr. Graff consulted me with regard to the status of the renewal copyrights of songs which he had written, which songs were then being published by the plaintiff.

There being some question regarding agreements made with the plaintiff, I advised Mr. Graff that it was my opinion that so-called assignments or agreements to transfer renewal copyrights made by an author in advance of the time when he might make application for such renewal copyrights were ineffectual as a matter of law.

At Mr. Graff's request, I communicated with A. M. Wattenberg, Esq., an attorney representing the plaintiff. I informed Mr. Wattenberg of the position that I had advised Mr. Graff to take. Incidentally, Mr. Wattenberg is familiar with my view of the law, as we have had a number of discussions on this point.

[fol. 67] I stated to Mr. Wattenberg that Mr. Graff would be willing to negotiate with the plaintiff for his renewal rights. Mr. Wattenberg, however, took the position that the plaintiff already owned Mr. Graff's renewal copyrights and that Mr. Graff had nothing further to convey.

The various conversations which took place between Mr. Wattenberg and myself were confirmed by correspondence. Copies of letters so exchanged are annexed to this affidavit, marked Exhibits "A" to "D", respectively.

John Schulman.

Sworn to before me this 5th day of December, 1940.
 Frederick Griffin, Notary Public, New York
 County. N. Y. Co. Clks. No. 346 Reg. No. 2G351.
 Kings Co. Clks. No. 169 Reg. No. 2254. Bronx Co.
 Clks. No. 45 Reg. No. 186G42. Queens Co. Clks.
 No. 811 Reg. 2523. Commission expires March 30,
 1942.

EXHIBIT "A", ANNEXED TO AFFIDAVIT OF JOHN SCHULMAN

July 1, 1938.

A. M. Wattenberg, Esq., 551 Fifth Avenue, New York City.

MY DEAR MR. WATTENBERG:

As I told you over the telephone, I have been consulted by George Graff regarding some of his songs which are coming up for renewal of copyright. In this connection, [fol. 68] I understand that there were some contracts with Witmark, of which I should like to have copies.

I should appreciate hearing from you as soon as possible.

Sincerely yours, (Signed) John Schulman.

JS: GS.

EXHIBIT "B", ANNEXED TO AFFIDAVIT OF JOHN SCHULMAN

October 18, 1938.

A. M. Wattenberg, Esq., 551 Fifth Avenue, New York City.

DEAR WATTY:

You will remember that I spoke to you about George Graff.

The compositions involved are those mentioned in the assignment of copyright dated May 19, 1917, a copy of which you sent me last July.

I should like to know if there is any possibility of coming to some agreement on his claim.

Sincerely yours, (Signed) John Schulman.

JS: GS.

[fol. 69] EXHIBIT "C", ANNEXED TO AFFIDAVIT OF JOHN SCHULMAN

October 19th, 1938.

John Schulman, Esq., 120 Broadway, New York City.

DEAR JOHN:

This is to acknowledge receipt of yours of October 18th, in re: George Graff.

Will you please let me know explicitly what the claim of your client is. With that before me, I will be able to give it proper consideration.

With kindest regards,

Sincerely, (Signed) Watty, A. M. Wattenberg.

AMW:PB.

[fol. 70] EXHIBIT "D" ANNEXED TO AFFIDAVIT OF JOHN SCHULMAN

October 21, 1938.

A. M. Wattenberg, Esq., 551 Fifth Avenue, New York City.

DEAR WATTY:

I have your letter of the nineteenth in regard to George Graff.

Graff's claim is simply that under the Copyright Law the renewal rights in his compositions revert to him, and that any continued exploitation by your client is in derogation of his rights.

I should like to know whether your client is interested in making some arrangement with Graff.

Sincerely yours, (Signed) John Schulman.

JS:GS.

[fol. 71] IN DISTRICT COURT OF THE UNITED STATES

REPLY AFFIDAVIT OF HERMAN STARR, IN SUPPORT OF MOTION

STATE OF NEW YORK,

County of New York, ss:

Herman Starr, being duly sworn, deposes and says: I am the President of M. Witmark & Sons, plaintiff herein, having executed the affidavit herein verified October 18th, 1940.

The present affidavit is in reply to the affidavit of defendant George Graff verified December 5th, 1940.

Defendant Graff states in his affidavit that during the early part of 1917, he was "in desperate financial straits". It is apparent that the construction which he now seeks to place on the renewal provisions of the copyright statute would certainly, if recognized in 1917, have impeded his

ability to make the May 1917 deal and receive the \$1,600 paid therefor.

The present practice of plaintiff is not to liquidate royalties agreed to be paid to authors by a flat sum, but rather to advance money against royalties to accrue during the original term and renewal term and to take an assignment of the renewal copyright as protection for the advance. Obviously, such transactions would be forbidden, if defendants' desired construction of the renewal provisions of the copyright law were upheld. Thus if defendants' desired construction of the renewal provisions of the copyright statute is upheld, an author, and for that matter the widow of an author dying before the 28th year, would be powerless before the 28th year to raise money by selling the renewal copyright or by assigning it in consideration of [fol. 72] an advance, regardless of how desperately such person were in need of cash.

Defendant, Graff, states that at the time he executed his general contract of July 1, 1910 and the May, 1917 agreement, no discussion was had regarding the disposition of the renewal rights. He admits, however, that the agreements speak for themselves. I should like to point out, however, that there is no one today associated with the plaintiff corporation who was a part of the management of plaintiff corporation either in 1910 or 1917 and thus we do not know the circumstances under which these agreements were executed. No explanation, however, is necessary since it is apparent from defendant, Graff's own affidavit that it was he and not plaintiff who desired to enter into the May 1917 transaction.

Deponent respectfully submits, therefore, that Graff and defendant Fisher, his present assignee, who took with full notice of Graff's transactions with plaintiff, should be bound by the agreements which Graff voluntarily entered into.

Defendant Graff also points out that since 1917, new arts for the recording or reproduction of music have developed. Deponent would like to reiterate that defendant Graff, being a member of the American Society of Composers, Authors and Publishers, participates in the revenues derived from the said Society from the use of Graff's music over the radio, in night clubs, hotels, cabarets, motion picture theaters and other places of entertainment.

(Sgd.) Herman Starr.

Sworn to before me this 13th day of December, 1940.
 (Sgd.) Joseph A. McLaughlin, Notary Public.
 Certificate filed N. Y. Co. No. 247.

[fol. 73] IN UNITED STATES DISTRICT COURT

FINDINGS OF FACT AND CONCLUSIONS OF LAW—May 26, 1941

Plaintiff herein having applied for a preliminary injunction against defendants, Fred Fisher Music Co., Inc. and George Graff, Jr., during the pendency of this action, and said application having come on to be heard, and an opinion herein having been made and rendered by the Court and filed on March 25th, 1941 granting said relief, I do now make the following Findings of Fact and Conclusions of Law:

FINDINGS OF FACT

1. Plaintiff is a New York corporation.
2. Defendant, Fred Fisher Music Co., Inc. is a New York corporation.
3. Defendant, George Graff, Jr. is a United States citizen and a resident of the Southern District of New York.
4. Plaintiff and defendant, Fred Fisher Music Co., Inc. are engaged in the business of printing, publishing and vending copyrighted musical compositions.
5. Prior to August 12, 1912, Ernest R. Ball, Chauncey Olcott and George Graff, Jr. jointly composed the song entitled "When Irish Eyes Are Smiling", hereinafter referred to as the "Song".
- [fol. 74] 6. At the time said song was thus jointly composed, said Ernest R. Ball and defendant George Graff, Jr. were under contract to plaintiff. Ball's contract with plaintiff is dated January 2, 1908, and is annexed to the complaint as Exhibit A. Defendant Graff's contract with plaintiff is dated July 1, 1910 and is annexed to the complaint as Exhibit B.
7. Under Ball's said contract with plaintiff, Ball covenanted and agreed, for valuable consideration, to deliver

to plaintiff any and all musical compositions which he alone, or in conjunction with others, would compose during the period of five (5) years commencing January 2nd, 1908, and he covenanted and agreed that all musical compositions thus composed by him during said five (5) year period would immediately, upon being composed, become and be the sole and absolute property of plaintiff, and be granted and conveyed to plaintiff

the copyright or copyrights of, with renewals and with right to copyright and renew, and property in any and all musical compositions which he may write or compose or acquire control of during said period of five (5) years.

Plaintiff agreed to pay Ball specified royalties.

8. Similarly under defendant Graff's said contract with plaintiff dated July 1, 1910, defendant Graff covenanted and agreed, for valuable consideration, to deliver to plaintiff any and all compositions which he alone, or in conjunction with others, would compose during the period of five (5) years beginning July 1, 1910, and he covenanted and agreed that any and all musical compositions which he would thus compose during said five (5) year period would [fol. 73] immediately, upon the same being composed, become the sole and absolute property of the plaintiff, and be granted and conveyed to plaintiff.

the copyright or copyrights of, with renewals and with right to copyright and renew, and property in any and all musical compositions which he may write or compose or acquire control of during the said period of five (5) years.

Plaintiff agreed to pay defendant Graff specified royalties.

9. Olcott, one of the three joint composers of the Song was not under contract to plaintiff, but prior to August 12, 1912, in consideration of the payment of specified royalties, he sold and assigned to plaintiff the Song and the copyright thereof and the right to take out copyright in plaintiff's name.

10. Thereafter and prior to August 12, 1912, pursuant to their respective agreements, Ball, Olcott and defendant Graff delivered the Song to plaintiff.

11. Thereafter, on August 12, 1912, pursuant to plaintiff's said respective contracts with Ball, Olcott and defendant Graff and in conformity with the copyright laws of the United States, plaintiff duly copyrighted the Song.

12. Since copyrighting the Song, plaintiff has published it and each published copy thereof has borne the proper statutory copyright notice.

13. On May 19th, 1917, defendant Graff, by instrument of the same date, for the sum of \$1600, released plaintiff [fol. 76] from any further obligation to pay him royalties for the Song and numerous other songs, and defendant Graff sold, assigned, transferred and delivered to plaintiff all his rights in the Song and other songs,

and all copyrights and renewals of copyrights and the right to secure all copyrights and renewals of copyrights in the same or in any arrangements or adaptations thereof, and any and all rights therein that I . . . may at any time be entitled to.

And I do, for myself . . . hereby irrevocably authorize and appoint the Publisher, its successor, successors and assigns, my attorneys and representatives, in my name

to take and do such actions, deeds, and things, and make, sign, execute and acknowledge all such documents as may from time to time be necessary to secure to the Publisher . . . the renewals and extensions of the copy-

right in said compositions and all rights therein for the term of such renewals and extensions. And I agree, for myself . . . upon the expiration of the first term of

any copyright in said composition, in this or in any other country, to duly make, execute, acknowledge and deliver or to procure the due execution, acknowledgment and delivery to the Publisher . . . of all papers necessary in order

to secure to it the renewals and extension of all copyrights in said compositions and all rights therein for the terms of such renewals and extensions.

This instrument of May 19, 1917 was duly recorded in the United States Copyright Office on November 19, 1935.

[fol. 77] 14. Defendant Graff is presently alive. His co-composers, Messrs. Ball and Olcott died prior to the beginning of the 28th year of the original copyright and each is presently survived by his respective widow.

15. On August 12, 1939, being within the period fixed by the Copyright Law for registering renewal copyrights, plaintiff, pursuant to defendant Graff's said instrument of May 19, 1917, and pursuant to authority from Olcott's widow, renewed the copyright in the Song in the name of defendant Graff and said Olcott's widow.

16. On August 12, 1939, pursuant to Graff's said instrument of May 19, 1917 plaintiff, as the attorney and representative of Graff, assigned to plaintiff the said renewal copyright in the Song by instrument of the same date, which instrument is annexed to the complaint as Exhibit "F" and which was recorded in the United States Copyright Office on August 12, 1939.

17. Thereafter on August 23, 1939, defendant Graff made personal application to the United States Copyright Office for a renewal registration of the copyright in the Song and by instrument dated October 24, 1939, which is annexed to the complaint as Exhibit "I", defendant Graff purported to assign to defendant Fisher, Graff's purported renewal copyright.

18. At the time defendant Graff executed said instrument of October 24, 1939 to defendant Fisher, both had full knowledge of plaintiff's rights, and of the prior renewal registration of August 12, 1939 in the name of defendant Graff and Olcott's widow, and the prior recorded assignment of that renewal registration of the same date to plaintiff, and the prior recorded instrument between plaintiff and defendant Graff of May 19, 1917.

[fol. 78] 19. Defendant Fisher relying solely and exclusively upon the said purported assignment from defendant Graff by the said instrument dated October 24, 1939 of defendant Graff's purported renewal copyright registration, and without any authority from plaintiff or anyone else other than defendant Graff, has published, offered for sale and sold, and is continuing to publish, offer for sale and sell, copies of the Song; has made an arrangement of the Song, and has offered for sale and sold and is continuing to publish, offer for sale and sell the said arrangement, and has represented to the trade and is representing to the trade that it owns the renewal copyright in the Song and threatens to continue all of the said acts.

20. Plaintiff has notified defendant Fred Fisher Music Co., Inc. in writing that said defendant has infringed the renewal copyright of plaintiff in the Song and that the infringement should cease, but defendant Fred Fisher Music Co., Inc. has continued to do all of the aforesaid acts after receipt of said written notice.

21. Plaintiff has suffered and will continue to suffer irreparable damage by virtue of the acts of defendants Fred Fisher Music Co., Inc. and Graff.

CONCLUSIONS OF LAW

1. The original copyright in the Song secured by plaintiff in plaintiff's name on August 12, 1912 was a valid copyright.

2. The renewal copyright in the Song secured by plaintiff on August 12, 1939 in the name of defendant Graff and of Chauncey Olcott's widow was and is a valid renewal copyright.

[fol. 79] 3. The contract between plaintiff and defendant Graff dated July 1, 1910 is a valid and binding agreement in its entirety.

4. The instrument of May 19, 1917 between defendant Graff and plaintiff was and is a valid and binding instrument in its entirety.

5. The assignment of August 12, 1939 by plaintiff, as the attorney and representative of Graff, to plaintiff of the renewal copyright in the Song was and is a valid and binding assignment.

6. The purported renewal copyright registration of the Song on August 23, 1939 by defendant Graff is invalid and void, and is a cloud upon plaintiff's title to and in the renewal copyright of the Song.

7. The purported assignment from defendant Graff to defendant Fisher dated October 24, 1939 of defendant Graff's purported renewal copyright registration in the Song is invalid and void and is a cloud upon plaintiff's title to and in the renewal copyright of the Song.

8. Defendant Graff and defendant Fisher have no right or interest of any nature whatsoever in and to the renewal

copyright in the Song, and have no right to claim or assert or represent to the trade or to anybody that they have any such right or interest.

9. Defendant Fred Fisher Music Co., Inc., has infringed plaintiff's renewal copyright in the Song by publishing, offering for sale and selling copies of the Song; by making a new arrangement of the Song and by publishing, offering for sale and selling copies of the said new arrangement.

[fol. 80] 10. Plaintiff is entitled to a preliminary injunction restraining defendant George Graff, Jr., his agents and servants, and defendant Fred Fisher Music Co., Inc. its officers, employees, agents and servants, during the pendency of this action and until the entry of final judgment, from printing, publishing, copying, vending or advertising or offering for sale the song entitled "When Irish Eyes Are Smiling", annexed to the complaint herein as Exhibit "L", and referred to herein as the Song, and from printing, publishing or vending or advertising or offering for sale the arrangement of the Song annexed to the complaint and marked Exhibit "M" or any other version or arrangement of the Song, and from arranging or adapting the Song, and from performing the Song publicly for profit, and from using the song upon parts of instruments serving to reproduce it mechanically, and from granting any license or permission to any person, firm or corporation to do any of the foregoing acts, and from making or licensing any reproduction or use whatsoever of the Song in whole or in part, or of any arrangement or version thereof in whole or in part, and from asserting any claim or interest in plaintiff's renewal copyright in the Song, or in any renewal copyright thereof.

Dated: New York, May 26th, 1941.

Edward A. Conger, U. S. D. J.

[fol. 81] IN UNITED STATES DISTRICT COURT

INTERLOCUTORY DECREE—May 26, 1941

Present: Hon Edward A. Conger, U. S. D. J.

Plaintiff having applied for a preliminary injunction against defendants, Fred Fisher Music Co., Inc., and George

Graff, Jr., during the pendency of this action, and said application having come on to be heard:

Now, upon reading the notice of motion herein dated October 18th, 1940, the affidavits of Herman Starr verified October 18th, 1940 and December 13th, 1940 respectively, and the summons and complaint herein; in support of said application, and the affidavit of George Graff, Jr., verified December 5th, 1940 and the affidavit of John Schulman, Esq., verified December 5th, 1940, in opposition to said application, and after hearing R. W. Perkins, Esq., attorney for plaintiff, by Stuart H. Aarons of counsel, in support of said application, and Hays, St. John, Abramson & Schulman, Esqs., attorneys for defendants by John Schulman, Esq., in opposition thereto, and it appearing to the satisfaction of the court after due deliberation that the plaintiff demands and is entitled to an order against defendants Fred Fisher Music Co., Inc. and George Graff, [fol. 82] Jr. restraining the commission of the acts set forth below and that said defendants are actually engaged in committing such acts, to the irreparable injury of the plaintiff, it is

Ordered that defendant Fred Fisher Music Co., Inc., its officers, employees, agents and servants, and defendant, George Graff, Jr., his agents and servants be and they hereby are enjoined and restrained during the pendency of this action and until the entry of final judgment herein from printing, publishing, copying, vending or advertising or offering for sale the song entitled "When Irish Eyes Are Smiling," annexed to the complaint herein as Exhibit "L," and referred to herein as the Song, and from printing, publishing or vending or advertising or offering for sale the arrangement of the Song annexed to the complaint and marked Exhibit "M" or any other version or arrangement of the Song, and from arranging or adapting the Song, and from performing the Song publicly for profit, and from using the Song upon parts of instruments serving to reproduce it mechanically, and from granting any license or permission to any person, firm or corporation to do any of the foregoing acts, and from making or licensing any reproduction or use whatsoever of the Song in whole or in part, or of any arrangement or version thereof in whole or in part, and from

asserting any claim or interest in plaintiff's renewal copyright in the Song, or, in any renewal copyright thereof.

Edward A. Conger, U. S. D. J.

Dated: New York, May 26th, 1941.

[fol. 83] IN UNITED STATES DISTRICT COURT

APPEARANCES:

R. W. Perkins, Esq. (Stuart H. Aarons, Stanleigh P. Friedman, of counsel), Attorney for Plaintiff.

Hays, St. John, Abramson & Schulman, Esqs. (John Schulman, Robert J. Burton, of counsel), Attorneys for Defendants.

OPINION—March 24, 1941

CONGER, D. J.:

This is a motion to enjoin pendente lite defendants Fred Fisher Music Co., Inc., and George Graff, Jr., from printing, publishing, copying or vending the song "When Irish Eyes Are Smiling." No preliminary relief is requested against the other defendant, Mills Music, Inc.

In 1912, Ernest Ball, Chauncey Olcott and defendant Graff jointly composed the song "When Irish Eyes Are Smiling", Ball writing the music, Olcott and Graff the lyrics. Ball and Olcott have since died.

At the time of song was written Graff and Ball were under general contract to plaintiff, whereby, for stated royalties, they transferred to plaintiff all their property in songs which they composed, and which contracts contained the following clause:

[fol. 84] " . . . and the party of the second part (Graff) hereby expressly grants and conveys to the party of the first part (plaintiff) the copyright or copyrights of, with renewals and with right to copyright and renew, and property in any and all musical compositions which he may write or compose or acquire control of"
Olcott, although not under a general contract, transferred to plaintiff all his rights to this song by a separate agreement. The song was copyrighted in the name of the plaintiff on August 12, 1912, and was thereupon published.

On May 17, 1917, Graff sold, assigned, transferred and delivered to plaintiff for \$1600 all his rights to some 69 songs, including the song in question, and which transfer provided, in part:

"... and all copyrights and renewals of copyrights and the right to secure all copyrights and renewals of copyrights in the same or in any arrangements or adaptations thereof, and any and all rights therein that I . . . may at any time be entitled to.

"And I do, for myself . . . hereby irrevocably authorize and appoint the Publisher, its successor, successors and assigns, my attorneys and representatives, in my name . . . to take and do such actions, deeds, and things, and make, sign, execute and acknowledge all such documents as may from time to time be necessary to secure to the Publisher . . . the renewals and extensions of the copyright in said compositions and all rights therein for the term of such renewals and extensions. And I agree, for myself . . . upon the expiration of the first term of any copyright in said composition, in this or in any country, to duly make, execute, acknowledge and deliver or to procure the due execution acknowledged [fol. 85] ment and delivery to the Publisher . . . of all papers necessary in order to secure to it the renewals and extension of all copyrights in said compositions and all rights therein for the terms of such renewals and extensions."

This instrument was recorded in the United States Copyright Office on November 21, 1935.

On August 12, 1939, plaintiff, upon the authority of the above contract and upon special authority of Mrs. Olcott, applied for the renewal registration in the name of Graff and Mrs. Olcott, which renewal copyright was registered in the name of Graff and Mrs. Olcott.

On August 13, 1939, plaintiff, in the name of Graff, and pursuant to the authority above stated, and as attorney-in-fact for Graff, assigned Graff's interest in the renewal copyright to itself and recorded the assignment in the United States Copyright Office on August 14, 1939.

On August 23, 1939, Graff made personal application to the United States Copyright Office for a renewal regis-

tration, and after its registration, on October 24, 1939, he sold this renewal copyright to defendant Fred Fisher Music Co. Inc.

The question presented by this motion is whether or not Graff's original contract with plaintiff, and his later 1917 agreement in which he purported to give to plaintiff the right to obtain the renewal copyright in his name are not invalidated by the Copyright Law and against public policy, and hence a nullity.

Section 23 of the Copyright Law, (17 U. S. C. A. 23) reads, in part, as follows:

"Duration; renewal. The copyright secured by this title shall endure for twenty-eight years from the date of the [fol. 86] first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name; . . . And provided further, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work when such contribution has been separately registered, the author of such work, if still living; or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children of the author be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright; . . ."

This section specifically provides that if the author be living, he alone has the privilege of obtaining the renewal in the twenty-eighth year, and if he be dead, the renewal privilege depends on the status of the persons mentioned in the statute who are living in the twenty-eighth year. (Fox Film Corp. v. Knowles, 261 U.S. 326.)

* All reference to the renewal rights of the widows of Olcott and Ball have been omitted since this motion is concerned with only the claim of Fisher, which is based on the claim of Graff.

When Congress passed this section of the statute, the Committee to which the bill had been referred, rendered a report which reads as follows:

"Section 23 deals with the term of the copyright. Under existing law the copyright term is twenty-eight years, with the right of renewal by the author, or by the author's widow or children if he be dead, for a further term of four- [fol. 87.] teen years. The act of 1790 provided for an original term of fourteen years, with the right of renewal for fourteen years. The act of 1831 extended the term to its present length. It was urged before the committee that it would be better to have a single term without any right of renewal, and a term of life of fifty years was suggested. Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right."

The renewal is a new right which accrues only upon application in the twenty-eighth year. (Fox Film Corp. v. Knowles, supra; White-Smith Music Pub. Co. v. Goff, 187 Fed. 247; Silverman v. Sunrise Pictures Corp., 273 Fed. 909; Danks v. Gordon, 272 Fed. 821; Harris v. Coca-Cola Co. 73 F. (2d) 370).

Defendants contend that the right of renewal could not be disposed of, alienated or assigned by Graff prior to the twenty-eighth year of the original copyright. Defendants state that, consequently, the agreements made by Graff prior to August 12, 1939 (the beginning of the twenty-eighth year) purporting to dispose of, alienate or assign, or agreeing to dispose of, alienate or assign the renewal copyright is unenforceable.

With defendants' contention I cannot agree. There is no doubt but that an ordinary assignment of the original copyright (similar to Graff's first assignment herein), [fol. 88] without specifically providing for the renewal of the copyright by the assignee in the author's name, would not give to plaintiff the right to apply for the renewal

copyright, in its own name or in the name of the author. (White-Smith Music Pub. Co. v. Goff, supra; Silverman v. Sunrise Pictures Corp., supra). Nor, if Graff had died, could his purported assignment of the renewal copyright be binding on his widow, executor, etc. (Fox Film Corp. v. Knowles, supra).

However, in the case at bar, Graff has specifically agreed to assign his personal right to the renewal copyright, and hence, if he be alive, which he is, he should be bound by his contract. In the case of Tobani v. Carl Fischer Inc., 98 F. (2d) 57, (cert. denied 305 U. S. 650), the Circuit Court for this Circuit stated:

"The statute (§24) clearly provides that an additional term will vest in the author if he is living but he may divest himself of the right thus reserved for him by parting absolutely with his entire interest in a work or by an agreement to convey the copyright for the additional term when it shall be secure. In the former instance, he has no interest in the work, and cannot rightly claim an additional privilege granted by the statute. In the latter case, he is bound by his agreement to transfer to another the right when it shall accrue to him. The author here parted with his absolute property in the work and could not himself, if living, secure a renewal of the copyright."

"Although the case at bar is distinguishable from the cited case above on the facts, in that there the publisher or employer became the "author" of the copyrighted articles which were created for hire, nevertheless, the language from that case, in my opinion, is applicable to the situation herein.

[fol. 82] The cases cited by defendant in support of its position herein that it is against public policy for an assignee to obtain a renewal, even when that assignee has the authority to secure such renewal in the name of the author, treat such violations of public policy only in relation to an assignee of an original copyright attempting to secure a renewal; and these cases do not consider an agreement by the author to assign a renewal such as here present. In fact, language in some of these cases would seem to support plaintiff's contention. For instance, in White-Smith Music Pub. Co. v. Goff, supra, the court said:

"It is therefore at least clear that, by the express terms of the statutes, whether the one existing when this copy-

right was taken out or the one existing when the extension was applied for, no one except the author or the members of his family or his executors could ordinarily apply for the extension; and this independently of any question for whose benefit the author or the other applicant might hold the copyright when acquired."

And in *Tobani v. Carl Fischer Inc.*, supra, it is stated:

"It is quite possible that, while an author cannot by any form of contract authorize his assignee to obtain the renewal, yet he may estop himself from asserting it against the assignee, or may bind himself to hold the renewal copyright as trustee for his assignee, but such estoppel or trust obligation would be personal to the author and would not bind the widow, widower, children, etc. in case of the author's death before accrual of the right to renew, because they do not take under, or in privity with, the author, but by virtue of an independent statutory grant."

[fol. 90] The Attorney General of the United States, in an opinion on this subject, said:

"When the application for renewal is presented to the register of copyrights, the only thing left for his consideration is whether the applicant is one of the persons designated in the statute. But who may possess the legal or equitable right in the copyright after renewal is another question, and one which is to be determined by the terms of such contract as the author or other person or persons entitled to the renewal may have entered into before or after the renewal is had. (28 Op. Atty. Gen. 162).

And again, the Attorney General stated:

"And no doubt it (the renewal copyright) may be the subject of a valid contract before renewal, which would carry the equitable, if not the legal, title thereto when received. (28 Op. Atty. Gen. 169).

It would seem that the main intent of Congress was to give a separate right to authors to the fruits of their labors in the renewal copyright. This prevented proprietors and assignees of the original copyright from securing a renewal, but Congress did not; nor does it appear that the statute

prevents the author from specifically and separately agreeing to assign, and assigning, his own renewal rights when, and if, these renewal rights accrue.

The contract to give the renewal right is not similar to the assignment of the interest of a beneficiary in the income of a trust, nor to the assignment of a receiver's or executor's fees; nor to the right to file a mechanic's lien; nor to the right to receive alimony, which rights are, respectively, against public policy. The question herein is not analogous. [fol. 91] I have made a rather exhaustive search of the works of text-book writers on the subject of copyrights. While I have not quoted any of them, I find the majority are in accord with the holding herein.

In deciding this case I have not cited the cases of *Cowen v. Banks*, 24 How. Prac. 73 and *Paige v. Banks*, 80 U. S. 698, for the reason that there is some doubt as which statute was controlling, 1790 or 1831. The distinction is that under the statute of 1790 a renewal could be claimed not only by the author, but also by his assignee. While the statute of 1831 is practically similar to the present statute on this point, the contracts construed in each of the above cited cases were contracts made prior to 1831.

Some question may be raised that, although plaintiff has the right to the renewal copyright, the procedure of obtaining the renewal herein is defective. However, there appears to me to be no material advantage gained in forcing plaintiff to bring an action for specific performance, or for a declaration of a trust in the author, for the benefit of plaintiff.

The motion for an injunction pendente lite, therefore, is granted as requested herein. Settle order on notice.

March 24, 1941.

U. S. D. J.

[fol. 92] IN DISTRICT COURT OF THE UNITED STATES

NOTICE OF APPEAL—June 20, 1941

Sirs:

Notice is hereby given that Fred Fisher Music Co., Inc. and George Graff, Jr., two of the defendants above-named, hereby appeal to the United States Circuit Court of Appeals for the Second Circuit, from the order granting the

plaintiff an injunction during the pendency of this action entered on the 26th day of May, 1941.

Dated New York, New York, June 20th, 1941.

Yours, etc., Hays, St. John, Abramson & Schulman,
Attorneys for Defendants, Fred Fisher Music Co.,
Inc. and George Graff, Jr., Office & P. O. Address:
120 Broadway, Borough of Manhattan, City of
New York.

To Clerk of the United States District Court for the
Southern District of New York. R. W. Perkins, Esq., At-
torney for Plaintiff, 321 West 44th Street, New York, New
York. Samuel Jesse Buzzell, Esq., Attorney for Defendant,
Mills Music Inc., 551 Fifth Avenue, New York, New York.

[fol. 93] IN UNITED STATES DISTRICT COURT

[Title omitted]

STIPULATION AS TO RECORD—September 25, 1941.

It is hereby stipulated and agreed that the foregoing is
a true copy of the transcript of the record of the said Dis-
trict Court in the above-entitled matter as agreed on by the
parties.

Dated New York, September 25, 1941.

Hays, St. John, Abramson & Schulman, Attorneys for
Defendants, Fred Fisher Music Co., Inc. and
George Graff, Jr. R. W. Perkins, Attorney for
Plaintiff.

[fol. 94] Clerk's Certificate to foregoing transcript omit-
ted in printing.



[fol. 95] UNITED STATES CIRCUIT COURT OF APPEALS FOR THE
SECOND CIRCUIT, OCTOBER TERM, 1941

No. 123.

(Argued December 12, 1941. Decided February 11, 1942)

M. WITMARK & SONS, Plaintiff-Appellee,

v.

FRED FISHER MUSIC CO., INC., GEORGE GRAFF, JR., Defendants-Appellants,

and

MILLS MUSIC, INC., Defendant

Appeal from the District Court of the United States for
the Southern District of New York

Action by M. Witmark & Sons against Fred Fisher Music Co., Inc., George Graff, Jr., and Mills Music, Inc., for copyright infringement. From an interlocutory decree enjoining the two first-named defendants *pendente lite* from printing, publishing, copying, or vending the song "When Irish Eyes Are Smiling," 38 F. Supp. 72, they appeal. Affirmed.

Before Augustus N. Hand, Clark and Frank, Circuit
Judges

[fol. 96] Stuart H. Aarons, of New York City (R. W. Perkins, of New York City, on the brief), for plaintiff-appellee.
John Schulman, of New York City (Hays, St. John, Abramson & Schulman and Milton Sargoy, all of New York City, on the brief), for defendants-appellants.

CLARK, Circuit Judge:

We are presented with a question of statutory construction which has apparently never arisen before, though the general statutory provision has existed for over a hundred years. Simply stated, the problem is whether or not a copyright holder may assign his expectancy of the renewal right which arises under 17 U. S. C. A. §23 at the expiration of the original twenty-eight year copyright grant. The district court upheld the validity of the assignment. 38 F. Supp. 72. This was in accordance with a strong dictum of this court in the case of *Tubani v. Carl Fischer, Inc.*, 2 Cir., 98 F.

2d 57, 60, *certiorari* denied 305 U. S. 650, 59 S. Ct. 243, 83 L. Ed. 420. We think it interpreted the law correctly.

The question arose in connection with the renewal of the copyright on the song "When Irish Eyes Are Smiling." One of the defendants, George Graff, Jr., collaborated in the writing of this song in 1912, at which time he was acting under a general agreement to assign all copyrights to the plaintiff, M. Witmark & Sons, with a reservation of royalties. Five years later, Graff has stated, he was in financial difficulties; at any rate he then entered into a second agreement with the plaintiff by which for the consideration of \$1,600 he released all his royalties on some sixty-nine [fol. 97] songs, including "When Irish Eyes Are Smiling," and also made a further assignment of the renewal rights. This further assignment purported to bind Graff and his heirs, executors, administrators and next of kin," and granted an irrevocable power of attorney to plaintiff to execute in Graff's name or that of his heirs, etc., all documents necessary to secure the renewal of the copyright and all rights therein for the term of the renewal. That is, the assignment was supported by the traditional power of attorney to enforce its terms, which has historically been the bridge whereby assignments anciently not recognized "at law" were actually made effective according to the intent of the parties.² Cook, *The Alienability of Choses in Action*, 29 Harv. L. Rev. 816, 822, 824; Ames, *Lectures on Legal History*, 213, 214; 34 Yale L. J. 409; *In re Barnett*, 2 Cir., — F. 2d —, —. This agreement, dated May 19, 1917, was duly recorded in the Copyright Office on November 19, 1935.

On August 12, 1939, the first day of the twenty-eighth year of the copyright in question—renewals must be applied for within that year—plaintiff entered an application for renewal in Graff's name, registered the renewal in Graff's name, assigned the renewal copyright to itself, and recorded the assignment. Eleven days later Graff applied for his renewal and assigned this renewal to defendant Fred Fisher Music Co.¹ When Fisher threatened to publish the

¹ It should be noted that Chauncey Olcott and Ernest Ball, who collaborated with Graff, died before the renewal period. Olcott's widow assigned her renewal to the plaintiff; Ball's widow assigned hers to defendant Mills Music, Inc. Since Mills does not threaten to publish the song, the injunction does not run against it.

song, the plaintiff instituted this action asking for an injunction, accounting, and damages, and moved for an injunction *pendente lite*. On the grounds that the assignment was valid, the motion was granted below and this appeal followed.

[fol. 98] We start with the statute. It says that "the author * * * if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright * * * for a further term of twenty-eight years when application for such renewal and extension shall have been made * * * within one year prior to the expiration of the original term of copyright." 17 U. S. C. A. §23. It is conceded by all concerned that this creates only an expectancy, and that in any event the author must be alive on the first day of the twenty-eighth year in order to obtain a renewal. An assignment of this expectancy likewise must rest also on survival. It is also apparent that the assignment here would not have cut off the rights of renewal extended to the widow, children, executors, or next of kin, in the event of Graff's death prior to the renewal period. See *Fox Film Corp. v. Knowles*, 261 U. S. 326, 43 S. Ct. 365, 67 L. Ed. 680. The only contested point is whether or not the statute absolutely forbids assignment. Certainly the passage does not say it does. There are no words that an assignment "shall be void and of no effect," as, for example, in 38 U. S. C. A. §129, dealing with the pledge or transfer of a pension. If we had no more than the words of the statute to go on, we could hardly find in that a restraint on freedom of assignment.

Reliance is had, however, upon the statutory history. The Copyright Act of 1790 said that the "exclusive right shall be continued to [the author], executors, administrators or assigns." 1 Stat. 124. In 1831, the Act was amended; and in changing the renewal provision to approximately its present form, the words "executors, administrators or assigns" dropped out. 4 Stat. 436. This, we are [fol. 99] told, indicates that assignments are not tolerated.²

² In *Paige v. Banks*, 13 Wall. 608, 20 L. Ed. 709, the Court upheld an assignment made in 1828, as a transfer of a right of renewal *after* and under the Act of 1831. Assignment of

But it may just as well be argued that the statute sought only to prevent an assignment that would cut off the widow's and children's rights in case the author died; or that Congress intended only the author and his family to be able to get a renewal, and thus "executors, administrators" went out along with "or assigns"; or, as said in *White-Smith Music Pub. Co. v. Goff*, 1 Cir., 187 F. 247, 250, that Congress enacted "an entirely new policy, completely dissevering the title, breaking up the continuance in a proper sense of the word, whatever terms might be used, and vesting an absolutely new title *eo nomine* in the persons designated." All that this says, however, is that assignment of copyright is not assignment of renewal; that renewal is an expectancy, not a present right. It does not express a public policy against disposal of the possibility of renewal. We cannot find a policy of "void and of no effect" in this change. Nor do the *Goff* case and others like it express such a policy. At most they indicate that an assignment would have to be like the one in this case to be effective. And since the issue was not present in those cases, it was not passed upon. See *Fox Film Corp. v. Knowles*, *supra*; *Silverman v. Sunrise Pictures Corp.*, 2 Cir., 273 F. 909, 19 A. L. R. 289, *certiorari* denied 262 U. S. 758, 43 S. Ct. 705, 67 L. Ed. 1219.

More to the point is the Congressional Report on the Act of March 4, 1909, which is the present statute, 17 U. S. C. A. §23—except for a slight textual change of 1940, here immaterial. The committee was supporting the decision to extend the right of renewal another fourteen years to make a [fol. 100] total renewal period of twenty-eight years, and it stated its preference for this arrangement, rather than a single and longer term as for life or fifty years. So it said: "Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your com-

the contingent right of renewal was upheld under the English statute, 8 Anne, c. 19, 1709. *Carnan v. Bowles*, 2 Bro. C. C. 80, 29 Eng. Rep. 45, 1786.

We see little that illuminates our present issue in the Committee Reports on the 1831 Act. Register of Debates, vol. 7, App. cxix.

mittee felt that it should be the exclusive right of the author to take the ~~renewal~~ term, and the law should be framed as is the existing law, so that he could not be deprived of that right.

"The present term of twenty-eight years, with the right of renewal for fourteen years, in many cases is insufficient. The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period that there would be ~~no probability~~ of its being taken away from him in his old age, when, perhaps, he needs it the most." H. R. Rep. No. 2220, 60th Cong., 2d Sess., p. 14. The House Report was adopted by the Senate Committee on Patents as its own. Sen. Rep. No. 1108, 60th Cong., 2d Sess.

We think it fair to say that defendants' case substantially depends on this quotation, as expressing a clear intent as to the statutory meaning and one to which we should give effect. But several observations must be made about it, for it contains its own ambiguities. Its direct purpose was clearly to explain the *continuance* of a renewal term as against the substitution of a single long term. In other words, it argued for an existing arrangement—"the existing law"—and so not necessarily or clearly for an absolute prohibition. If the committee had really meant the latter, they could easily have so drafted the statute. And they could easily have stated their purpose in unambiguous words in their report. As it is, their own words are almost [fol. 101] as ambiguous as the statute itself. They said the author "could not be deprived of" the right to renew. Does this mean he could not be deprived of it if he "sells his copyright outright to a publisher"?³ If so, we agree. Or did they mean that a court was to strike down the author's

³ One treatise on copyright states that publishers sought unsuccessfully to induce the committee to include an amendment requiring author and assignee publisher to unite in renewal, thus preserving a publisher's investment in plates. Bowker, Copyright, 1912, 117. This establishes nothing more than the committee report does. Publishers are still dependent on the author's survival. Probably they would have liked to secure more than a precarious expectancy; that they were unsuccessful does not show that even that was taken away.

attempt specifically to dispose of his expectancy? If so, "deprive" was a poor word to use, for the result is that he is "deprived" of his privilege to alienate his renewal right, not saved from "deprivation" of the right itself. As for the statement about the "probability of its being taken away from him in his old age," this is no more than a repetition of the same thought, and suffers from the same ambiguity.

If we could find that the statute had been interpreted—in the light of the committee's report—to forbid such assignments as we find here, we might well be inclined to give the committee the benefit of any doubts as to the language they had chosen.³ Meaning is frequently obscure, and courts may well be sympathetic to clear Congressional statements of what they think they are doing. *United States v. Dickerson*, 310 U. S. 554; 60 S. Ct. 1034, 84 L. Ed. 1356; *Hamilton and Braden, The Special Competence of the Supreme Court*, 50 Yale L. J. 1317, 1357-1367; cf. *Radin, Statutory Interpretation*, 43 Harv. L. Rev. 867. But we do not find such interpretation; so far as we can ascertain, the general view has been to the contrary. Soon after passage of the Act, Assistant Attorney General Fowler observed that "no doubt it [the renewal] may be the subject of a valid contract before renewal, which would carry the equitable, if not the legal, title thereto when [vol. 102] renewed." 28 Ops. Atty. Gen. 162, 169. Such also appears to have been the attitude of the people affected by copyright law as manifested in the treatises on the subject. Four treatises published before 1909 are definite in stating that an author may validly assign his expectancy of renewal,⁴ and none that we have found deny it. After 1909, it is true that some of the experts tended to hedge. Four treatises published after the new act went into effect state that probably an assignment can be enforced;⁵ but

⁴ Drone, *The Law of Property*, 1879, 326, 332; MacGillivray, *The Law of Copyright*, 1902, 267; 2 Morgan, *The Law of Literature*, 1875, 230; Curtis, *The Law of Copyright*, 1847, 235.

⁵ Marchetti, *Law of the Stage, Screen and Radio*, 1936, 67; DeWolf, *Outline of Copyright Law*, 1925, 66; Weil, *Copyright Law*, 1917, 367; Bowker, *Copyright*, 1912, 117.

three others are fairly definite about it.⁶ Only one of those we have found seems to deny assignability.⁷ Of particular interest is Wittenberg's treatise on Literary Property cited in the footnote. He purports to set out model contracts to be used by authors and publishers, and by authors and motion picture producers for movie rights. In the publishing contract, he admonishes the author to retain the copyright in his own name and grant only an exclusive right. But Wittenberg also insists that a provision be included whereby an author agrees to obtain a renewal and to assign the exclusive right under the renewal. This, he says, is because "the right to renew copyright . . . rests with the author, and he should agree to renew for the joint protection of himself and the publisher." Wittenberg, 195-196. [fol. 103] A similar clause is contained in the model movie rights contract. *Ibid.* 261.

Here, then, is a substantial number of writers on the subject all tending to say the same thing: that only an author can renew, but that he can make binding agreements to renew for someone's benefit. It seems not unreasonable to conclude from this that such a belief doubtless exists throughout the trade. Naturally, neither this belief, if it exists, nor the authorities themselves in any way bind us. Yet some weight may be attached to the fact that an ambiguous statutory provision has fairly uniformly been interpreted one way, and presumably acted upon.

Perhaps even more persuasive is the history of further attempts to amend the copyright laws. The attempts were aimed at general revision, usually including a change in the duration of the copyright; but for our purposes only the provisions relative to the preservation of the status of copyrights existing at what would be the time of enactment of these bills are of interest.

⁶ 2 Laidas, International Protection of Literary and Artistic Property, 1938, 773; Wittenberg, Literary Property, 1937, 45; Fröhlich & Schwartz, The Law of Motion Pictures, 1918, 549.

⁷ Andur, Copyright Law and Practice, 1936, 532-538, 540-541. His long discussion is unilluminating, however, for he appears not to have considered any problem but that of the assignee's renewing in his own name.

In two bills we find this passage: "*Provided*, that where the author has . . . agreed to part therewith for the renewal term under said act" [with terms following to make the renewal contract fit the time periods of the proposed act]. H. R. 6990, 71st Cong., 2d Sess.; H. R. 10434, 69th Cong., 1st Sess. And in two others this provision appears where . . . the author has agreed to renew the copyright for the renewal term for the benefit of the assignee or licensee" [with similar terms following]. H. R. 11948, 72d Cong., 1st Sess.; H. R. 10976, 72d Cong., 1st Sess. Still a fifth bill, which passed the House, says much the same thing in only slightly different words. H. R. 12549, 71st Cong., 3d Sess.⁸ This, we conceive, constitutes a recognition, on the part of the drafters at least, of the validity under the 1909 Act of Assignment of expectancies.⁹ A somewhat more direct acknowledgment of the validity of assignments is found in three other bills. These provide that the continuation of the copyright beyond twenty-eight years shall vest "in the person or persons . . . who would have been entitled to the renewal term . . . subject to any agreement valid in law or equity, which may have been made for the disposal of the renewal term prior to the date when this section, as amended, takes effect." H. R. 926, 76th Cong., 1st Sess.; H. R. 5275, 75th

⁸ The committee report on this bill appears to recognize assignments, for it speaks of retaining the "absolute reversion" of renewal—to "parallel" that of the 1909 Act—in the author's representatives, "regardless of his assignments." H. R. Rep. No. 1689, 71st Cong., 2d Sess., p. 10.

⁹ We may point out that the terms provided for in the bills were: (1) if the original copyright assignment was on a royalty basis, the same royalty was to be paid during the renewal period; (2) if the original copyright had been sold for a lump sum, two bills said the same sum should be paid again, and two bills said "the author and/or the owner shall be entitled to the [renewal], upon performance of such conditions as may be determined by agreement, or in the absence of an agreement . . . by the court, as justice may require." That Graff would probably have obtained a further payment from the plaintiff had any of these bills passed is immaterial so far as the present discussion is concerned.

Cong., 1st Sess.; S. 2240, 75th Cong., 1st Sess.¹⁰ All told, those Congressmen interested in copyright law seem to have taken it for granted that an author could agree to assign the renewal to someone. If they went that far, undoubtedly they would agree that an author could authorize someone to act in his name when the renewal period arrived.

Notwithstanding this history, we might well be moved by a demonstration that only by holding all assignments void could we further the policy of the act. But even this seems to us quite doubtful. True, it would be nice for an author to look forward to more money when the renewal [fol. 105] time comes. But he can do that by not assigning. What we would be saying is that all authors who have already assigned can eat their cake and have it too. Only in the future would such a ruling be fair all around. Furthermore, it is not clear that authors wish to be deprived of the privilege of obtaining more money now, or that a widow whose husband dies penniless wishes to be deprived of the privilege of anticipating on her statutory renewal right. We are, in effect, asked to impose forced saving on authors and widows by requiring them to forego for twenty-eight years whatever additional money they could obtain by assignment of their expectancies. It should require more than an ambiguous committee report on an ambiguous statutory provision to produce such a drastic restriction on free assignability.

This conclusion is reinforced by the history of judicial disapproval of restraints on assignability. Thus lawyers discovered a way around the archaic rule against assignment of choses in action, courts of equity supported them directly, and courts of law winked at the result. Cook, *op. cit. supra*. Equally familiar are the general rules against restraints on alienation of property.¹¹ There may

¹⁰ It is worth mentioning that the quoted section appears to be inconsistent with an earlier section which seems to deny the validity of such agreements. Compare § 24 with § 23, H. R. 926, *supra*. The explanation seems to be that § 23 referred only to unpublished works.

¹¹ Carey and Schuyler, *Illinois Law of Future Interests*, 1941, c. 13, esp. §§ 421, 434, 439; Schnebly, *Restraints Upon the Alienation of Legal Interests*, 44 *Yale L. J.* 961-995, 1186-1215. Schnebly says (at 961): "Indeed, a substantial

be mentioned, also, the unsuccessful attempts of employers to prevent wage assignments; and the consequent specific legislation forbidding or regulating such assignments. One such statute was even declared unconstitutional. *Massie v. Cessna*, 239 Ill. 352, 88 N. E. 152; see, generally, Fortas, [fol. 106] *Wage Assignments in Chicago*, 42 Yale L. J. 526. And there is the unusual case of an unenforceable assignment of an interest under a spendthrift trust being enforced by the pleasant fiction of calling it a "contract to assign," with the amount assigned as the measure of damages. *Kelly v. Kelly*, 11 Cal. 2d 356, 79 P. 2d 1059; 48 Yale L. J. 666. Further, there is our own recent holding that an assignment of an expectancy under a will is valid, *In re Barnett*, *supra*; 3 Restatement, Property, § 316; and generally of contingent interests in modern law, 2 Restatement, Property, § 162. Our society still rests on the theory that men can ordinarily make free disposition of their property rights. We are perfectly willing to uphold a Congressional declaration that public policy forbids assignment of a copyright renewal; but we expect something more than ambiguous inferences drawn from a committee report explicitly arguing only for continuance of an existing statutory scheme with a new renewal period. If property rights are to be rendered immediately untranslatable into money or money's worth, in order to protect remote and contingent future gains, that result should be accomplished by legislative declaration, not by judicial fiat.

We are limiting our discussion, as did the parties before us, to the question of statutory interpretation. On this interlocutory issue we ought not to foreclose other contentions which the parties may wish and be entitled to raise on the merits, including possibly claims of inadequacy of consideration in 1917, so gross as to prevent negative enforcement of the assignment, with which would go the question of adequacy of damages as a remedy for breach. 2

portion of the history of real property law consists in the record of various legal devices whereby it was sought to make land inalienable, and of the means whereby the courts thwarted those efforts in order to protect what they deemed to be the larger social good." See, also, *Dr. Miles Medical Co. v. John D. Park & Sons Co.*, 220 U. S. 373, 404; 31 S. Ct. 376, 55 L. Ed. 502, 517; *Bobbs-Merrill Co. v. Straus*, 210 U. S. 339, 28 S. Ct. 722, 52 L. Ed. 1086.

Restatement, Contracts, §§ 358, 363, 367, 380. But we think we should say that the record contains no evidence which casts doubt on the consideration; certainly defendant Graff's statement that royalties on the songs covered by the assignment had amounted to as much as \$5,000 annually (i.e., as a maximum) does not do so, particularly in view of the well-known ephemeral nature of popular song hits. Indeed, defendants base their assertion of the songs' present value on the new developments of radio, electrical transcription, and sound motion pictures. And their advertising adds that sung by Oleott "for a year or two and then having lived its hour, it seemed destined to be forgotten" until "a Dublin minstrel," returning "to his native isle," made it part of "the folk lore of Ireland," whence it came back here to a seemingly delayed, albeit considerable, present success.

Affirmed.

FRANK, C. J., dissenting:

1. From most interlocutory orders there is no appeal. From an interlocutory injunction, because of its marked capacity for harm, Congress permits an appeal. Unusual caution should be exercised in the issuance of such an order. Cf. *Watson v. Buck*, 313 U. S. 387. In the case at bar, the preliminary injunction seriously intrudes on defendants, restraining them from continuing sales—which had been going on for about a year—of the copyrighted song and adversely affecting their good will. That order was improper if, on the facts presented, assuming, for present purposes, that they will be the facts on final hearing, it seems unlikely that plaintiff will be granted the final relief sought, a decree for specific performance.¹ I think the order should be re-

¹The district court said in its opinion: "Some question may be raised that although plaintiff has the right to the renewal copyright, the procedure of obtaining the renewal herein is defective. However, there appears to me to be no material advantage gained in forcing plaintiff to bring an action for specific performance, or for a declaration of trust in the author for the benefit of plaintiff."

Plaintiff, in its brief, relied on *G. Schirmer v. Robbins Music Corp.*, 28 N. Y. S. (2d) 699 (1941) which, said plaintiff, "accepted the decision of the court below as controlling upon the State Court in decreeing specific performance of a similar contract."

[fol. 108] versed, because on the facts as they now appear, a court of equity should not grant specific performance, in the light of the subject matter of the contract, the circumstances and relations of the parties when it was made, and the consideration paid.

In 1917, when the contract was made, the plaintiff was a successful publisher, and the defendant Graff, an author or lyricist. It is admitted on this record that Graff was then "in desperate financial straits." By that agreement, Graff

(a) released plaintiff from the obligation, existing under an earlier agreement, to pay to defendant, over a considerable future period, annual royalties, on a group of some seventy songs, which royalties "had amounted in previous years to as much as \$5000 annually"; and

(b) contracted to give plaintiff his personal contingent rights to renew the copyrights on those seventy songs, if ever those rights should later ripen, i.e., if Graff should live twenty-two years longer, until 1939.

The consideration was a lump sum payment to Graff of \$1600. The released royalties alone were almost certain, in a short period, to equal the entire consideration of \$1600; on that basis, nothing was actually received for the renewal rights. But even if we assume that nothing was paid for the released royalties and the entire \$1600 was paid for the renewal rights, then, as there were seventy songs, the amount paid for the renewal right to the particular song involved in this suit was one-seventieth of \$1600 or about \$23. The right to renew a copyright twenty-two years later—a right which on no assumption could have any worth to the purchaser unless the author lived for twenty-two years [fol. 109] more—was, of course, highly speculative in value. The speculation has proved immensely valuable for the plaintiff.²

²The present value of the renewal right to the song in suit is not estimated in the moving papers. However, it was used 6,335 times on the radio in 1939, and there are a number of prospective profitable uses which have come into being since the date of the assignment, such as electrical transcriptions for radio, motion-picture sound tracks, coin-operated public phonographs and radio broadcasting. In

In considering those facts, we should take judicial notice of the economic capacities and business acumen of most authors. In ascertaining that certain persons, because "often under economic compulsion," constituted a "necessitous class," our present Chief Justice, in 1928, used, judicially, off-the-record knowledge which no casual inquiry would elicit—such as the contents of a report by the City Club of New York, of the Proceedings of the Association of Governmental Labor Officials, and the like.³ We need not go nearly so far here. We need only take judicial notice of that which every schoolboy knows—that, usually, with a few notable exceptions (such as W. Shakespeare and G. B. Shaw), authors are hopelessly inept in business transactions and that lyricists, like the defendant Graff, often sell their songs "for a song."

its moving paper, appellee's president urges that the song "is one of the most celebrated ballads of our times," and that an injunction is necessary to prevent "substantial monetary damage."

There were similar renewal rights to several other songs sold by Graff to the plaintiff in the same contract—including the well-known *Till The Sands of the Deserts Grow Cold*—which have admittedly "become world famous."

³ Dissenting opinion in *Ribnik v. McBride*, 277 U. S. 350, 361, 364-370 (1928). That dissent is now good doctrine in the light of *Olsen v. Nebraska*, 313 U. S. 236, 244-246 (1941).

Mr. Justice Brandeis confessedly went out of the record to acquaint himself, judicially, with "the art of breadmaking and the usages of the trade; with devices by which bakers of bread are imposed upon and honest bakers or dealers are subjected by their dishonest fellows to unfair competition; with the problems which have confronted public officials charged with the enforcement of the laws prohibiting short weights, and with experience in administering those laws"—obtaining such information from a variety of sources, including a letter, written in 1917, by Herbert Hoover to President Wilson; *Jay Burns Baking Co. v. Bryan*, 264 U. S. 504, 517, 533 (1924). Cf. *Oklahoma v. Guy F. Atkinson Co.*, 313 U. S. 508 (1941).

For these and related matters, see Davis, *An Approach to Problems of Evidence in The Administrative Process*, 54 Harv. L. Rev. (1942) 364, 403-405.

Here, then, is a case where (a) the defendant was an author, one of a class of persons notoriously inexperienced [fol. 110] in business, and the particular author was actually, at the time, in desperate financial straits, while the plaintiff was a successful and experienced publisher; (b) the property contracted for was of such a character that, when the contract was made, "neither party could know even approximately the value," so that "it was a bargain made in the dark"; and (c) the consideration was a very small sum.

That is not the kind of contract which equity will specifically enforce. Although Chancellor Kent, in a well-reasoned early case, *Gumour v. Delauey*, 6 Johns. Ch. 292, concluded that inadequacy of consideration alone would bar specific performance of a contract, his views were rejected on appeal by a bare majority, 3 Cow. 445, in what became the leading American case. More recently, however, there has been a growing tendency to adopt Chancellor Kent's view. But we need not rely on such authorities, for it is well-established that specific performance will be denied where, in addition to inadequate consideration, other factors contribute to the inequity of the bargain. See 2 Chafee and Simpson, *Cases on Equity* (1934) 1173-1193, especially note 5, page 1185. Among the factors to be considered are lack of advice by one contracting party, *Ames v. Ames*, 91 V. E. 509, 46 Ind. App. 597; *Banaghan v. Maloney*, 85 N. E. 839, 200 Mass. 46; differences in business experience or information, *Margraf v. Muir*, 57 N. Y. 155; especially if an improvident contract is the result; *Pickett v. Camstock*, 229 [fol. 111] N. W. 249 (Iowa).³⁴ Where a small lump sum consideration is coupled with the sale by an inexperienced seller of property highly problematic in value, equity will deny relief. *Marks v. Gates*, 154 Fed. 481 (C. C. A. 9); cf. *Federal Oil Co. v. Western Oil Co.*, 121 Fed. 674 (C. C. A. 7); and cases cited in 58 C. J. 954-957; Pomeroy, *Specific Performance of Contracts* (3d ed. 1926) Sections 192-198. In *Marks v. Gates*, *supra*, the plaintiff asked for specific performance of a contract by which the defendant agreed to convey to him a twenty per cent interest in any property he should acquire on the Territory of Alaska. The consideration was \$1000 in cash, and the cancellation of a debt of

³⁴ Cf. *Miss. & Mo. R. R. Co. v. Cromwell*, 91 U. S. 643, 645-646; *Randolph v. Quidnick Co.*, 135 U. S. 457, 459.

\$11,225. Within two years, the defendant had acquired certain mining properties, worth more than \$750,000. In denying specific performance, the Circuit Court of Appeals for the Ninth Circuit said that the contract bound the defendant to convey "property of which neither party could know even approximately the value. It was a bargain made in the dark * * *. Where the consideration is so grossly inadequate as it is in the present case, and the contract is made without any knowledge at the time of its making on the part of either of the parties thereto of the nature of the property to be affected thereby, or of its value, no equitable principle is violated if specific performance is denied, and the parties are left to their legal remedies, if any they have."

For the foregoing reasons, the order for an interlocutory injunction should be reversed.⁴

[fol. 112] 2. It should also be reversed because there can, I think, be no enforcement, under the Copyright Act of 1909, of a contract for the sale of an author's renewal option if made prior to the date when the author is himself able to exercise that option.

My previous discussion has a bearing on the interpretation of that Act. For, as the equitable policy of denying enforcement of certain contracts for the sale of property, which I have just considered, rests upon non-statutory grounds, it serves to answer my colleagues' suggestion that, we must take it for granted that the policy of our legal system is steadfastly opposed to any impediments on the freest possible alienability by all men of their property, and should construe this statute accordingly.

As one might surmise, Congress had fully in mind the inexperience of authors. As I shall show, it desired to protect them against the very sort of improvident agreement

⁴ The defendants seem not to be financially responsible. That alone, however, is no ground for a preliminary injunction, and surely not when there are other means of protecting plaintiff, should it ultimately win, without doing unnecessary harm to defendants should they ultimately succeed. At most (assuming that any agreement made prior to the renewal date to sell a renewal right can be valid) the interim order should not have gone beyond an impounding, *pendente lite*, of the receipts of defendants from sales of the song.

for the disposition of their contingent renewal privileges which, in the case at bar, the majority opinion holds to be enforceable. Indeed, my colleagues, a few weeks ago, joined in an opinion in which it was said (in passing, to be sure) that the very section of the Act now before us "imposes [a limitation] upon the author's power to dispose of the right of renewal during his life" which was "clearly intended to protect widows and children from the supposed imprudence of authors * * *". *Skapiro, Bernstein & Co., Inc. v. Bryan, et al.*, — F. (2d) — (December 1, 1941). [Incidentally, that recent decision makes it unnecessary to give any weight to the *obiter dictum* in the opinion of Marton, J., in *Tobani v. Carl Fischer, Inc.*, 98 F. (2d) 57, 60, to which the majority opinion in the instant case refers with approval.]

The majority opinion grants, as it must, that Congress put some very real restraints on the author's power to dispose of his statutory renewal option. One who purchases it under a contract made prior to the renewal date acquires nothing; even the majority concedes, if the author is not alive on that date; if he dies intestate before then, his creditors cannot avail themselves of that option on the renewal date, even if he leaves no widow or children, because Congress expressly said that the option should then pass to his next of kin and not to his administrator. And the majority admits, also, that the statute does not clearly provide that if the author is alive on the renewal date, the option passes to a purchaser under such a contract as is before us in the instant case. We must, therefore, turn to the legislative history.

My colleagues give a partial quotation of the Congressional committee reports concerning the 1909 Act. Those reports, in discussing the author's right to a renewal term, say that "the law should be framed as is the existing law, so that he could not be deprived of that right," and cannot have it "taken away from him in his old age when he needs it the most." Since the 1909 report refers to the then "existing law," the 1831 Act, we should examine—as the majority does not—the following comments of the Congressional Committee made at the time when the 1831 Act was enacted:

"At the second session of the first Congress, a statute was passed to secure to authors the copy-right of their books, charts and maps. In 1802, a like statute was passed

to secure the copy-right of prints. In both of these statutes, there are provisions which are useless and burdensome, and in which there are likewise discrepancies. * * * In the United States, by the existing laws, a copy-right is secured to the author, in the first instance, for fourteen years; and if, at the end of the period, he be living, then for fourteen years more; but, if he be then not living, then the copy-right [fol. 114] is determined although, *by the very event of the death of the author, his family stand in more need of the only means of subsistence ordinarily left to them.* * * *

The bill secures to the author a copy-right for twenty-eight years, in the first instance, with a right of renewal for fourteen more, if, at the end of the first period, the author be living, or shall have a family. * * * The scholar, who secludes himself and wastes his life, and often his property, to enlighten the world, has the best right to the profits of those labors. * * * Shall we not encourage the means of that knowledge, and enlighten that virtue * * *? We ought to present every reasonable inducement to influence men to consecrate their talents. * * * *It cannot be for the interest or honor of our country that intellectual labor should be depreciated, and a life devoted to research and laborious study terminate in disappointment and poverty.* * * * *The question is, whether the author or bookseller shall reap the reward.*"

With that Congressional purpose as to the 1831 Act in mind, we can the better get at the Congressional intention in enacting the 1909 Act by quoting (more extensively than do my colleagues) from the Committee Reports on that Act:

"It was urged before the committee that it would be better to have a single term without any right of renewal, and a term of life and fifty years was suggested. Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success [fol. 115] and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of

House Report No. 2220, 60th Cong. 2d sess. p. 14 *et seq.* The Senate Committee adopted this report.

The author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right. The present term of twenty-eight years, with the right of renewal for fourteen years, in many cases is insufficient. The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period that there would be no probability of its being taken away from him in his old age, when, perhaps, he needs it the most. A very small percentage of the copyrights are ever renewed. All use of them ceases in most cases long before the expiration of twenty-eight years. *In the comparatively few cases where the work survives the original term, the author ought to be given an adequate renewal term.*"⁶

We should, in the case before us, carefully consider especially these sentences from those two Reports: "The question is whether the author or bookseller should reap the reward." "It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum." Surely, in the light of the Congressional purpose thus disclosed, we ought not so construe the statute that the publisher and not the author will "reap the reward," when, as here—and as "not-infrequently happens"—the "author sells his copyright outright for a comparatively small sum."

⁶ The report also said: "your committee do not favor and the bill does not provide for any extension of the original term of twenty-eight years, but it does provide for an extension of the renewal term from fourteen years to twenty-eight years; and it makes some change in existing law as to those who may apply for the renewal. Instead of confirming the right of renewal to the author, if still living, or to the widow of children of the author, if he be dead, we provide that the author of such work, if still living, may apply for the renewal, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower or children be not living, then the author's executors, or, in the absence of a will, his next of kin. *It was not the intention to permit the administrator to apply for the renewal, but to permit the author who had no wife or children to bequeath by will the right to apply for the renewal.*"

The Committees almost literally described the facts of the instant case: Graff sold outright his original term for a small sum. His turned out to be one "of the comparatively few cases where the work survives the original term." It was to meet just such a contingency, the Committees said, that Congress gave "the author the exclusive right" to "an adequate renewal term" so that he could, in such a case, "reap the reward" in "his old age." We should see to it, that, as Congress intended, the "right of the author to take the renewal term" is so hedged about that he can "*not be deprived of that right*" by having it "*taken away from him in his old age when he needs it the most.*"

I find it difficult to regard those expressions of the Committees as mere idle talk, or as so ambiguous that we can laugh them off. The considerations which they present fully answer the suggestion in the majority opinion that, if we do not allow the author to contract away his contingent renewal privilege before it ripens, we may be depriving him of a means of procuring funds, by a sale of that right when it is still contingent on his living, i. e., prior to the beginning of the twenty-eighth year. If Congress intended him to be able to dispose of it before that time, why did it not confer on him a single fifty-six year term? Why did it provide for a renewal, and explicitly prevent its exercise at an earlier date? Plainly, as Congress said, because it wanted the author to be unable to sell it "outright to a publisher for a comparatively small sum"—as he endeavored to do in this very case. Here the attempted "outright" sale of the renewal right occurred in 1917, twenty-two years before the right came into existence (i. e., 1939). If Congress contemplated that the author should be able to make such a [fol. 117] sale at so early a date, then it put him in the worst possible position to do so for an adequate consideration: As any member of Congress with any sense must have seen, the sale value prior to the twenty-eighth year, 1939, would be small, because the purchaser would be buying a gamble on the author's longevity. In other words, to repeat, if such an early sale was to be allowed, the best arrangement for the author would have been a single term of fifty-six years, for then the gambling element would not inhere in the sale. But Congress explicitly rejected that arrangement. Why? In order, the Committees said, to safeguard the author "in his old age." That explicit intention is frustrated by the majority's interpretation. The

result of that interpretation is that the protection of the author "in his old age" becomes "a teasing illusion like a munificent bequest in a pauper's will."

The majority opinion itself demonstrates that the benefit to the author of any such an early sale must necessarily be trifling: In discussing the small consideration paid by the plaintiff to Graff in 1917—over two decades before the renewal date—the majority opinion says that it was adequate because of "the well-known ephemeral nature of popular song hits." Which is to say that in 1917 no one could be expected to pay more than a slight sum for the renewal right to even a most successful song, especially since the purchased right would be valueless unless the author were alive in 1939. Since, as the majority opinion thus acknowledges, an early sale must, inevitably, mean a negligible price, how can the Congressional purpose of protecting the old age of the author be reconciled with the alleged permission to make such a sale? A small sum received by an author when a young man will do little to help him twenty years or more later, in his declining years.

[fol. 118] The statute as interpreted by the majority means merely this: An author cannot make a *direct* "outright" sale before the twenty-eighth year. But, say my colleagues, he can do so by indirection—by making (twenty-two years earlier as here) a specifically enforceable agreement, absolutely binding on him, to have it assigned in his name as soon as the twenty-eighth year arrives. The majority opinion admits that the difference between such a transaction and the forbidden direct "outright" sale is of the tweedle-dum-and-dee variety. The hocus-pocus employed by the plaintiff makes clear the artificial character of the distinction. The plaintiff, M. Witmark & Sons, relies for its title to the song on an assignment executed in 1939 "to M. Witmark & Sons," signed by George Graff "by M. Witmark & Sons," as George Graff's "appointed attorney." Congress could not have intended that its admitted purpose—to prevent a direct sale prior to the twenty-eighth year—should be so easily circumvented. If it had intended that an anticipatory assignment should be valid, it is strange that in the course of a century, since 1831, it has provided no machinery by which the assignee might perfect the re-

³ Mr. Justice Jackson concurring in *Edwards v. California*, — U. S. — (November 24, 1941).

newal in his own right and in his own behalf and without resort to such *hocu-pocus*.

It was said of the Statute of Uses,* that it failed in its purpose and, because of hostile judicial interpretation, had the effect merely of "adding three words to a conveyance." A similar gutting of a statute, by interpretation, will result from my colleagues' decision here.

That my colleagues are obviously uneasy about their interpretation of the Congressional intention expressed in the 1909 Committee report is demonstrated by their desperate recourse to bills subsequently introduced but which failed [fol. 119] of passage. Only one of these bills progressed as far as passage by one house of Congress. And since, in one way or another, all those bills expressly provided for assignment of the renewal term, they might be said to show—if they show anything—not, as the majority would have it, "a recognition of the validity under the 1909 Act of assignment of the renewal term," but, on the contrary, that the draftsmen believed that amending legislation was needed to validate such an assignment. While proposed but unsuccessful legislation is at best a feeble basis for statutory interpretation, the only sort of proposed bill which would have had any clear significance, as showing the validity of an assignment under the 1909 Act, would have been one which sought to deprive the author of the power to assign the renewal, or one which explicitly stated that such assignments should thereafter, as theretofore, be valid; but no such proposal was ever made.

The majority opinion cites, in support of its interpretation, the views of seven text-book writers; yet the majority opinion concedes that one such "expert" denied the power to make an early assignment and that the other six either "hedged" or were only "fairly" definite. There is then no evidence to support the majority's comment that the statute "has fairly uniformly been interpreted one way" by the "experts." And there is not a scrap of evidence, in or out of the record, to sustain my colleagues' statement that "it seems not unreasonable to conclude" that such a belief (i. e., that renewal rights are thus assignable) "doubtless exists throughout the trade."

* Perhaps not altogether accurately, see Radin, *Anglo-American Legal History* (1936), 435; 4 Holdsworth, *History of English Law*, 467 *et seq.*

My colleagues also refer to a comment made in an opinion of Acting Attorney General Fowler. But they disregard the fact that, as that opinion discloses, it was in response to the question whether assignees under "direct assignments of the renewal" are "entitled to renewals"; that the [fol. 120] answer to that question was in the negative; and that the remark quoted in the majority opinion here was made merely in passing, as is shown by the following statement: "It is not intended in this opinion to determine any question of law which relates to the relative rights of authors and their assigns, and such rights are mentioned only by way of illustration or argument." Thus qualified, an *obiter* in such an opinion is entitled to little weight.

It was argued by plaintiff that Congress, when enacting the 1909 Act, must be deemed to have had in mind the judicial interpretation of the 1831 Act, and that the later Act must therefore be construed as the majority construes it. But there had been no clear judicial interpretation of the 1831 Act along those lines. It is not at all plain that, in *Paige v. Banks*, 13 Wall. 608 (1871), the court, in passing on a contract made in 1828, was thus construing the 1831 Act, as distinguished from the preceding Act of 1790, which differed in its provisions. That Judge Putnam, in *White Smith Music Co. v. Goff*, 187 Fed. 247, 253, understood *Paige v. Banks*, *supra*, as relating solely to the 1790 statute goes to show that it cannot be said that it was clear to Congress in 1909 that the Supreme Court had held that under the 1831 Act the contingent renewal privilege was alienable by the author prior to the date fixed for renewal. In the face of that ambiguity, not much weight should be given to the rule of statutory construction that, when a legislature uses, without change, statutory language which has previously received judicial interpretation, the language of the statute is read in the light of such interpretation. That rule of construction has been much weakened of recent years. The Supreme Court, in *Helvering v. Hallock*, 309 U.S. 106, 119, said: "To explain the cause of non-action by Congress when Congress itself sheds no light is to venture into speculative unrealities. Congress may not have had its attention directed to an undesirable decision; and [fol. 121] there is no indication that as to the *St. Louis Trust* cases it had, even by any bill that found its way into a Committee pigeonhole. Congress may not have had its attention so directed for any number or reasons . . ."

Various considerations may be suggested for the inaction * * * but they would only be sufficient to indicate that we walk on quicksand when we try to find in the absence of corrective legislation a controlling legal principle."⁹ It should be noted that there is nothing in the report of the Committee dealing with the 1909 Act which refers to *Paige v. Banks, supra*. And, at best, the suggested rule of statutory construction is only one means—"neither final nor conclusive"—of ascertaining the legislative interest, which must give way to more lucid indications of that intent, such as we find here in the Committee reports. Cf. *Helvering v. Stockholms Enskilda Bank*, 293 U. S. 84, 89; *Boston Sand Co. v. United States*, 278 U. S. 41, 48.

The following considerations reinforce my interpretation of those reports: The Constitution expressly states the very limited purposes for which Congress may authorize patents and copyrights as follows: "to promote the Progress of Science and useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." [For the historical background of this clause, see Hamilton, *Patents and Free Enterprise*, T. N. E. C. Monograph No. 31, 11-27.¹⁰] A [fol. 122] copyright or patent statute should fulfill that constitutional purpose; if it promoted a monopoly primarily for the benefit of manufacturers or publishers, rather than basically as a reward to inventors or authors, it would verge on unconstitutionality.¹¹ To the effect that we must keep a

⁹ Cf. *Neirbo v. Bethlehem Shipbuilding Corp.*, 308 U. S. 165, where the statute had been left unchanged for half a century after decisions which in that case were repudiated by the court. In *Erie R. Co. v. Tompkins*, 304 U. S. 64, the statute had not been changed during almost a century of judicial interpretation, despite proposals to amend it; see dissenting opinion of Butler, J., 304 U. S. at 86.

¹⁰ A brilliant criticism of the conventional descriptions of the fight on monopolies waged in the reigns of Elizabeth and James I is made in a study by Goldwater, *The Anti-Monopoly Movement in England, 1606-1624* (unpublished, 1939).

¹¹ Of course, in order to aid the inventor or author, there must be, via the patent or copyright, some incentives to manufacturers or publishers.

sharp eye on the Constitutional purpose of this clause, see *Cuno Engineering Corp. v. Automatic Devices Corp.*, — U. S. — (November 10, 1941) and *Morton Salt Co. v. G. S. Suppiger*, — U. S. — (January 5, 1942), which disclose a back-to-the-Constitution movement in a field in which the simple words of the Constitution are regarded as at least as good a guide as (if not a better one than) the reams of gloss which have been written since 1789. *West Coast Hotel Co. v. Parrish*, 300 U. S. 379, 391;¹² *Wisconsin v. J. C. Penney Co.*, 311 U. S. 435, 444; cf. Frankfurter, J., concurring in *Graves v. New York ex rel. O'Keefe*, 306 U. S. 466, 491:

"But the ultimate touchstone of constitutionality is the Constitution itself and not what we have said about it."

It is worthy of note, also, that while the individual inventor seems to be rapidly giving way to the corporate research laboratory, so that the patent grant is no longer the same kind of stimulus to personal genius that it once was (see Hamilton, *ibid.*, 152-158),¹³ no such development has taken [fol. 123] place among authors and song-writers. With respect to such persons, the full achievement of the objectives of the Constitutional provision is still easily possible. An interpretation of the Copyright Act which gives them adequate protection will bring that statute more closely in line with the Constitution than will the interpretation adopted by my colleagues. And that the Constitutional limitation was clearly in the mind of Congress in 1831—when the statutory provisions here in question were first adopted—is highly likely; for, just two years earlier, in 1829, the Supreme Court was stressing the language of the Constitutional provision far more than it subsequently did until a

¹² There the court, in repudiating expressions found in *Adkins v. Children's Hospital*, 261 U. S. 525, said: "The Constitution does not speak of freedom of contract."

¹³ This is not to say that the development of the corporate research laboratory calls for the elimination of the patent system, but merely that, as many persons have recently suggested, that development may necessitate an overhauling of the patent system if it is to serve the constitutional objective. Cf. L. Hand, J.: "Perhaps the [patent] system is outworn" *Dewey & Almy Chemical Co. v. Minner Co., Inc.*, — F. (2d) — (January 5, 1942).

*very recent date.*¹⁴ I note here once more this statement in the 1831 report: "The question is whether the author or bookseller shall reap the reward." The answer of the Committee, constrained by the Constitution, was, necessarily, "the author." Yet the result of the majority opinion in this case is to give the other answer—"the bookseller." For a small price paid in 1917, the "bookseller", here (so the majority rules) acquired the author's contingent right which, when it came into being in 1939, was immensely valuable. And, as already shown, the majority recognizes that, inevitably, the acquisition for an insubstantial sum must be the consequence of permitting a sale of the contingent renewal right at an early date, *so that, if there is any substantial reward going to anyone from the renewal, it will not, in such circumstances, enure to the author.*

The inherent difference between the difficulties involved in exploiting a patent and a copyright must always have [fol. 124] been apparent. And it is noteworthy that at one time when Congress provided that patents should, on a certain showing, be renewable for an additional period, it expressly provided, as it did not do equivalently as to copyrights in the 1831 or 1909 Copyright Acts, "And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interest therein * * * 14a

3. The chief prop of the statutory interpretation adopted by the majority opinion is that our society rests on the theory that men should have the greatest possible liberty to make such contracts as they please. I agree that that has, for long and, on the whole, desirably, been, in general, the American attitude. But while, during a part of the 19th century, the devotion to that theory was peculiarly

¹⁴ In *Pennock v. Dialogue*, 2 Pet. 1 (1829) Mr. Justice Story emphasized the constitutional provision. Later, a majority of the court paid it less attention (although there was a deviation in 1882, in *Atlantic Works v. Brady*, 17 Otto 492). After a long detour, the court has recently returned to the earlier attitude. See *Cuno Engineering Corp. v. Automatic Devices*, *supra*.

^{14a} 1836 Patent Law, 5 Stat. at L. 125, Sec. 18. This renewal feature was omitted in the Patent Act of 1862 and since then.

intense, there have been in our history changes in that intensity, as this court has candidly recognized several times within recent weeks. Thus one manifestation of the most extreme enthusiasm for "liberty of contract" was the notion that courts must never depart from "the intention of the parties" to a contract. Yet our court, about a month ago, frankly confessed that that idea was a pious fiction, saying, in an opinion written by Judge Clark, that there had been much confusion in judicial statements concerning "implied" negative covenants and adding, "One may perhaps conclude that in large measure this confusion arises out of the reluctance of courts to admit that they were to a considerable extent 'remaking' a contract where it seemed necessary and appropriate so to do. 'Intention of the parties' is a good formula by which to square doctrine with result. That this is true has long been an open secret." *Paper Products Co., Inc. v. I. Rokeach & Sons, Inc.*, — F. (2d) — (December 24, 1941). And our court has stated [fol. 125] that, to the consensual act of the parties in entering into contracts, the courts have attached many obligations which were not in the minds of the parties, that a contract creates a status which imposes such obligations because of considerations of policy.¹⁵

Consequently, it is surprising that my colleagues, uncharacteristically, in this particular case interpret the statute as if, today, laissez-faire were still in fullest bloom—as if there were still so strong a presumption against any and all restrictions on the freest possible bargaining that only the plainest language can overcome it, so that the desire of Congress to clog alienability of an author's rights, in order to protect him, must be disregarded unless that desire is set forth in wording as precise as that found in a general release.

Such was, to be sure, the attitude of the courts during the latter part of the 19th century. As Dean Pound has said,¹⁶ it was then "taken for gospel that law was moving and must move in the direction of abstract individual self-determination by free control. . . . The judges were imbued with genuine faith in the . . . doctrine of

¹⁵ *United States v. Forness*, 125 F. (2d) 928, 936, note 25 (January 20, 1942); *Hume v. Moore-McCormack Lines*, 120 F. (2d) 336, 342-343, notes 18-22.

¹⁶ *Interpretations of Legal History* (1923) 60ff.

progress from status to contract.¹⁷ Hence it seemed to them that the constitutional requirements of due process was violated by legislative attempts to restore status and restrict the contractual powers of free men by enacting that men of full age and sound mind in particular callings should not be able to make agreements which other men might make freely * * *. This attitude resulted in "an inconsistency between the doctrine of progress from [fol. 126] status to contract, as the last generation understood it, and the principles of equity which had developed in our law, especially in the seventeenth and eighteenth centuries. The state courts held for two decades that legislative imposition of contractual incapacities in the relation of employer and employee was arbitrary and hence unconstitutional. But there were existing incapacities with which they did not think of interfering. The surviving common law incapacities could be idealized as 'natural incapacities.' Usury laws were not so easy to explain. But courts said that there had been such laws from the beginnings of American legislation, and some, ignorant of English law-making, that they were immemorial and universal. In other words, they were familiar historically and hence reasonable. There remained equitable restrictions on free contract, the doctrine as to penalties, the refusal to allow the holder of a penal bond to recover more than the actual damages, the doctrine of redemption of mortgaged property after the condition had become absolute, the rule against clogging the equity of redemption, the rules as to sailors' contracts and sales by reversioners. An eighteenth century chancellor had explained these by saying that necessitous persons were not free.¹⁸ But the courts shrank from so recognizing the facts of industrial employment in the face of the abstract freedom which they had set up as an ideal. The best they could say was that the equitable incapacities also were historical. This amounted to holding that the legislature was unable to create new contractual incapacities; that the lines had been drawn forever in the seven-

¹⁷ That this "doctrine" involved a misinterpretation of Maine's epigram, see *United States v. Forness*, *supra*, note 25.

¹⁸ As Chief Justice Taft was to say in 1927; see *American Steel Foundries v. Tri-City Council*, 257 U. S. 184, 209.

teenth and eighteenth centuries and that no new type of disability could be recognized. Nor did it matter that the [fol. 127] underlying principle of these new statutory disabilities was the same as that underlying the disabilities imposed by equity."

The theory of laissez-faire was that the state, the government, was not to interfere beyond a bare minimum. That such was not the actual practice, even when laissez-faire was in its zenith, has been brilliantly shown in the writings of Robert Hale, beginning in 1923.¹⁹ His thesis may be paraphrased thus: In outward appearance, under let-alone-ism, the extensive use of state power is rejected. In fact, however, there is a transference of much of the State's power to individuals. The contracts they make (so far as they are lawful) are enforced and protected by the State through the orders of its courts and its sheriffs. More than that, the individual has a right to refuse to sell or use his property on any terms or except on his own terms. If someone else tries to make him sell or use it except on those terms, the State, through its courts and sheriffs, will protect him from such intrusions. Liberty to contract includes liberty not to contract if one pleases. And government backs up that liberty. Laissez-faire does not mean that the State has given up most of its "interferences," but that the State is used to "interfere" in new ways at the demand of individuals. The power of government is thus exercised, indirectly, by the individual to enforce his bargains and to punish those who try to make him bargain ex- [fol. 128] cept as he chooses.²⁰ The Hale thesis involves

¹⁹ See *Coercion and Distribution in a Supposedly Non-Coercive State*, 38 Pol. Sci. Q. (1923) 415; *Force and The State*, 35 Col. L. Rev. (1935) 149; *Our Equivocal Constitutional Guaranties*, 39 Col. L. Rev. (1939) 563.

²⁰ Hale's ideas were subsequently restated (although independently) by M. R. Cohen, who says that our "law of contract . . . puts the sovereign power of the State at the disposal of one party to a contract. . . . From this point of view, the law of contract may be viewed as a subsidiary branch of public law, as a body of rules according to which the sovereign power of the State will be exercised as between the parties to a more or less voluntary bargain If then the law of contract confers

some over-statement. But its dramatic challenge of the conventional thesis helps us to attain a new and valuable perspective. It serves to high-light the public interest in individual contracts. Because of it, we can better understand why, at no time, did let-alone-ism go so far as to obliterate all direct governmental interference with contracts; why, even in the hey-day of laissez-faire, there were retained such doctrines as the rule against perpetuities and the rules as to restraints on alienation, dower rights, spend-thrift trusts, the voidability of infants' contracts, etc. Laissez-faire, in other words, meant a shift of emphasis; older attitudes were not killed off but merely submerged. Hale aids us to see the legitimacy of the State's now openly acknowledged interest and direct interference in many kinds of contracts. Nothing, it has been said, exceeds like excess. Laissez-faire went too far.

It is helpful to make an historical approach to the chief interpretative device employed by my colleagues. Their opinion, I note again, relies, in effect, on a supposed spirit of our institutions, tenaciously opposed to all restraints on freedom to contract, which, it is urged, must be read into all American legislation. To make that thesis applicable here, my colleagues must assume that that spirit was operative a century ago when the 1831 Copyright Act was enacted; for the 1909 Act, it is conceded, took over from the earlier statute the provisions which we are considering in the case now before us; accordingly the relevant "time spirit" is that of 1831. In purporting to find such a spirit, then and still [fol. 124] operative, my colleagues are, I think, misreading history. Both they and many of those who have criticized

sovereignty on one party over another (by putting the State's force at the disposal of the former) the question naturally arises: For what purposes and under what circumstances shall that power be conferred? M. R. Cohen, *The Basis of Contract*, in Cohen, *Law and The Social Order* (1933) 69, 103-104; cf. Cohen, *Property and Sovereignty*, 13 *Corn. L. Q.* (1927) 8; cf. J. M. Clark, *Social Control of Business* (1926) 132.

²⁰To the effect that in constraining a statute we may refer to the history of the time when it was passed, see *Great Northern Ry. Co. v. U. S.*, — U. S. — (February 2, 1942).

views such as they have expressed²¹ have made history too smooth, have oversimplified it. Even in the so-called period of *laissez-faire*, of course, as in almost any so-called "historical period," there were numerous currents and cross-currents, not a single drift in one direction.²² The casual observer sees only the current at the surface. And so with excessive *laissez-faire*: It was merely—and for a relatively short time—the surface current. In the early days of the Republic, mercantilism was still visibly powerful.²³ Alexander Hamilton was certainly not wholly in the grip of that "old Adam"—Adam Smith. Mercantilist notions—and even medieval notions²⁴—persisted throughout the 19th century in America, and in many matters made themselves felt.²⁵ When the 1831 Copyright Act was enacted, whole-hog *laissez-faire* was not yet fashionable.

²¹ Dean Pound, for instance:

²² Cf. *United States v. Forness*, — F. (2d). — (January 20, 1942).

To shift the metaphor, and to use ten dollar words, there is much cacophony in the symphony of history. Or to restate it, there is usually, at any given moment, not one "spirit of the age," but many such spirits. The bias, conscious or unconscious, of the particular historian will often explain why he chooses one special spirit for emphasis.

²³ Cf. Hamilton and Adair, *The Power to Govern* (1937).

²⁴ Of course, the labels "medieval," "mercantilism" and "*laissez-faire*" are each vague catchwords. Each of them symbolizes a complex or congeries of acts and attitudes having many sources. As to some of the many facets and components of *laissez-faire*, see e.g., Wingfield-Stratford, *The Victorian Cycle* (1935); Clarke, 3 Pol. Sc. Q. (1888) 549; reprinted in Beard, *Introduction to The British Historians* (1906) 609, 612ff; Hamilton and Braden, *The Special Competence of the Supreme Court*, 50 Yale L. J. (1941) 1319, 1320, note 11; Sabine, *A History of Political Theory* (1937) 656-665, 672.

²⁵ As to domestic policy, they did in England, too, moving towards the surface earlier there than in this country; cf. *Hume v. Moore-McCormack Lines*, 121 F. (2d) 336, 340 and note 12. Our protectionist policy as to foreign affairs was akin to mercantilism.

[fol. 130] However, the vocabulary of full-fledged let-alone-ism became the style with the average well-to-do "educated" American after the Civil War.²⁶ For a span of years, the constricting vocabulary of ultra-let-alone-ism was fashionable with much of our judiciary. As is not seldom true, the judicial fashion was out of step with a budding popular fashion in words and thoughts outside the court houses.²⁷ What the courts were saying was not necessarily an index of what Congress had in mind: We lawyers are too much inclined to take our history in legal capsules; we restrict our history reading too much to what we find in the law books, neglecting the fact that "there waft into the courts only occasional gusts in the varied and perpetually changing weather of . . . transactions" occurring in the outer world. "A climate cannot be delineated from a jar of captured raindrops."²⁸ Even, however, in the court-houses,

²⁶ Not until we reach the opinions of Mr. Justice Field in the *Slaughter House Cases*, 16 Wall. 36, 110 (1873) and *Butchers Union v. Crescent City Co.*, 111 U. S. 746, 757 (1884) do we find Adam Smith's views as to the virtues of individual egotism as the prime protector of public welfare quoted judicially as final and authoritative. In *Veazie Bank v. Fenno*, 8 Wall. 553, 541 (1869) Smith was referred to with great respect; but his views on taxation were there said not to have guided the Founding Fathers. Cf. *Pollock v. Farmers' Loan & Trust Co.*, 157 U. S. 429, 555, 630-631, 639-640 (1895).

²⁷ "If a statute . . . is apt to reproduce the public opinion not so much of today as of yesterday, judge-made law occasionally represents the opinion of the day before yesterday. But with this statement must be coupled the reflection that beliefs are not necessarily erroneous because they are out of date; there are such things as ancient truths as well as ancient prejudices." Dicey, *Law and Opinion in England* (24 ed., 1914) 369.

²⁸ Goebel, Editor's Introduction to DuBois, *The English Business Company After The Bubble Act* (1938) vii.

Professor Walter B. Kennedy remarks "that thirty years before the United States Supreme Court declared the Minimum Wage Law of the District of Columbia to be unconstitutional, Pope Leo XIII vehemently defended the right of the worker to a living wage in his famous encyclical, *Rerum Novarum*, and argued for such economic reform on the ground of natural law and natural justice." *My Philosophy of Law* (1941) 147, 159.

[fol. 131] there were those who, not long after the Civil War, asserted their independence of the style, in words and ideas, generally prevailing in the court-rooms. Chief Justice Waite was one of them. See *Munn v. Illinois*, 94 U. S. 113 (1877), *Holden v. Hardy*, 169 U. S. 366 (1898) and *Knoxville Iron Co. v. Harrison*, 183 U. S. 13 (1901), are also impressive as signs that the judicial thought-ways were not constantly running towards one point in the compass. The subsequent tussle between opposing attitudes is disclosed in a series of dissenting opinions—with Holmes as leader of the dissenters²⁹—which, latterly, have become the majority doctrine.³⁰ It will not do, then, to interpret Congressional committee reports, either in 1831 or 1909, as if they were the words of men with but a single and inflexible thought as to the folly of ever interfering with contracts.

Excessive judicial worship of let-alone-ism began, then, to melt away in the 1920's and has disappeared in the de-

²⁹ Sometimes his views prevailed: In *Noble State Bank v. Haskell*, 219 U. S. 104 (1911) he spoke for the Court, announcing in effect, that the judiciary, in a democracy, should, when possible, accept the ideas prevailing with the majority of the people as expressed in legislation. Zane, shocked by that decision, denounced it as a capitulation to the wicked ideas of the Germans, with whom we were then at war. See Zane, *German Legal Philosophy*, 16 Mich. L. Rev. (1918) 287; cf. 2 Holmes, *Pollock Letters* (1941), 3; 6, 42. And, for a time, the majority of the Court turned its back on the views expressed in the *Noble State Bank* case.

The story of the course of judicial attitudes in this field is excellently told by Paxton Blair, *Bench, Bar and Social Change*, an address before the N. Y. State Bar Ass'n, January 24, 1842.

³⁰ Informed by the past, we should, with proper scepticism, regard the view now prevailing as a new fashion, not certain to last forever, even if we admire it. Certainly there are other opposing views not far below the surface. That is no cause for regret: They may prevent a drift of opinion from becoming a flood which will erode too much.

For some healthy scepticism concerning the current anti-laissez-faire drift by one who likes it, see Bossard, *Sociological Fashions and Societal Planning*, 14 Social Forces (1935) 186.

[fol. 132] cisions, during the last decade, of the Supreme Court.³¹ "Whatever may be one's opinion about the wisdom of trying to save the ignorant and rash from folly, it is a recognized power that is used in many ways," said the Court, in 1924, in *Dillingham v. McLaughlin*, 264 U. S. 370, 374, construing a New York statute. We are obliged no longer to hold that the power to prevent the free disposal of rights was exhausted in such non-statutory rulings, for, instance, as that contracts by public officers, executors and receivers assigning their future earnings will not, on grounds of public policy, be enforced;³² or in the doctrine that equity will refuse to grant specific performance of improvident contracts. Indeed, we have been warned by a successful commercial banker and by able economists that the passion for excessive liquidity—the eagerness to make every kind of property or idea immediately convertible into cash—was one of the causes of the Great Depression, which began in 1929, and that, unless we do something to curb that zest for instant monetization of everything, our profit economy may collapse.³³

The former judicial repugnance to any legislative interference with free bargaining involved a blindness to the effects on the public—the community—of the conduct of individuals. Lately, we have begun to see that any business is "affected with a public interest," if the legislature so decides.³⁴ In reaching that conclusion, the courts have, [fol. 133] once more, realized that what one man does with his life often affects all the rest of us. If he is infected by a disease, many others may be victimized. If he con-

³¹ See discussion of this change and citation of pertinent cases in *Hume v. Moore-McCormack Lines*, 121 F. (2d) 336 (C. C. A. 2, 1941).

³² *In re Furness*, 75 F. (2d) 965; *Fischer v. Liberty Bank & Trust Co.*, 61 F. (2d) 757; *Bliss v. Lawrence*, 58 N. Y. 442, 445, 450; *Matter of Worthington, et al.*, 141 N. Y. 9, 12.

³³ See testimony of Ralph W. Manuel, President, Marquette National Bank of Minneapolis, May 22, 1939, before the Temporary National Economic Committee, Hearings, pp. 3710, 3713-3724; Berle and Pederson, *Liquid Claims and National Wealth* (1934).

³⁴ *Nebbia v. New York*, 291 U. S. 502 (1933).

tracts dire poverty, crime may result and a large group may suffer.³⁵ And so it is with free bargaining.³⁶ For a contract may be something more than a private affair of the contracting parties; it may vitally affect the interests of the public. Once that was the prevailing view; in the mediæval period, and for a long time subsequently, it was taken for granted that there was an overriding social or public aspect of individual trafficking. Cf. *Hume v. Moore-McCormack Lines*, 121 F. (2d) 336, 338. That emphasis in England on the public obligations of private persons was, however, exploited in the interests of dictatorial royal dynasts and, later, to benefit an economic oligarchy.³⁷ A revolt of enterprising individuals resulted. Their slogans were laissez faire and the natural rights of the individual. "As is natural in all revolts, absolute claims on one side were met with absolute denials on the other. Hence the theory of the natural rights of the individual took not only an absolute but a negative form: men have inalienable rights, the State must never interfere with private property etc."³⁸ "In the fierce fight against . . . numerous irrational, tyrannical and oppressive restraints, men jump to the conclusion that the absence of all restraint is a good in itself and indeed the one absolute good. . . . [Vol. 134] Recognition today of the unwisdom of excessive liquidity or excessive individualism does not at all mean a commitment to rigidity, regimentation, or undue paternalism. Cf. Russell Davenport, *This Would Be Victory*,

³⁵ *Carmichael v. Southern Coal Co.*, 301 U. S. 468, 516-517 (1937).

³⁶ See Paxton Blair, *loc. cit.*

³⁷ See, e.g., Wingfield Stratford, 1 *History of British Civilization* (1928) 498ff.; J. M. Clark, *Social Control of Business* (1926), 26ff.

³⁸ M. R. Cohen, *Property and Sovereignty*, 13 Cornell L. Q. (1927) 8, reprinted in Cohen, *Law and The Social Order* (1933) 41, 57.

³⁹ M. R. Cohen, *The Basis of Contract*, 46 Harv. L. Rev. (1933) 553, reprinted in Cohen, *Law and The Social Order* (1933) 69, 75-76.

24 *Fortune* (1941) 45, 136-144. Here, as almost everywhere in life, there is need for intelligent compromise.⁴⁰

⁴⁰ Cf. *Hudson Water Co. v. McCarter*, 209 U. S. 349, 355; dissenting opinion in *Christensen v. Valentine*, 122 F. (2d) 541, 522-523 (C. C. A. 2); *Clark v. United States*, 289 U. S. 1, 13.

It is of interest, in the light of subsequent events, to compare the absolutistic arguments of Joseph Choate, asserting before the Supreme Court in 1895 that any federal income tax would bring about communism, with those of James Carter, in the same case, that such a tax, intelligently applied, by reducing the undue concentration of wealth, would help to prevent communism and the breakdown of democracy. See *Pollock v. Farmers' Loan & Trust Co.*, 157 U. S. 429 (1895). For Choate's argument, see page 532.

Carter, a conservative lawyer and one of the leaders of the bar, arguing, on behalf of a trust company, in favor of the constitutionality of the tax, said (p. 517): "It is alleged by the counsel for the appellant that the income tax—and this they consider its most monstrous form of injustice—falls upon two per cent only of the population of the United States; but what must we think of the fact that this two per cent have been paying but a trifle more than two per cent of the \$500,000,000 [of taxes] while of the annual income of the nation, after deducting what would be sufficient to furnish a living for the people, they have been receiving probably more than fifty per cent? At the same time another impressive and startling fact not adverted to by them, has also been receiving more and more of the attention of the people of the country—I mean the growing concentration of large masses of wealth in an ever diminishing number of persons. It was impossible to avoid the suggestion that there was some connection between these striking facts, and it was also impossible that they should not form the point of conflict around which political content would gather. They did finally succeed in dividing the two great political parties of the country. At last the party complaining of these things gained an ascendancy in the legislative councils and efforts were made to devise a remedy. This income tax is a part of that remedy. The view taken by the Congress which passed the tax law in question is plain upon its face. The object was to redress in some degree the

beware of the either-or dogmatizers. It is unnecessary to make a hard-and-fast, all-or-nothing, antithesis between complete formal individual freedom and complete governmental guardianship for everyone. But it is necessary to observe that individualism, if utterly unrestrained, becomes self-devouring.⁴²

"More and more," said Lord Macmillan in 1935,⁴³ "the main issue in political science has come to be—not whether the State should intervene at all in the regulation of our daily lives but where the *frontier line ought most wisely to be drawn between the province of state activity and that of individual enterprise*. On all hands it is now recognized that the policy of *laissez-faire*, which gave us no

flagrant inequality by which the great mass of the people were made to furnish nearly all the revenue; and leave the very wealthy classes to furnish very little of it, in comparison with their means. . . .

[fol. 135] "Most of the issues of human and social relationships are not of the black-and-white variety."⁴⁴ We should

⁴¹ Mr. Justice Douglas, *Democracy and Finance* (1940) 243.

⁴² "To put the matter more generally, ought every person of full age, acting with his eyes open, and not the victim of fraud but who nevertheless is placed in a position in which from the pressure of his needs he can hardly make a fair bargain, to be capable of binding himself by a contract? If these and the like questions be answered in the affirmative, an individual's full contractual capacity is preserved, but he is in danger of parting, by the very contract which he is allowed to make, with all real freedom. . . . The difficulty is in all these cases . . . the same; there is a perpetual danger that unlimited contractual capacity which is looked upon as an extension of individual freedom, may yet be so used by some individual as to deprive himself of the very freedom which it is assumed to be the exercise." Dicey, *Law and Opinion in England* (2d. ed. 1914) 152-153; cf. 260ff.

See also Dawson, *Economic Duress and Fair Exchange in French and German Law*, 11 *Tulane L. Rev.* (1937) 346; 12 *ibid.* (1937) 43; Cohen, *The Basis of Contract*, *supra*.

⁴³ *Law And Other Things* (1937) 1, 7-9.

doubt our industrial and commercial supremacy but also gave us our slums and many other attendant evils, must give place to a new regime. * * * We have traveled far since Tom Paine—that early champion of the people's rights—proclaimed that “The more perfect civilization is, [fol. 136] the less occasion it has for government. * * * Sedgwick * * * recognized that * * * social legislation is essential to the preservation of the liberty of the individual. Such measures, he saw, may promote rather than diminish freedom.”⁴⁴

When the philosophy of 100% individualism was in vogue, the courts often soft-pedalled such considerations. They devised and interpreted legal rules and read statutes under the influence of their own notions of public policy. That process may have been largely unconscious. But, as Mr. Justice Holmes often said, there was strong policy-making in those judicial decisions.⁴⁵ The judges who decided them also uttered verbal repudiations of judicial legislation.⁴⁶

⁴⁴ In 1909, President Taft advocated the establishment of a postal savings bank. He replied to some of his critics who, he said, argued that such a bank “is a very paternalistic institution; that it has a leaning towards state socialism. * * * Now I am not a paternalist, and I am not a socialist, and I am not in favor of having the government do anything that private citizens can do as well or better. * * * [But] we have passed beyond the time of * * * the laissez-faire school which believes that the government ought to do nothing but run a police force.” See Pringle, *The Life and Times of William Howard Taft* (1939) 518.

⁴⁵ See e.g., Holmes, *Science and The Common Law* (1879) reprinted in Holmes, *Book Notices, etc.* (Shriver, 1936) 10-11; *Vegeahn v. Guntner*, 167 Mass. 92 (1896); *The Path of the Law* (1879); *Collected Legal Papers* (1920) 181, 184.

⁴⁶ For candid avowals that there is and (within proper limits) must be judicial legislation, see Holmes, *J., Southern Pacific Company v. Jensen*, 244 U. S. 221 (1917); Cardozo, *The Nature of the Judicial Process* (1921) 19, 103, 113, 146-149; Dicey, *Law and Opinion in England* (2d ed. 1914) 361-398, 483-494; Thayer, *A Preliminary Treatise on Evidence* (1898) 318-319, 327, 331; Dickinson, *Administrative*

But the demolition of the purposes of Congress, through stingy statutory interpretation, is the most emphatic kind [fol. 137] of "judicial legislation."⁴⁷ Our job is, so far as possible, to enforce the aims of Congress. We should, in the instant case, carry out what Congress meant to achieve for the protection of authors in the Copyright Act, and should not carry out, without modification, the policy of the judicial legislation found in the judicial decisions of the let-alone-ist era.

It is of considerable interest to note some of the cases cited by the majority to support their assertion that the Copyright Act must be read in the light of an alleged strong policy, said to be embedded in our legal system, unfriendly to any "restriction on free assignability": (a) There is the citation of an Illinois decision declaring unconstitutional a statute regulating assignments of wages and salaries. *Massie v. Cessna*, 239 Ill. 352, 88 N. E. 152.⁴⁸ To cite such a case indicates sympathy, which I doubt whether my colleagues entertain, with an attitude that such legislation, because it interferes with liberty of contract, is invalid; that attitude the United States Supreme Court has, in recent decades, flatly rejected.⁴⁹ (b) The majority also cites our recent decision, *In re Barnett*, — F. (2d) — (January 7, 1942) where, following early New York decisions (as we were obliged to do under *Eric v. Tompkins*, 304 U. S. 64),

Justice and the Supremacy of Law (1927) 122, note 22; 209, note 23.

What was the law in the time of Richard Coeur de Lion on the ability of a telegraph company to the persons to whom a message was sent? Gray, *The Nature and Sources of Law* (1900) Sec. 222.

⁴⁷ Cf. Paul, 1 *Federal Estate and Gift Taxation* (1942) 44 and notes 62, 86-87 and notes 33 and 34.

⁴⁸ Curiously, my colleagues cite Fortas, *Wage Assignments in Chicago*, 42 Yale L. J. 526, in which the author severely criticizes cases relying on that holding, and concludes (at p. 557) that "it seems doubtful that any restriction short of prohibition will cure the ill wage assignments have propagated in Chicago." * * *

⁴⁹ *Moorehead v. N. Y. ex rel. Tipaldo*, 298 U. S. 587; *West Coast Hotel Co. v. Parrish*, 300 U. S. 379.

we held that an assignment of an expectancy under a will is effective, and cannot be set aside by a trustee in bankruptcy or a judgment creditor; there was in that case no [fol. 138] statutory declaration of a contrary policy, nor was it even suggested that the consideration for the bargain was inadequate. (c) My colleagues also cite what they themselves describe as "the unusual case" of *Kelly v. Kelly*, 11 Cal. 2d 356, in which an interest under a spendthrift trust was allowed, by indirection, to be assigned.

It is important that the "property" here involved is a creature of statute and not a common law "right of property." In *Powell v. Hedd*, L. R. 12 Ch. D. (1879), 686, 688, it was argued that the part owner of a play could grant a license for its production without the consent of the other owners, because, at common law, one tenant in common of a chattel has a right to use the chattel as he pleases. Jessel M. R. rejected this argument saying: "I am not at all inclined to extend the antiquated and barbarous doctrines, which have been set aside partly by the Legislature and partly by the Courts of Equity, to new rights created by statute, and which are of a character wholly different from the rights of property to which these ancient doctrines apply." Cf. Holmes, J., dissenting, in *Truax v. Corrigan*, 257 U. S. 312, 342.

We know today that legal recognition of differences between different types of persons is not incompatible with the concept of "equality before the law," intelligently interpreted. Hughes, C. J., in *Moorehead v. N. Y. ex rel. Tipaldo*, 298 U. S. 587, 627, and in *West Coast Hotel Co. v. Parrish*, 300 U. S. 379, 391. Protection for those unable adequately to protect themselves must be afforded by any civilized legal system.⁵⁰ And when Congress has, as in the case of copy-

⁵⁰ Our system recognizes divers restraints on complete liberty of contract. Among them are the enforcement of spendthrift trusts; refusal to enforce the contract of a man to stay out of business forever or to allow his arm to be cut off; punishment of those who make suicide pacts, etc. As to the use of standardized contracts of insurance and the like, required by statute, see Isaacs, *Standardizing of Contracts*, 27 Yale L. J. (1917) 34; Llewellyn, *What Price Contract?* 40 Yale L. J. (1931) 704, 731ff; Goebel, *Trends in The Theory of Contracts in the United States*, 11 Tulane

[fol. 139] rights, expressed such a policy, there is no reason why the courts should frustrate it. It has been held that a person included within the provisions of a Workmen's Compensation Act cannot validly contract himself out of the statute; courts have reached that result even when the statute did not prohibit such a contractual waiver of the benefits of the legislation. *Wass v. Bracker Construction Co.*, 240 N. W. 464, 466; cf. *Powley v. Vivian & Co., Inc.*, 169 N. Y. App. Div. 170, 171. Here, where the Committee reports show the legislative intent to arrive at a similar limitation on free bargaining by an author, it is difficult for me to see why we should pay no respect to that intention.

I agree that the courts must not rewrite statutes and import into them what they think desirable when Congress has remained silent. But there is a marked difference between the silence of Congress and a statement of its purpose not expressed with complete nicety, a middle ground between Congress saying nothing and Congress shouting. The guiding principle was formulated as follows by Mr. Justice Holmes:⁵¹

"We recognize that courts have been disinclined to extend statutes modifying the common law beyond the direct operation of the words used, and that at times this disinclination has been carried very far. But it seems to us that [fol. 140] there may be statutes that need a different treatment. * * * The legislature has the power to decide what the policy of the law shall be, and if it has intimated its will, however indirectly, that will should be recognized and obeyed. The major premise of the conclusion expressed in a statute, the change of policy that induces the enactment, may not be set out in terms, but it is not an adequate dis-

L. Rev. (1937) 413, 421; M. R. Cohen, *The Basis of Contract*, *supra*.

The concept of "coercion by economic pressure" has received over judicial recognition in *United States v. Butler*, 297 U. S. 1, 71. It has been applied to "contract law" in many ways. For a recent case decided by this court, see *United States Navigation Co. v. Black Diamond Lines*, — F. (2d) — (January 5, 1942). Cf. Havighurst, *Consideration, Ethics and Administration*, 42 Col. L. Rev. (1942) 1, 27-30.

⁵¹ *Johnson v. United States*, 163 Fed. 30, 32.

charge of duty for courts to say: We see what you are driving at, but you have not said it, and therefore we shall go on as before."

Twice recently the Supreme Court has quoted that language with approval and applied that canon of interpretation.³² I believe it is our duty to do likewise. My colleagues say they are willing to abide by a Congressional policy against assignability of a contingent copyright renewal. I fear that they have just missed a real opportunity to do so.

[fol. 141] UNITED STATES CIRCUIT COURT OF APPEALS, SECOND
CIRCUIT

At a Stated Term of the United States Circuit Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the 26th day of May one thousand nine hundred and forty-two.

Present: Hon. Augustus N. Hand, Hon. Charles E. Clark, Hon. Jerome N. Frank, *Circuit Judges*.

M. WITMARK & SONS, Plaintiff-Appellee,

v.

FRED FISHER MUSIC CO., INC., GEORGE GRAFF, JR., Defendants-Appellants, and Mills Music, Inc., Defendant

Appeal from the District Court of the United States for the Southern District of New York

This cause came on to be heard on the transcript of record from the District Court of the United States for the Southern District of New York, and was argued by counsel.

On Consideration Whereof, it is now hereby ordered, adjudged, and decreed that the order of said District Court be and it hereby is affirmed with costs.

It is further ordered that a Mandate issue to the said District Court in accordance with this decree.

D. E. Roberts, *Clerk*.

³² *United States v. Hutcheson*, 312 U. S. 219, 235 (1941); *Keifer & Keifer v. Reconstruction Finance Corp.*, 306 U. S. 381, 391, note 4 (1939); cf. Stone, *The Common Law in the United States*, 50 Harv. L. Rev. (1936) 4, 13.

[fol. 142] [Endorsed:] United States Circuit Court of Appeals, Second Circuit. M. Witmark & Sons v. Fred Fisher Music Co., Inc., George Graff, Jr., and Mills Music, Inc. Order for Mandate. United States Circuit Court of Appeals, Second Circuit. Filed May 26, 1942. D. E. Roberts, Clerk.

[fol. 143] Clerk's certificate to foregoing transcript omitted in printing.

[fol. 144] SUPREME COURT OF THE UNITED STATES

ORDER ALLOWING CERTIORARI—Filed October 12, 1942

The petition herein for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit is granted.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

Endorsed on Cover: File No. 46,828, U. S. Circuit Court of Appeals, Second Circuit. Term No. 327. Fred Fisher Music Co., Inc., and George Graff, Jr., Petitioners, vs. M. Witmark & Sons. Petition for a writ of certiorari and exhibit thereto. Filed August 21, 1942. Term No. 327 O. T. 1942.

(2997)

FILE COPY

No. 327

U.S. - Supreme Court, U. S.

FILED

AUG 21 1942

CHARLES REMOND CHOPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1941

FRED FISHER MUSIC Co. INC. and GEORGE GRAFF, JR.,

Petitioners,

against

M. WITMARK & SONS,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT AND BRIEF
IN SUPPORT THEREOF**

**ARTHUR GARFIELD HAYS,
Solicitor for Petitioners.**

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IN THE
Supreme Court of the United States

OCTOBER TERM, 1941

FRED FISHER MUSIC CO. INC. and GEORGE GRAFF, JR.,
Petitioners,

against

M. WITMARK & SONS,
Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT**

TO THE HONORABLE, THE CHIEF JUSTICE OF THE UNITED
STATES AND THE ASSOCIATE JUSTICES OF THE SUPREME
COURT OF THE UNITED STATES:

Your petitioners, Fred Fisher Music Co. Inc. and George
Graff, Jr., respectfully represent:

I

Summary Statement of Matter Involved.

This case involves the construction of the renewal provisions of the Copyright Act of 1909 (17 U. S. C. A., Section 23). As stated by Judge Clark, writing for the majority in the Circuit Court of Appeals (R. 95, 125 Fed. (2d) 948):

"We are presented with a question of statutory construction, which has apparently never arisen before, though the general statutory provision has existed for over a hundred years. Simply stated, the problem is whether or not a copyright holder may assign his ex-

pectancy of the renewal right which arises under 17 U. S. C. A. § 23 at the expiration of the original twenty-eight year copyright grant."

The subject matter of the suit is the ownership of the author Graff's interest in the renewal copyright to the song "WHEN IRISH EYES ARE SMILING", which was originally copyrighted in 1912 and which became available for renewal in 1939.

The respondent claims ownership under an agreement made in 1917, twenty-two years before the renewal could be obtained or applied for, and also under an agreement made in 1910, two years before the song was written.

Petitioners contend that since Section 23 of the Copyright Law (17 U. S. C. A.) created the renewal term and limited the right to apply for it to the author or his family for the purpose of protecting them against an improvident disposition of the renewal copyright prior to its accrual, the assignments under which respondent claims are void and unenforceable.

The majority of the Circuit Court of Appeals (Judges Clark and A. N. Hand) sustained the validity of the anticipatory assignment; Judge Frank dissented.

The Facts

1. In 1912, the petitioner Graff, in collaboration with Ernest R. Ball and Chauncey Olcott, wrote the song "WHEN IRISH EYES ARE SMILING" (R. 23, 60).

2. It was published and copyrighted by the respondent on August 12, 1912 (R. 40-41).

3. Two years prior thereto, on July 1, 1910, Graff had agreed to sell to the respondent, on a royalty basis, all songs written by him during the next succeeding five years, "with renewals and with right to copyright and renew" (Exh. B, R. 36-40).

4. In 1917, Graff, who was then in financial straits, entered into an agreement with the respondent, whereby he released to the respondent all his right, title, interest and royalties in sixty-nine songs, including "WHEN IRISH EYES ARE SMILING", for the sum of \$1,600.00 (R. 60; Exh. D, R. 41-45)—an average price of approximately \$23 per song. This agreement purported to sell to the respondent, in addition to the royalties still to accrue on the songs, the renewals of copyright thereon. It provided (R. 44):

"And I do, for myself, my heirs, executors, administrators and next of kin, hereby irrevocably authorize and appoint the Publisher, its successor, successors and assigns, my attorneys and representatives, in my name or in the names of my heirs, executors, administrators and next of kin, or in its own names to take and do such actions, deeds and things, and make, sign execute and acknowledge all such documents as may from time to time be necessary to secure to the Publisher, its successor, successors and assigns, the renewals and extensions of the copyrights in said compositions and all rights therein for the terms of such renewals and extensions. And I agree, for myself and for my heirs, executors, administrators and next of kin, upon the expiration of the first term of any copyright in said compositions, in this or in any other country, to duly make, execute, acknowledge and deliver or to procure the due execution, acknowledgment and delivery to the Publisher, its successor, successors or assigns, of all papers necessary in order to secure to it the renewals and extensions of all copyrights in said compositions and all rights therein for the terms of such renewals and extensions."

5. Under Section 23 of the Copyright Act, the time for filing an application for the renewal copyright to the song "WHEN IRISH EYES ARE SMILING" commenced on August 12, 1939, the beginning of the twenty-eighth year of the first term of copyright.

6. On August 12, 1939, the respondent applied for and registered the renewal copyright in the names of the petitioner, Graff and Mrs. Olcott (the widow of Chauncey

Olcott, who had died prior to August 11, 1939) (R. 8, 26, 46, 47).

7. That same day, the respondent, as Graff's attorney in fact under the 1917 agreement, assigned to itself Graff's interest in the renewal copyright (Exh. F, R. 47-48). (Mrs. Olcott assigned her interest to the respondent on August 28, 1939 (Exh. G, R. 49). The validity of her renewal and her assignment is not in dispute.)

8. Petitioner Graff himself applied for the renewal on August 23, 1939, and, after registering it in his own name (R. 27; Exh. H, R. 50), assigned his interest to the petitioner Fred Fisher Music Co. Inc. (Exh. I, R. 51).

9. Mrs. Ball, as the widow of Ernest R. Ball, who had died prior to August 11, 1939, applied for and registered the renewal copyright in her name on November 15, 1939 (Exh. J, R. 26, 51), and assigned her interest to the defendant Mills Music, Inc. on July 8, 1940 (Exh. J, R. 52-55). (As in the case of Mrs. Olcott, the validity of Mrs. Ball's renewal copyright and her assignment to Mills Music, Inc. is not in question in this proceeding.)

10. The respondent, claiming the ownership of the renewal copyright, commenced an action for infringement against the petitioners, Graff and Fred Fisher Music, Inc., and Mills Music, Inc. (R. 21-31).

11. Simultaneously with the commencement of the action, the respondent moved for an injunction pendente lite against the petitioners, Graff and Fred Fisher Music Co. Inc. (R. 2-4). However, no preliminary injunction was sought against the defendant Mills Music, Inc., it being stated that this defendant did not threaten immediate publication of the song (R. 4).

12. The motion for temporary injunction against petitioners was granted by the United States District Court for the Southern District of New York and the petitioners were, during the pendency of the action, enjoined from

printing, publishing, copying or vending the song "WHEN IRISH EYES ARE SMILING" or licensing the use thereof, or asserting any claim or interest in the renewal copyright thereof (R. 81-82, 92). District Judge Conger's opinion appears at pages 83-91 of the record and is reported in 38 Fed. Supp. 72.

13. The interlocutory decree was affirmed by the United States Circuit Court for the Second Circuit, Judge Frank dissenting with opinion. Judge Clark's majority opinion appears at pages 95 to 105 of the record. Judge Frank's at pages 105 to 135; both opinions are reported in 125 Fed. (2d) 949, 954.

II

Statement of Jurisdiction.

The jurisdiction of this Court is invoked under the provisions of Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C. § 347(a)).

III

Question Presented.

The sole question is whether, in view of the limitations contained in Section 23 of the Copyright Law, particularly when read in the light of the Congressional intent expressed at the time of its enactment, an agreement to assign his renewal, made by an author in advance of the twenty-eighth year of the original term of copyright, is valid and enforceable.

IV

Statute Involved.

Section 23 of the Copyright Law (17 U. S. C. § 23) reads as follows:

"Duration; renewal. The copyright secured by this title shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided,* That in the case of any posthumous work or of any periodical, encyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright; *And provided further,* That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a encyclopedic or other composite work when such contribution has been separately registered,* the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright; *And provided further,* That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication. (Mar. 4, 1909, c. 320, § 23, 35 Stat. 1080.)"

* The clause "when such contribution has been separately registered" was deleted by Act of March 15, 1940, c. 57, § 4 Stat. 51. Otherwise, the Section has remained unchanged since 1909.

V

Reasons for Granting the Writ.

The United States Circuit Court of Appeals for the Second Circuit has decided an important question of Federal law which has not been, but should be, settled by the Supreme Court of the United States. The unsettled state of the law is indicated by both the majority opinion of Judge Clark and by the dissent of Judge Frank.

A definitive determination of this question is of the utmost importance to authors, to publishers and to users of copyrighted material. Affected by this question are the rights to the renewals of the vast number of copyrights to books, plays, musical compositions and to other literary and artistic material not coming within the limited exceptions contained in the first proviso to Section 23 of the Copyright Law.

The decision of the Circuit Court of Appeals on this important question is, we submit, untenable and contrary to the Copyright Act of 1909.

VI

Finality of Proceeding.

The petitioners are aware that ordinarily this Court will not review an interlocutory decree. However, in the instant case, the sole issue presented is one of statutory construction. The facts upon which this question is presented are not in dispute and are based upon documents, the execution of which is admitted. Should this writ be granted and the question of law determined in accordance with the petitioners' contentions, the practical effect will be a final determination of the action adverse to the respondent. Since the legal basis underlying its cause of action will have been destroyed, nothing will then remain but the formal dismissal of the complaint. Under these circumstances, we respectfully submit, a writ may issue.

Waialua Agricultural Co. v. Christian et al., 305 U. S. 91;

Prudence Co. v. Fidelity Co., 297 U. S. 198, 205;

Stringfellow v. Atlantic Coast Line R. Co., 290 U. S. 322;

United States v. Gulf Ref. Co., 268 U. S. 542.

Moreover, the decision in the instant case has already provided a precedent for the determination of other cases in the District Court for the Southern District of New York and in the Supreme Court of New York State.

Scheyn & Co., Inc. v. Veiller, 43 F. Supp. 491;

G. Schirmer, Inc. v. Robbins Music Corp. et al., 176 Misc. 578, 28 N. Y. Supp. (2d) 699;

Rossiter v. Vogel, U. S. D. C., So. Dist. of N. Y., June 30, 1942, not yet reported.

If, as we urge, the rule announced by the Circuit Court of Appeals is erroneous, undue prejudice may result from reliance thereon unless the law is settled by this Court.

WHEREFORE, petitioners pray that a writ of certiorari may issue out of and under the will of this Court, directed to the United States Circuit Court of Appeals for the Second Circuit, commanding the said Court to certify and send to this Court for review and determination, as provided by law, this cause and a complete transcript of the record and of all proceedings had herein; and that the order of the United States Circuit Court of Appeals affirming the interlocutory judgment in this cause may be reversed and that the petitioners may have such other and further relief in the premises as this Court may deem proper.

Dated, August 18th, 1942.

GEO. GRAFF,

FRED FISHER MUSIC CO., INC.,

By ANNA FISHER, President,

Petitioners.

(Seal)

ARTHUR GARFIELD HAYS,

Solicitor for Petitioners.

State of New York)
County of New York) ss.:

GEORGE GRAFF, JR., being duly sworn, says:

I am one of the petitioners herein. I have read the foregoing petition by me subscribed and know the contents thereof. The facts therein stated are true to the best of my knowledge, information and belief.

GEO. GRAFF.

Sworn to before me this
18th day of August, 1942.

ELIAS MESSING, Notary Public
Bronx Co. Clk. No. 169, Reg. No. 177-M-43
N. Y. Co. Clk. No. 1007, Reg. No. 3-M-634
Kings Co. Clk. No. 121, Reg. No. 3412
Commission expires March 30, 1943

State of New York,)
County of New York,) ss.:

ANNA FISHER, being duly sworn, deposes and says:

That I am President of Fred Fisher Music Co., Inc., one of the petitioners herein. I have read the foregoing petition by me subscribed and know the contents thereof. The facts therein stated are true to the best of my knowledge, information and belief.

ANNA FISHER.

Sworn to before me this
19th day of August, 1942.

ROBERT BLAUSTEIN
Notary Public, Kings Co. No. 140, Reg. No. 4145
Cert. filed in N. Y. Co. No. 360, Reg. No. 4B186
Commission expires March 39, 1944

(Seal)

State of New York,)
County of New York,) ss. :

I hereby certify that I have examined the foregoing petition for a writ of certiorari and that in my opinion it is well founded and the cause is one in which the petition should be granted.

ARTHUR GARFIELD HAYS.

Sworn to before me this
18th day of August, 1942.

ELIAS MESSING, Notary Public
Bronx Co. Clk. No. 169, Reg. No. 177-M-43
N. Y. Co. Clk. No. 1007, Reg. No. 3-M-634
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M. WITMARK & SONS,

Respondent.

**BRIEF IN SUPPORT OF PETITION FOR
CERTIORARI**

Jurisdiction

The statement of jurisdiction is set forth in the foregoing petition.

Statement of the Case

The facts have been set forth in the foregoing petition.

Summary of Argument

POINT I

The limitation contained in Section 23 of the Copyright Law of 1909 restricting the renewal privilege to the author and his family was designed to prevent the alienation of the renewal copyright prior to the twenty-eighth year of the original term.

POINT II

The history of copyright legislation in the United States supports the view that the renewal privilege may not be alienated by anticipatory assignment.

POINT III

The case is one of first impression.

POINT I

The limitation contained in Section 23 of the Copyright Law of 1909 restricting the renewal privilege to the author and his family was designed to prevent the alienation of the renewal copyright prior to the twenty-eighth year of the original term.

Section 23 of the Copyright Law provides for a basic copyright term of twenty-eight years. Its first clause reads:

"The copyright secured by this title shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: * * *"

It then makes provision for renewal copyright for an additional term of twenty-eight years. In four categories of literary work, the proprietor under the statute becomes entitled to the renewal. They are (a) works published posthumously; (b) periodical, cyclopedic or other composite works on which copyright was originally secured by the proprietor; (c) works copyrighted by a corporation *otherwise than as assignee* or licensee of the individual author; and (d) works made for hire.

In all other cases, there is the limitation that only the author, if he be living, or his family, if he be dead, is entitled to the renewal. This portion of Section 23 reads:

"And provided further, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work when such contribution has been separately registered, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: And provided further, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication."

It will be observed that there is no provision made here which would entitle an assignee of the author, a proprietor or the author's administrators to the renewal. In this respect, it differs from the language of Section 8, of the same statute which, in referring to the original copyright, recites:

"The author or proprietor of any work made the subject of copyright by this title, *or his executors, administrators, or assigns*, shall have copyright for such work under the conditions and for the terms specified in this title * * *". (Italics ours.)

The exclusion of the assignee from the renewal privilege was not due to inadvertence, but constituted an integral part of the pattern by which Congress sought to preserve for the author and his family the economic benefits which might flow from the survival of a work beyond the original copyright term.

This purpose is explained in the report of the House Committee on Patents which recommended the bill (H. R.

2222, 60th Congress, 2nd Session, page 14). When the Copyright Law was in the course of revision in 1909, a proposal had been advanced that renewals be eliminated and that there be substituted a single term to extend for the life of the author and fifty years. In rejecting the change in pattern, the Committee said:

"Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right.

"The present term of twenty-eight years, with the right of renewal for fourteen years, in many cases is insufficient. The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period that there would be no probability of its being taken away from him in his old age, when, perhaps, he needs it the most."

Based upon this pattern, it is now settled that this renewal copyright is a new grant not stemming from ownership of the original copyright, that an assignee of the author may not apply for the renewal and that the application therefor must be filed by the persons named in the statute, in the order of their designation.

28 Opinions of Attorneys General, 162;

Fox Film Corp. v. Knowles, 261 U. S. 326;

White-Smith Music Publishing Co. v. Goff, 187 Fed. 247;

Silverman v. Sunrise Pictures Corp., 273 Fed. 909, cert. denied 262 U. S. 758;

Danks v. Gordon, 272 Fed. 821;

Harris v. Coca-Cola Co., 73 Fed. (2d) 370;

Yardley v. Houghton Mifflin Co. Inc., 108 Fed. (2d) 28, 32.

Moreover, it will not be disputed that no act on the part of the author, if he fails to survive, can have the effect of defeating the right to the renewal accorded by the statute to the widow, children and other persons named. Judge Clark, writing for the majority in the Court below, said (125 Fed. (2d) 949, at 950, R. 97):

"It is also apparent that the assignment here would not have cut off the rights of renewal extended to the widow, children, executors, or next of kin, in the event of Graff's death prior to the renewal period. See *Fox Film Corp. v. Knowles*, 261 U. S. 326."

The point of divergence in the Court below was the extent to which the statute provided a safeguard to the author himself against his own improvident act.

As to this, the majority of the Court reached the conclusion that despite the limitations written into the statute, and despite the purpose expressed in the report of the Patent Committee, the intent to make the renewal inalienable by anticipatory assignment had not been expressed with sufficient clarity to effect that purpose. Stress was laid upon the absence of language specifically providing that an attempted anticipatory assignment would be void and of no effect."

The Committee's report and the purpose of the statute will be referred to later. At this juncture, we submit that undue weight was given to the absence of prohibitory language in the statute. If, as we contend, it was the purpose of Congress to reserve to the author a renewal right which could not be alienated in advance of its accrual, the limitation contained in the Act to the effect that the author shall be entitled to the renewal if living, is sufficient to accomplish that purpose.

The courts will effectuate the policy of a statute by holding unenforceable contracts in contravention thereof, although the statute itself contains no express prohibitions.

Restatement of the Law of Contracts, Sections 512, 580, 2(e), Illustration of Clause (e).

In this respect, the case comes within the principle applied by this Court in *Avotin v. Atlas Exchange Bank*, 295 U. S. 209, which concerned the validity of an agreement by a national bank to repurchase securities previously sold to a customer. The Act provided "That the business of buying and selling investment securities shall hereafter be limited to buying and selling without recourse marketable obligations evidencing indebtedness of any person * * * or corporation, in the form of bonds, notes and/or debentures, commonly known as investment securities."

The contract was held invalid as coming "within the broad sweep of the statute which by mandatory language sets up definite limits upon the liability which may be incurred by a national bank * * * (p. 211)."

In *Kneettle v. Newcomb*, 22 N. Y. 249, the New York Court of Appeals held unenforceable an agreement by which a debtor had purported to waive and relinquish his statutory right of exemption of property from execution, although there was no provision in the statute expressly invalidating such agreements. It said, at pages 251-252:

"By the statutes exempting certain property, the legislature in effect determined that it was inexpedient to allow contracts entailing such results; and this was done by providing that certain property, of limited value, should not be taken. Parties cannot now stipulate that their contracts shall have the same effect as under the former law, for that would be hostile to the policy thus established."

See also:

Bunker v. Coons (Utah), 60 Pac. 549;

Meyer Bros. Drug Co. v. Bybee (Mo.), 78 S. W. 579;

Green v. Watson, 75 Ga. 471;

Mills v. Bennett (Tenn.), 30 S. W. 748.

Regarding the Congressional Report, the majority said:

"We are perfectly willing to uphold a Congressional declaration that public policy forbids assignment of a copyright renewal; but we expect something more than ambiguous inferences drawn from a committee report explicitly arguing only for continuance of an existing statutory scheme with a new renewal period" (125 Fed. (2d) 949, 954, R. 104).

Judge Frank, dissenting, reasoned:

"The Committees almost literally described the facts of the instant case: Graff sold outright his original term for a small sum. His turned out to be one 'of the comparatively few cases where the work survives the original term.' It was to meet just such a contingency, the Committees said, that Congress gave 'the author the exclusive right' to 'an adequate renewal term' so that he could, in such a case, 'reap the reward' in his old age. We should see to it, that, as Congress intended, the 'right of the author to take the renewal term' is so hedged about that he can *'not be deprived of that right'* by having it *'taken away from him in his old age when he needs it the most.'*

"I find it difficult to regard those expressions of the Committees as mere idle talk, or as so ambiguous that we can laugh them off * * *" (125 Fed. (2d) 949, 958, R. 113). (Italics quoted from the record.)

With all deference to the majority in the Court below, we urge that the Committee's report has been read much too narrowly. In the course of the argument for the continuance of the statutory scheme, the Committee stated the purpose of the renewal and the reason for its retention. The report refers not to the necessity of protecting the author's widow and children, but to the desirability of safeguarding the author himself, particularly in his old age.

When the Committee wrote that "it should be the *exclusive* right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right", it obviously had in

mind something more than the mere power of an author to withhold from a purchaser some interest in the copyright. Had the renewal been treated merely as an expectancy, subject to conveyance or retention as the author chose, there would be no purpose in the reference to the "exclusive right" of the author to take the renewal term, or the possibility that he might be deprived of it. Concession must be made to the Congressional knowledge that an assignee could acquire the renewal only if the author chose to convey it and would have no interest in the renewal if the author elected to retain it. The use of the expression "deprive" can refer logically only to a relinquishment by the author's act, occasioned by his own improvidence.

The Committee was not dealing in a vacuum. It was interested in the practical consequences of retaining the pattern of a renewal copyright. It sought to forestall disposition by the author of his entire interest in the copyrighted work until time had established its worth. It is difficult to see how this purpose is achieved by construing the statute to permit the author to include in the sale for the same pittance the renewal as well as the original term. The renewal privilege was accordingly limited so that the author, despite himself, might have the "exclusive right" and therefore a new opportunity to bargain for the exploitation of his work at the end of twenty-eight years and to derive whatever financial benefit might accrue from the fact that his property was sufficiently meritorious to have a monetary value after that length of time.

Construed as it has been in the Court below, the limitations of Section 23 are relegated to mere administrative formalities. The inability to make a present assignment is considered only from a functional viewpoint because the interest has no present existence and, as though no public policy created a barrier. To say that the renewal may be alienated through the device of an agreement to assign, or, as in this case, an agreement fortified by the appointment of

the assignee as attorney-in-fact to file the application and to make the assignment to itself, retains merely the form of not depriving the author of his exclusive right to the renewal, but frustrates the attempt to provide for the author a benefit having actual economic substance.

The suggestion that authors and their widows ought not be deprived of the opportunity to realize money by anticipating upon the statutory renewal, contemplates a highly illusory benefit. Congress certainly did not intend to subject an author and his family to the hazard of improvident sales. Yet, that is the very consequence which results from the interpretation given to the statute. Were the renewal wholly alienable, an author or his widow might sell it for an amount commensurate with the value of the literary property. There is, however, no way in which an author can convey a full and complete title to the renewal prior to the twenty-eighth year. If he be permitted to anticipate on his renewal, what he can sell is at most the expectancy based on survival. No purchaser could logically be expected to pay full value for property which he may never receive. If the wife be joined in the conveyance, the title is still not complete, since if she fails to survive the right of renewal will pass unimpaired to the children. Efforts to join the children in the sale present questions of infancy and of the possibility of the birth of additional children. (As to a suggestion that the widow and children would not be bound by their joining in the contract, since this would be against the policy of the Act, see Howell, *The Copyright Law* (1942) p. 109.) Consequently, the shield erected for the necessitous author becomes a weapon to diminish or completely destroy his bargaining power.

On the other hand, if the statute be construed to prohibit anticipatory assignments, the limitations which it provides and the announced purpose of Congress become consistent. In the twenty-eighth year, the author, if he be alive, or his widow or children, if he be dead, can convey

a full marketable title to the property. What they receive in return is not diluted by the hazards of non-survival. This, we submit, is what the Committee had in mind and was the meaning intended by the limitations enacted into the statute.

True, by this construction, the author is deprived of a right to sell his renewal before the twenty-eighth year arrives. By the same token, individuals are deprived of the right to pay usurious rates of interest, or to waive homestead and other statutory exemptions in order to borrow money. A beneficiary of a trust is often deprived of his right to assign his income (*Stringer v. Young*, 191 N. Y. 157). Employees are deprived of their right to work for less than minimum wages or to work overtime without statutory compensation. These examples might be expanded indefinitely and the considerations in all the instances are of like character. The law often limits the individual's freedom of action in the interests of the broader public policy to be served. If, as must be conceded in the instant case, Congress has the power to impose the limitation, the wisdom or folly of the restriction is a matter only of legislative concern.

Dillingham v. McLaughlin, 264 U. S. 370, at 374.

POINT II

The history of copyright legislation in the United States supports the view that the renewal privilege may not be alienated by anticipatory assignment.

In the first point of this brief our argument was addressed to the limitation contained in Section 23 of the Copyright Law of 1909 and its construction, particularly in the light of the report of the Patents Committee. The Committee in its report refers to the existing law, which

we submit did not by the statutory provisions after 1831 permit anticipatory alienation of the renewal copyright.

An examination of the history of copyright legislation in the United States reveals that under the first federal copyright statute enacted in 1790, an assignee, by express provision, not only could acquire the author's interest in the renewal, but was entitled to perfect that renewal in his own right. The statute (1 Stat. at L. 124) provided that:

"* * * if, at the expiration of the said term, the author or authors, * * * be living, * * * the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years: Provided, *he or they shall cause the title thereof to be a second time recorded and published * * * within six months before the expiration of the first term of fourteen years aforesaid.*" (Italics ours.)

When, however, the Act was amended in 1831, reference to the assignee was eliminated and the right limited to the author and his family (4 Stat. at L. 436, Sec. 2):

"That if, at the expiration of the aforesaid term of years, such author, * * * be still living, and a citizen * * * of the United States, or resident therein, or being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued *to such author, * * * or, if dead, then to such widow and child, or children,* for the further term of fourteen years." (Italics ours.)

Concerning this change in the form of the statute, Judge Putnam, writing for the Court in *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247, said (p. 250):

"Here, then, was an entirely new policy, completely disavowing the title, breaking up the continuance in a proper sense of the word, whatever terms might be used, and vesting an absolutely new title *eo nomine* in the persons designated."

The copyright statutes of 1870 (16 Stat. at L. 212, 213) and 1891 (26 Stat. at L. 1107) continued the policy of the 1831 Act in its departure from the law of 1790. Section 88 of the Act of 1870 makes it clear that the application for renewal must be filed in the name of the author, his widow or his children, and that the obligation rests upon them to publish notices thereof. It provides:

"* * * that the author * * * if he be still living * * * or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work * * *. And *such person* shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers * * *." (Italics ours.)

The amendment of 1891 (26 Stat. at L. 1107) contains the same provision, but eliminates a requirement that the author be a citizen or resident of the United States.

It is difficult to explain the change in the pattern of the copyright law and the elimination of the assignee from the category of persons entitled to take the renewal unless it be integrated with a public policy to prevent an anticipatory alienation by the author. The suggestion that this change may have come about only to prevent the author from disposing of the right extended to his widow and his children, if he himself failed to survive, does not account for various factors of the statute. There is, for instance, no machinery provided by which an assignee of an author may perfect his right to the renewal by filing an application in his own name, if the author be living. Under the Statute of 1790, an assignment of the renewal was permitted and the assignee was given the privilege of recording it in his own name. Since 1831, however, the assignee has been denied that privilege, and the statute has accordingly provided no machinery by which an application for renewal may be filed by him. It seems strange that Con-

gress should have destroyed this machinery unless it intended to reserve to the author the "exclusive right" to both the legal and the beneficial ownership of the renewal.

The suggestion also fails to account for a similar exclusion of an assignee in an earlier portion of Section 23 of the 1909 Act. It will be remembered that in the category of works to which a proprietor of the copyright is entitled to renewal are those originally "copyrighted by a corporate body, *otherwise than as assignee* or licensee of the individual author." The statute makes no distinction between the effect of the assignment if the author survives and its effect when the author fails to live for twenty-eight years. In neither case may the corporate body originally copyrighting the work take the renewal in its own right under the statute. There could have been no purpose in excluding the corporate assignee entirely, if the intention had been to permit anticipatory assignments dependent solely on the author's survival. The logical provision would have been to have excluded the corporate body only if the author were not living.

In conclusion on this point, we respectfully urge that the majority in the court below misconceived the purpose which led to the change in the renewal structure in 1831 and which has continued to the present day. The careful distinction made by Congress between those categories of works in which the proprietor is entitled to the renewal, and those in which the author has the exclusive right, the limitations upon the right to apply for the renewal, the explanation of its purpose by the Congressional Committee, all present a uniform design. They point to the intention to create the renewal as a privilege personal to the author, to which he has the "exclusive right" in the twenty-eighth year, and one which by the policy enacted in the statute, he may not dissipate. The renewal is inalienable not because it is an expectancy, but because Congress chose to treat the author as though he were the beneficiary of a spendthrift trust.

POINT III

The case is one of first impression.

The present case is the first under the Copyright Law of 1909 to pass directly upon the obligation of a surviving author to assign his renewal pursuant to an anticipatory agreement. The question remained unadjudicated under the various statutes enacted in and after the year 1831. Three early cases, *Paige v. Banks*, 80 U. S. (13 Wall.) 608, *Cowen v. Banks*, 24 How. Pr. 72 and *Pierpont v. Fowle*, 2 Woodb. & M. 23, 19 Fed. Cas. 652, are however sometimes referred to as authority that such an assignment is valid.

Although these cases were decided after 1831 they actually determined rights already vested in the assignee under the Act of 1790, which by its terms expressly permitted an anticipatory assignment of the renewal.

In *Paige v. Banks*, the assignment of the author's right, title and interest had been made in 1828. In *Pierpont v. Fowle*, the agreements had been made on July 21, 1823 and on July 12, 1827, respectively. In *Cowen v. Banks*, the assignee's rights had likewise vested before the enactment of the Copyright Law of 1831.

As authority for this distinction, we have the statement of Judge Putnam in *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247, at 253:

"On examining *Paige v. Banks*, as reported in 13 Wall., it appears at page 609 (20 L. Ed. 709) that the contract on which the publisher relied was made in 1828, when the act of 1790 was in force, and when no rule of public policy such as we have explained existed or had been declared."

See also:

28 Ops. Atty Gen. 162, at 168.

Another case sometimes referred to as justification for enforcing these contracts is *Carnan v. Bowles*, 2 Bro. C. C.

80, which was decided in 1786 and construed an early English statute, 8 Anne c. 19. That Act was there considered as providing a reversion by way of recapture in favor of the author at the end of fourteen years. The second fourteen year period of copyright, contingent upon the author's survival, was not considered to be a new grant, but the "return" of a portion of a larger grant.

In this respect, the entire concept of the English law was different from that which underlies Section 23 of the Copyright Law of 1909 and its predecessors since 1831. It is well settled that the renewal is under our statute a new grant not dependent on ownership of the original copyright.

For Film Corp. v. Knowles, 261 U. S. 326;

White Smith Music Publishing Co. v. Goff, 187 Fed. 247.

The danger of arguing from the English cases is demonstrated by the difference in the development of the English Copyright Law as compared to that of the United States. Although the Statute of Anne had contained no reference to assignees, the amendment adopted in 1814 made specific provision for them. The Statute (54 George III, c. 156, p. 817) provided (§ IV, p. 820):

"from and after the passing of this Act, the author * * * and his assignee or assigns, shall have the sole liberty of printing and reprinting such book or books, for the full term of twenty-eight years, * * * and also, if the author shall be living at the end of that period, for the residue of his natural life." (Italics ours.)

The law in this country, as we demonstrated in Point II of this brief, took an opposite course. The Statute of 1790, by its express language, entitled the assignee of an author to take the renewal. The revision of 1831, in contrast to the earlier Act and to the development in the English law, excluded the assignee and limited the right of renewal to the author and his family.

The writings of the text books on Copyright Law present a confusing picture. In deference to the supposed authority of the earlier decisions, and with little regard to the policy which led to the change in the statute, statements are made that an agreement by an author to assign his renewal will be enforced.

Some of the more recent writers have, however, (by the manner of their statement) indicated their mental disquiet over the apparent incongruity between this doctrine and the Congressional intent. Weil (*Copyright Law*, 1917) says (pp. 305, 306):

"If the author be living when a copyright expires, *he may, it seems, be compelled, in a proper case, to assign the renewal copyright to the proprietor of the original copyright, if the contract between them so provided.*" (Italics ours.)

See also:

Boeker: Copyright, Its History and Its Law, 1912, page 117;

De Wolf: Outline of Copyright Law, 1925, page 66.

Mr. Howell (*The Copyright Law*, 1912), formerly Assistant Register of Copyrights, after referring to the present case, hastens to add at page 109:

"The renewal right being personal to the author, it is doubtful whether, in the event of his dying before the statutory year arrives, the widow or children could be bound by having joined in any such contract. This would plainly be contrary to the general policy of the Act, and enable the author to accomplish indirectly what he is not permitted to do directly."

It would seem that this reasoning should apply with equal force to an attempted assignment by the author of his interest in the renewal.

Among the earlier writers, MacGillivray (*The Law of Copyright*, 1902), saw the necessity of resolving the conflict, and found what seemed to him a logical solution by

destroying the renewal entirely, if the beneficial ownership of the literary work no longer remained in the author. He reasoned (p. 268) :

"If the author of an unpublished work conveys all right, title, and interest in it to another, he certainly cannot take out an extended term to run against his grantee. It seems doubtful whether he can take it out at all. Certainly his grantee cannot, and probably the author could not for his benefit."

For a similar suggestion, see Bowker, *Copyright, Its History and Its Law*, page 118.

Morgan (2, *The Law of Literature*, 1875, 227) proposed the solution of recourse to a court of equity, saying, that the assignee of a renewal is "entitled to be protected in it, in equity rather than according to any mere technical rule of law." It is surprising that a policy established by the Legislature should be considered as a mere technicality.

Of all the writers, Drone (*Copyright*, 1879) came out most squarely and argued that the author could in addition to divesting himself of his renewal privilege upon survival, defeat as well the interest in the renewal which extended under the statute to his widow and children. Mr. Drone's view was that an author who had parted with his entire interest in the work thereby conveyed the entire renewal privilege.

Drone on Copyright, pages 326, 327, 333.

He said (p. 327) :

"Their title is derived from him, and stands or falls with his. There must be a good foundation on which to rest their claim. If the author has parted with his absolute property in the work, and could not, if living, himself secure the copyright, it seems to be clear that his representatives are equally incapable of securing it, for the reason that the work does not belong to them."

This position was predicated upon the reasoning that (p. 327):

"The provision under consideration was, doubtless, intended to secure to the author, and his family a privilege which is not given directly to an assignee; but it is not reasonable to suppose that the object of the statute was to reserve to the author or his family any rights with which he has voluntarily parted, and for which he has received and enjoyed the consideration." (Italics ours.)

Drone's concept of the nature of the renewal right, and of the protection intended to be afforded by Congress has been rejected by the courts and is negatived by the Committee's report, when the law was later revised in 1909. At least to the extent of the widow and children, the majority in the Court below were of the opinion that the author's conveyance would not have cut off the rights granted to Graff's widow, children, etc. (125 Fed. (2d) 949, at 950, R. 97).

See also:

Marchetti: Law of the Stage, Screen and Radio, 1936, 67;

Curtis: The Law of Copyright, 1847, 235;

2 Ladas: The International Protection of Literary and Artistic Property, 1938, 773;

Wittenberg: Literary Property 1937, 45;

Frohlich & Schwartz: The Law of Motion Pictures 1918, 549;

Amdur: Copyright Law and Practice 1936, 532, 538, 540-541.

Reference was made in the Court below to an opinion of the Attorney General issued in 1910 (28 Ops. Atty. Gen. 162) ruling that the statute did not authorize the filing of applications by assignees. While in the course of his opinion, the Attorney General made the observation that rights in the renewal might be the subject of a valid contract

which would carry the equitable, if not legal, title, he pointed out at pp. 169, 170:

"It is not intended in this opinion to determine any question of law which relates to the relative rights of authors and their assigns, and such rights are mentioned only by way of illustration or argument."

There is likewise a reference to *Tobani v. Carl Fischer, Inc.*, 98 Fed. (2d) 57, cert. denied 305 U. S. 650, where, in a dictum, Judge Manton stated that an author might divest himself of his renewal by parting absolutely with his entire interest in the work, or by agreement to convey the copyright for the renewal term. That statement was not, however, necessary to the decision since the claim of the publisher was that the works in question were made for hire, and that the proprietor was entitled to the renewal by the correlation of Sections 62 and 24 of the Copyright Law. Moreover, as Judge Frank indicated in his dissent below (R. 110), the force of the decision in the *Tobani* case was weakened by a later opinion—*Shapiro, Bernstein & Co. v. Bryn*, 123 Fed. (2d) 697, at 700.

We submit, that because of the uncertainty in the law, the question presented by this case, is one which deserves the consideration of this Court. Copyrights to works published since 1909, a most prolific era, are becoming more and more important for renewal purposes. Modern inventions, such as motion pictures, radio, television, and the like, have resulted in the revival of many types of literary works, particularly of plays and musical compositions.

We respectfully urge that the decision in the Court below was erroneous in that it fails to give effect to the intent of Congress which sought by the limitations in the statute to preserve to the author the exclusive right to the benefits and economic advantages which flow from the pattern of the statute. We believe that the Court below fell into the error of viewing the limitations in the statute as technical impediments, which might be overcome by in-

genious draftsmanship of contracts or by doctrines of specific performance in a court of equity.

Congress had a purpose when it revised the Copyright Law in 1831 and eliminated from the renewal benefits assignees of authors. The nature and intent of that purpose was given expression in the Committee Report of 1909 when a single term was rejected and when Congress likewise rejected a proposal which would have required that authors and publishers unite in the application for renewal where a publisher had made investments in plates. (Bowker: Copyright, Its History and Its Law, 117.)

To limit that purpose to the safeguarding only of widows and children of deceased authors, and to deprive the surviving author of protective barriers erected by Congress, seems to frustrate the very purpose which the Congressional Committee contemplated when reference was made to the benefits which would enure to the author by the retention of the renewal pattern.

Retaining the form of the statute by requiring application to be made by or in the name of the author, and disregarding beneficial ownership, seems utterly inconsistent. Congress obviously intended the author have the tangible fruits of the renewal in the twenty-eighth year, not merely the empty privilege of having the application registered in his name.

Conclusion

We respectfully pray that the petition for certiorari be granted.

Respectfully submitted,

ARTHUR GARFIELD HAYS,
Solicitor for Petitioner

No 327

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IN THE
Supreme Court of the United States

OCTOBER TERM, 1942

**FRED FISHER MUSIC CO. INC. and GEORGE
GRAFF, Jr.,**

Petitioners,

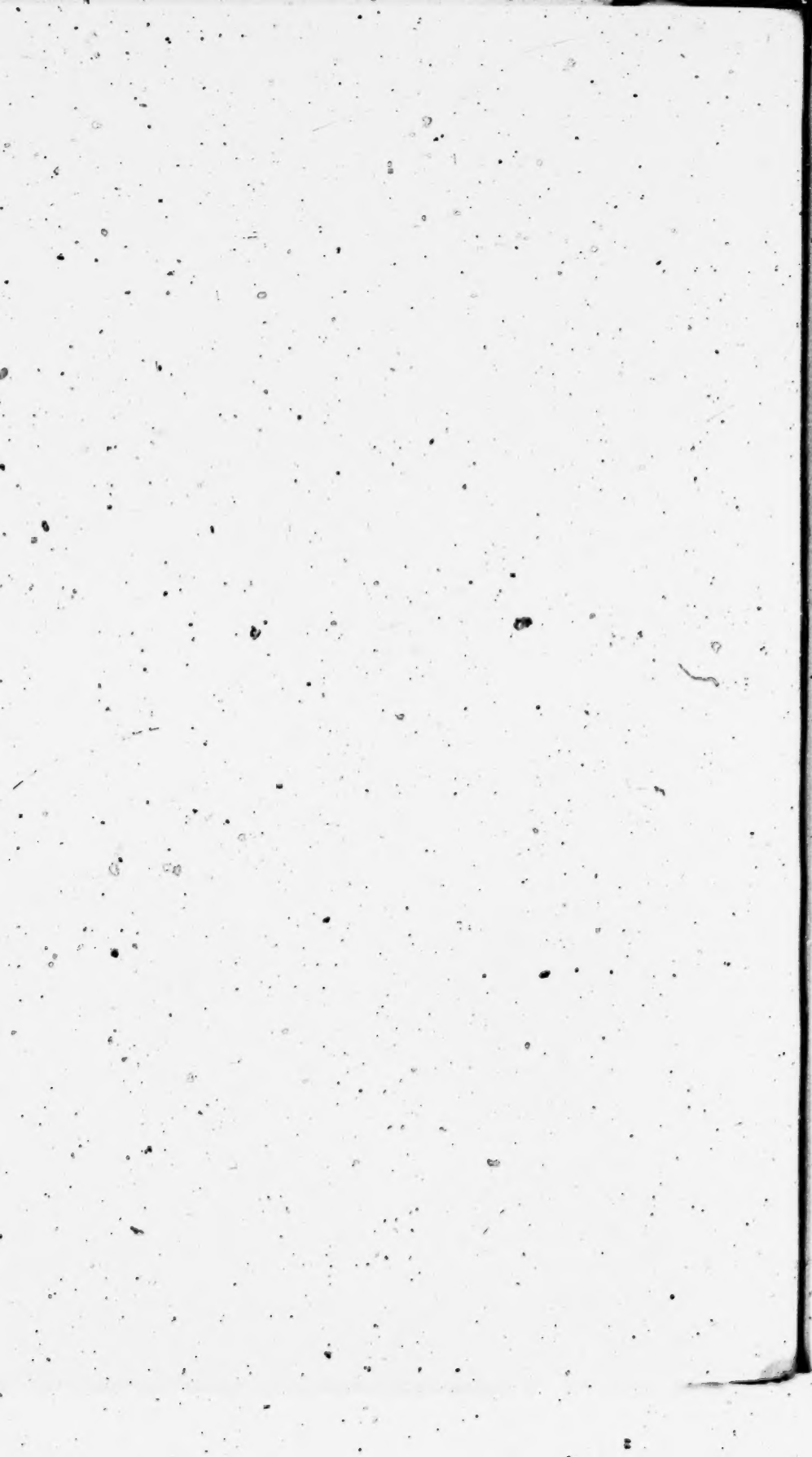
against

M. WITMARK & SONS,

Respondent.

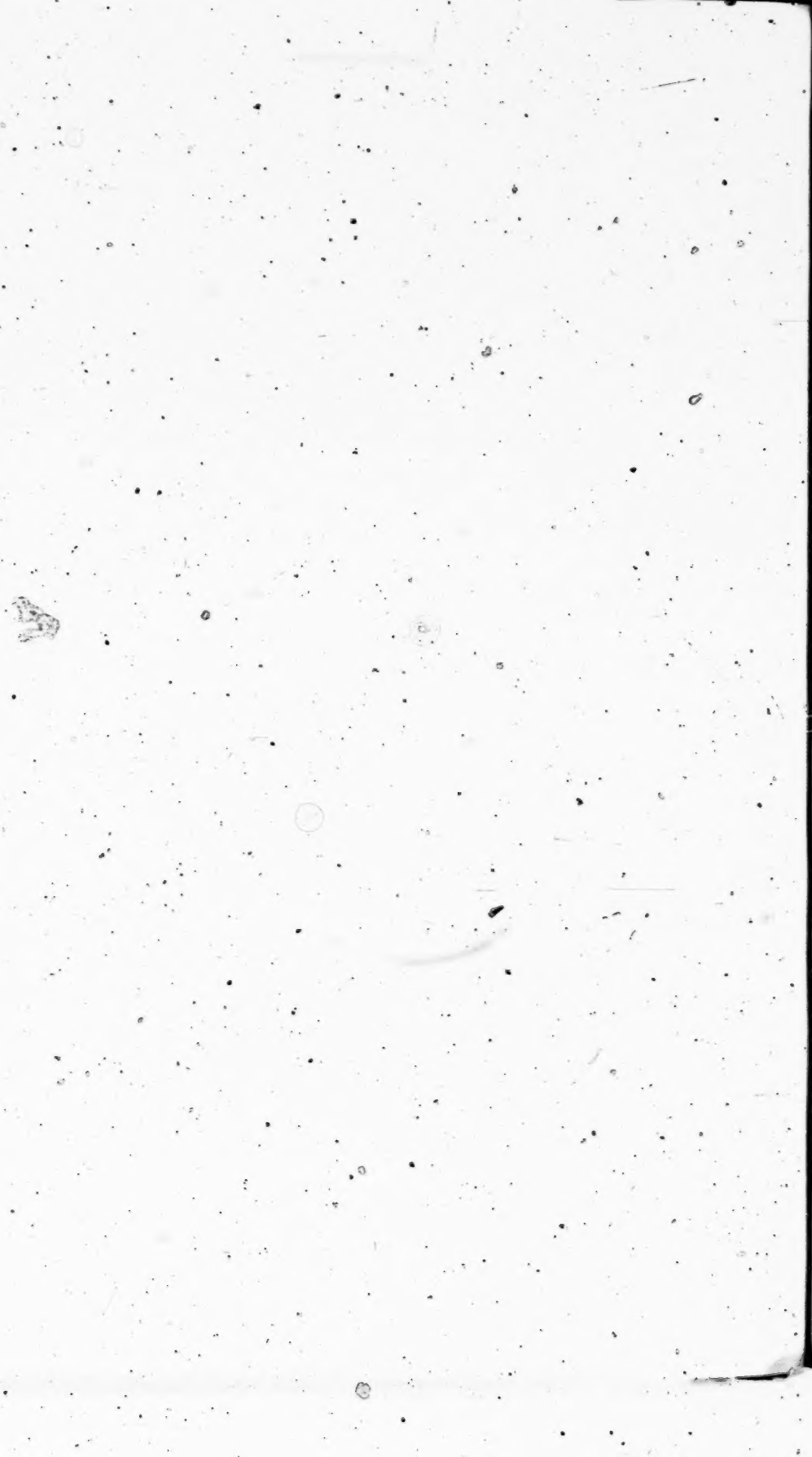
PETITIONERS' REPLY BRIEF

**ARTHUR GARFIELD HAYS,
Solicitor for Petitioners.**



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IN THE
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OCTOBER TERM, 1942

FRED FISHER MUSIC CO. INC. and GEORGE GRAFF, JR.,

Petitioners,

against

M. WITMARK & SONS,

Respondent.

PETITIONERS' REPLY BRIEF

Respondent urges that certiorari should not be granted because the order sought to be reviewed is interlocutory. We indicated in the petition our realization that this Court is reluctant to review cases which have not reached final judgment. The relief for which we ask is not lightly granted. The power does, however, exist, and where the question is one of public interest and general importance, this Court may, in the exercise of its discretion, review a case at any stage of the proceedings.

American Const. Co. v. Jacksonville Ry., 148 U. S. 372, at 385;

Hamilton Shoe Co. v. Wolf Bros., 240 U. S. 251, at 258.

Respondent makes no attempt to deny that the question of law decided in the case at bar is one of public interest

and general importance. On the contrary, it speaks of the difficult problems "affecting the rights of authors, and of the public" which might be involved in a decision contrary to that which prevailed in the Court below. (Brief, p. 17).

The argument is advanced that the law is settled beyond controversy, and yet, we have the dissent of Judge Frank and the concession of the majority that:

"After 1909, it is true that some of the experts tended to hedge. Four treatises published after the new act went into effect state that probably an assignment can be enforced; but three others are fairly definite about it. Only one of those we have found seems to deny assignability" (R. 100-101).

The problem presented in this case is of importance not only to the petitioners and to the respondent, but to every author in the United States, to every purchaser of copyright, and to every user of copyrighted material. It affects not only contracts made in the past, but furnishes a guide for future conduct.

Especially because of the sharp divergence of opinion in the Court below, there remains, until this Court should speak, a continued uncertainty concerning the validity of contracts by which an author purports to sell his renewal rights in advance of the twenty-eighth year of copyright. Upon the ultimate decision of this Court rests the claim to ownership of renewal rights which have been sold or which may hereafter be conveyed.

As we stated in the petition, three cases have already been decided on the precedent established in the instant case.

In *Schwinn & Co. v. Veiller*, 43 Fed. Supp. 491, the playwright, Bayard Veiller, was directed to assign his renewed copyright in the play "WITHIN THE LAW" to a corporation which had been dissolved and whose corporate existence

was revived only after the commencement of the action. Judge Rifkin said (43 Fed. Supp. 491, at 494):

"The second prayer of the complaint is for a direction that defendant assign the renewal copyright to plaintiff. It raises the same issue as the Witmark case and has been settled for this Court by the Circuit Court of Appeals. *M. Witmark & Sons v. Fred Fisher Music Co., Inc.*, 2 Cir., 125 F. 2d 949, decided February 11, 1942. I am constrained, by the authority of that decision, to hold that plaintiff is entitled to a decree adjudicating that as against the defendant it is the owner of the renewal copyright."

See also:

G. Schirmer, Inc. v. Robbins Music Corp., et al.,
176 Misc. 578, 28 N. Y. Supp. (2d) 699;

Rossiter v. Vogel, U. S. D. C., So. Dist. of N. Y.,
June 30, 1942, not yet reported.

- One need but look at the shelves of a library, or at newspapers or magazines, or attend concerts and theatres, or to listen to the radio, to realize the wealth of material covered by copyright. New works are created day by day. Some of them will have a long life, others an early death. Most of them are covered by copyright. In many, if not in most instances, the copyrights have been, and will continue to be owned for the original term by the publishers and other entrepreneurs. It is important for them, as well as for authors, to know who controls the renewal privilege when it comes into being in the twenty-eighth year of the original term. It is likewise important that there be certainty in respect of the renewal copyrights in the many literary and artistic works which were created within the past quarter of a century. Is the beneficial ownership of the renewal privilege confined to the author, as Congress seems to have intended, or may it pass to a publisher under contract because Congress failed to make its intention clear? Until

the issue is ultimately decided by this Court, there can be no certainty, doubt will remain, and reasonable men may continue to differ on the question.

That type of doubt, as Judge Rifkin points out in *Selwyn & Co. v. Veiller*, 43 Fed. Supp. 491, caused a motion picture company to pay a substantial sum to an author to insure itself against the contingency that the courts might hold that the author, and not his assignee, was the true owner of the renewal copyright (43 Fed. Supp. 491, at 493). Whether it would have paid the same sum only for a quitclaim from the author's wife and son is, of course, conjectural.

Consequently, the circumstance that your petitioners may possibly defend at a trial on the theory that the contract lacked consideration adequate to make it enforceable in equity, is overshadowed by the larger principle involved. The question of interpretation of the statute strikes at the very heart of the respondent's cause of action. In the determination of this issue, there is no disputed question of fact. The making of the contracts is admitted, and for the purposes of this issue of law petitioners assume that the consideration was legally sufficient. If the statute be interpreted as we contend it should be, the litigation is to all intents and purposes at an end. As Judge Clark's opinion shows, it was to this specific issue that the arguments in the Circuit Court of Appeals were confined (R. 104).

Because of the general importance of the question and the public interest involved, we respectfully pray for the exercise of the Court's discretion, on the ground this is an extraordinary case. Petitioners and respondent are now symbols in a controversy, the scope of which transcends their private interests. The ownership of the song "WHEN IRISH EYES ARE SMILING" is important to

them individually. Of even greater importance is the control of the renewal privilege by authors on the one hand, or by copyright proprietors on the other. That affects literally thousands of people in the United States who make their living by writing and creating, or by publishing or utilizing copyrighted material.

We therefore pray that despite the interlocutory character of the order, certiorari be granted.

Respectfully submitted,

ARTHUR GARFIELD HAYS,
Solicitor for Petitioners.

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CHARLES EDWARD JOSEPH
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Supreme Court of the United States

OCTOBER TERM—1942

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Petitioners,

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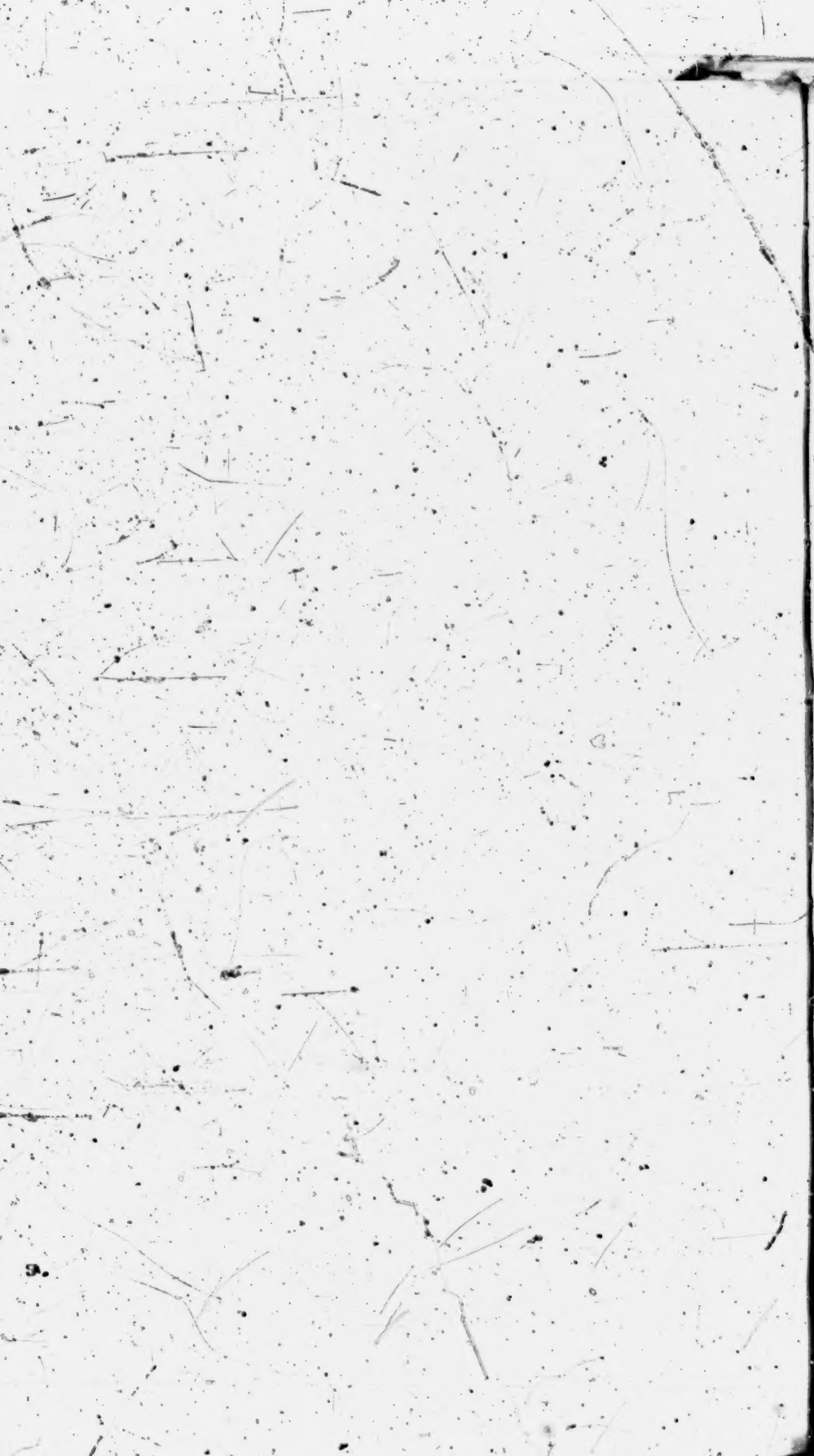
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BRIEF FOR PETITIONERS

ARTHUR GARFIELD HAYS,
Solicitor for Petitioners.

JOHN SCHULMAN,
of Counsel.



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Supreme Court of the United States

OCTOBER TERM—1942

FRED FISHER MUSIC CO. INC. and GEORGE GRAFF, JR.,

Petitioners,

against

M. WITMARK & SONS,

Respondent.

BRIEF FOR PETITIONERS

This cause comes before this Court upon writ of certiorari to the Circuit Court of Appeals for the Second Circuit granted October 12, 1942 (R. 117).

The Decision Below

The opinion of the Circuit Court of Appeals is reported in 125 Fed. (2d) 949 (R. 75). There was a dissent by Judge Frank (125 Fed. (2d) 954 (R. 85)).

The Circuit Court of Appeals affirmed an interlocutory decree of the District Court for the Southern District of New York which granted to the respondents (plaintiffs below) an interlocutory injunction in a copyright infringement case.

Jurisdiction of the Court

The jurisdiction of this Court is invoked under the provisions of Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C., Section 347(a)).

Statement of the Case

This case involves the construction of the renewal provisions of the Copyright Act of 1909 (17 U. S. C. A., Section 23). As stated by Judge Clark, writing for the majority in the Circuit Court of Appeals (R. 75, 125 Fed. (2d) 949):

"We are presented with a question of statutory construction which has apparently never arisen before, though the general statutory provision has existed for over a hundred years. Simply stated, the problem is whether or not a copyright holder may assign his expectancy of the renewal right which arises under 17 U. S. C. A. § 23 at the expiration of the original twenty-eight year copyright grant."

The subject matter of the suit is the ownership of the author Graff's interest in the renewal copyright to the song "WHEN IRISH EYES ARE SMILING", which was originally copyrighted in 1912 and which became available for renewal in 1939.

The respondent claims ownership under an agreement made in 1917, twenty-two years before the renewal could be obtained or applied for, and also under an agreement made in 1910, two years before the song was written.

Petitioners contend that since Section 23 of the Copyright Law (17 U. S. C. A.) created the renewal term and limited the right to apply for it to the author or his family for the purpose of protecting them against an improvident disposition of the renewal copyright prior to its accrual, the assignments under which respondent claims are void and unenforceable.

The majority of the Circuit Court of Appeals (Judges Clark and A. N. Hand) sustained the validity of the anticipatory assignment; Judge Frank dissented.

The Facts

1. In 1912, the petitioner Graff, in collaboration with Ernest R. Ball and Chauncey Olcott, wrote the song "WHEN IRISH EYES ARE SMILING" (R. 16; 51).

2. It was published and copyrighted by the respondent on August 12, 1912 (R. 29).

3. Two years prior thereto, on July 1, 1910, Graff had agreed to sell to the respondent, on a royalty basis, all songs written by him during the next succeeding five years, "with renewals and with right to copyright and renew" (Exh. B, R. 25-28).

4. In 1917, Graff, who was then in financial straits, entered into an agreement with the respondent, whereby he released to the respondent all his right, title, interest and royalties in sixty-nine songs, including "WHEN IRISH EYES ARE SMILING", for the sum of \$1,600.00 (R. 51; Exh. D; R. 29-32)—an average price of approximately \$23 per song.

This agreement purported to sell to the respondent, in addition to the royalties still to accrue on the songs, the renewals of copyright thereon. It provided (R. 31-32):

"And I do, for myself, my heirs, executors, administrators and next of kin, hereby irrevocably authorize and appoint the Publisher, its successor, successors and assigns, my attorneys and representatives, in my name or in the names of my heirs, executors, administrators and next of kin, or in its own names to take and do such actions, deeds and things, and make, sign execute and acknowledge all such documents as may from time to time be necessary to secure to the Publisher, its successor, successors and assigns, the renewals and extensions of the copyrights in said compositions and all rights therein for the terms of such renewals and extensions. And I agree,

for myself and for my heirs, executors, administrators and next of kin, upon the expiration of the first term of any copyright in said compositions, in this or in any other country, to duly make, execute, acknowledge and deliver or to procure the due execution, acknowledgment and delivery to the Publisher, its successor, successors or assigns, of all papers necessary in order to secure to it the renewals and extensions of all copyrights in said compositions and all rights therein for the terms of such renewals and extensions."

5. Under Section 23 of the Copyright Act, the time for filing an application for the renewal copyright to the song "WHEN IRISH EYES ARE SMILING" commenced on August 12, 1939, the beginning of the twenty-eighth year of the first term of copyright.

6. On August 12, 1939, the respondent applied for and registered the renewal copyright in the names of the petitioner Graff and Mrs. Olcott (the widow of Chauncey Olcott who had died prior to August 11, 1939) (R. 5, 18, 33).

7. That same day, the respondent, as Graff's attorney in fact under the 1917 agreement, assigned to itself Graff's interest in the renewal copyright (Exh. F, R. 33-34). (Mrs. Olcott assigned her interest to the respondent on August 28, 1939 (Exh. G; R. 34-35). The validity of her renewal and her assignment is not in dispute.)

8. Petitioner Graff himself applied for the renewal on August 23, 1939, and, after registering it in his own name (R. 19; Exh. H, R. 35-36), assigned his interest to the petitioner Fred Fisher Music Co. Inc. (Exh. I, R. 36).

9. Mrs. Ball, as the widow of Ernest R. Ball, who had died prior to August 11, 1939, applied for and registered the renewal copyright in her name on November 15, 1939

(Exh. J, R. 19, 36, 37), and assigned her interest to the defendant Mills Music, Inc. on July 8, 1940 (Exh. K, R. 37-38). As in the case of Mrs. Oleott, the validity of Mrs. Ball's renewal copyright and her assignment to Mills Music, Inc. is not in question in this proceeding.

10. The respondent, claiming the ownership of the renewal copyright, commenced an action for infringement against the petitioners, Graff and Fred Fisher Music Co. Inc., and Mills Music, Inc.

11. Simultaneously with the commencement of the action, the respondent moved for an injunction pendente lite against the petitioners, Graff and Fred Fisher Music Co. Inc. (R. 1, 2). However, no preliminary injunction was sought against the defendant Mills Music, Inc., it being stated that this defendant did not threaten immediate publication of the song (R. 2).

12. The motion for temporary injunction against petitioners was granted by the United States District Court for the Southern District of New York and the petitioners were, during the pendency of the action, enjoined from printing, publishing, copying or vending the song "WHEN IRISH EYES ARE SMILING" or licensing the use thereof or asserting any claim or interest in the renewal copyright thereof (R. 64-66). District Judge Conger's opinion appears at pages 66-72 of the record and is reported in 38 Fed. Supp. 72.

13. The interlocutory decree was affirmed by the United States Circuit Court for the Second Circuit, Judge Frank dissenting with opinion. Judge Clark's majority opinion appears at pages 75-85 of the record, Judge Frank's at pages 105-115; both opinions are reported in 125 Fed. (2d) 949, 954.

SUMMARY OF ARGUMENT

POINT I

THE LIMITATION IN SECTION 23 OF THE COPYRIGHT LAW OF 1909 RESTRICTING THE RENEWAL PRIVILEGE TO THE AUTHOR AND HIS FAMILY WAS DESIGNED TO PREVENT THE ALIENATION OF THE RENEWAL COPYRIGHT PRIOR TO THE TWENTY-EIGHTH YEAR OF THE ORIGINAL TERM.

A. Copyright is the creature of statute, hence the privileges extended and the persons to whom they are available must be determined by the provisions of the Copyright Law.

B. The renewal privilege is a new grant available only to the persons specifically designated in the statute.

C. Section 23 of the Copyright Law was designed to enable authors and their families to derive an economic benefit in the twenty-eighth year of the original term, unfettered by prior commitments.

POINT II

THE HISTORY OF COPYRIGHT LEGISLATION IN THE UNITED STATES FORTIFIES THE VIEW THAT THE RENEWAL PRIVILEGE MAY NOT BE ALIENATED BY AN ANTICIPATORY ASSIGNMENT OR AGREEMENT TO ASSIGN.

POINT III

THE POLICY OF THE STATUTE TO LIMIT THE RENEWAL PRIVILEGE TO THE AUTHOR AND HIS FAMILY NULLIFIES ANY AGREEMENT BY WHICH A THIRD PERSON SEEKS TO ACQUIRE IN ADVANCE OF THE TWENTY-EIGHTH YEAR THE BENEFITS INTENDED TO BE RESERVED TO THE AUTHOR AND HIS FAMILY ALONE.

A. The limitation by which only the author may apply for the renewal is not a mere technicality or functional impediment which may be overcome by legal devices. It is an obstacle imposed by the statute to safeguard the author against his improvident act.

B. The doctrine that the law favors alienability of property lends no support to the contention that the renewal may be disposed of by an author in advance of the twenty-eighth year. The statute is so framed that at no time before the twenty-eighth year can a complete title be conveyed.

POINT IV

THE CASE IS ONE OF FIRST IMPRESSION.

POINT V

THE INTERLOCUTORY JUDGMENT APPEALED FROM SHOULD BE REVERSED; THE DECREE PENDENTE LITE VACATED AND SET ASIDE; AND THE CASE REMANDED WITH INSTRUCTIONS TO DENY RESPONDENT'S MOTION FOR A TEMPORARY INJUNCTION.

POINT I

The Limitation in Section 23 of the Copyright Law of 1909 restricting the renewal privilege to the author and his family was designed to prevent the alienation of the renewal copyright prior to the twenty-eighth year of the original term.

A. Copyright is the creature of statute, hence the privileges extended and the persons to whom they are available must be determined by the provisions of the Copyright Law.

Although the issue before the Court involves only the construction of Section 23 of the Copyright Law of 1909,

no discussion of the issue would be complete without a consideration of the nature of copyright in general.

Justice Brown, defining copyright in *Holmes v. Hurst*, 174 U. S. 82, 86, quoted the famous statement of Lord Mansfield (*Miller v. Taylor*, 4 Burrows 2023, at 2396) that it is

"an incorporeal right to print a set of intellectual ideas, or modes of thinking, communicated in a set of words or sentences, and modes of expression. It is equally detached from the manuscript or any other physical existence whatsoever."

The language of Judge Gardner in *Buck v. Swenson*, 33 Fed. Supp. 377, is particularly apt. He said (p. 387) that

"it is an intangible incorporeal right in the nature of a privilege or franchise quite independent of any material substance such as the manuscript or the plate used for printing."

See also *Fox Film Corp. v. Doyal*, 286 U. S. 123.

Copyright is the creature of statute and the privileges appertaining to it, their extent and their limitations, must be found in the law itself.*

"Congress", said this Court in *Caliga v. Inter Ocean Newspaper*, 215 U. S. 182, at 188, "did not sanction an existing right; it created a new one."

This doctrine had been settled in *Holmes v. Hurst*, 174 U. S. 82, where, after referring to earlier controversies, the Court said (p. 85):

* Statutory copyright should be distinguished from the common law right which inures to an author prior to the publication of a work. See Copyright Law, Section 2. Section 11 of the Copyright Law permits statutory copyright to be obtained on some works of which copies are not reproduced for sale, but registration under this section likewise displaces the common law right and substitutes statutory copyright in its place. *Universal Film Mfg. Co. v. Copperman*, 218 Fed. 577; *Photo Drama Motion Picture Co. v. Social U. Film Corp.*, 220 Fed. 448, at 450.

"While the propriety of these decisions has been the subject of a good deal of controversy among legal writers, it seems now to be considered the settled law of this country and England that the right of an author to a monopoly of his publications is measured and determined by the copyright act—in other words, that while a right did exist by common law, it has been superseded by statute."

See also:

American Tobacco Company v. Werckmeister,
207 U. S. 284;

Robbs-Merrill Co. v. Straus, 210 U. S. 339;

Burrow-Giles Lithographing Co. v. Sarony, 111
U. S. 53;

*White-Smith Music Publishing Co. v. Apollo
Co.*, 209 U. S. 1;

Wheaton v. Peters, 8 Pet. 591 at 661.

The authority of Congress to enact copyright legislation is derived from Article I, Section 8 of the Constitution, which grants the power

"to promote the progress of science and useful arts by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries."

Acting in pursuance of this power, Congress has from time to time enacted copyright legislation. The first statute was adopted in 1790 (1 St. at L. 124). Changes were made from time to time, and a complete revision of the Copyright Law took place in the year 1909 (17 U. S. C., 35 Statutes 1080).

This Court has ruled that these statutes should be liberally construed to accomplish their objects and purposes. In *American Tobacco Co. v. Werckmeister*, 207 U. S. 284, the Court wrote (p. 291):

"Under this grant of authority a series of statutes have been passed, having for their object the protec-

tion of the property which the author has in the right to publish his production, the purpose of the statute being to protect this right in such manner that the author may have the benefit of this property for a limited term of years. These statutes should be given a fair and reasonable construction with a view to effecting such purpose."

B. The renewal privilege is a new grant available only to the persons specifically designated in the statute.

The Constitution prescribes, and the statutes have provided that the copyright privilege or franchise shall be limited in point of time. Differing from the laws now prevalent in most other countries (Howell, *The Copyright Law*, 1942, page 100), our statute provides for two separate and distinct, successive terms of copyright. The original design adopted in 1790 (1 Stat. at L. 124) and patterned after the English Statute of Anne (8 Anne c. 19), was changed materially in 1831 (4 Stat. at L. 436, Sec. 2), when the assignee was eliminated from among the persons entitled to apply for the renewal (*White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247, 250.) By the revision of 1909, the pattern of an original term of copyright and a renewal was continued.

The renewal term, it has been held, is not merely a continuation or extension of the original term of copyright. It is a new grant, not stemming from the ownership of the original term, and constitutes a personal privilege available only to those persons specifically designated in the statute, in the order of the prescribed precedence. This doctrine has been stated by the Courts in various ways.

In *White-Smith Music Publishing Co. v. Goff*, 187 Fed. 247, the Court said at page 248:

"It is to be noted that in each statute the grant of the original copyright is to the author or proprietor while, as to the provision for an extension the word 'proprietor' is studiously stricken out."

and again at 249:

"While the words 'renewed and extended', in their proper and ordinary construction, relate to a continuing right; yet the fact that, if the author is not living, the 'widow, widower or children' of the author are entitled to the additional term makes the provision of each statute in reference thereto strictly personal, and not really and truly a renewal or extension. Therefore neither statute on its face provides really and truly an extension to the author, his assigns, executors, and administrators, but a new grant to the author or others enumerated as we have said."

The nature of the renewal right is summarized by Justice Hough in *Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909, at 911, cert. denied 262 U. S. 758, in the following language:

"On this authority, as well as the reason of the matter, we regard it as settled: (1) That the proprietor of an existing copyright as such has no right to a renewal. (2) There is nothing in *Paige v. Banks*, 13 Wall. 608, 20 L. Ed. 709, opposed to this ruling. (3) The statute confers no right of renewal upon administrators. (4) The purpose of the statutory renewal provisions is to give to the persons enumerated in the order of their enumeration a new right or estate, not growing legally out of the original copyright property, but a new creation for the benefit (if the author be dead) of those naturally dependent upon or properly expectant of the author's bounty."

Judge Sibley in *Harris v. Coca-Cola Co.*, 73 Fed. (2d) 370, enunciated the principle in the following language, at page 371:

"The great purpose of a copyright is to secure to authors and artists the financial fruits of their own mental labors. The initial copyright period is frequently assigned to a publisher with but little gain to the author. If the work proves meritorious and successful, the author may have had but little benefit. The second period is intended, not as an incident of

the first for the benefit of the then owner of the expiring copyright, but as a second recognition extended by the law to the author of work that has proven permanently meritorious by giving directly to him, if alive, or, if not, to his widow, children, next of kin or executor (but not to an administrator who may represent no relative and no wish of the author), a supplementary copyright upon the terms stated in the statute."

C. Section 23 of the Copyright Law was designed to enable authors and their families to derive an economic benefit in the twenty-eighth year of the original term, unfettered by prior commitments.

Section 23 of the Copyright Law provides for a basic copyright term of twenty-eight years. Its first clause reads:

"The copyright secured by this title shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: * * *"

It then makes provision for renewal copyright for an additional term of twenty-eight years. In four categories of literary work, the proprietor under the statute becomes entitled to the renewal. They are (a) works published posthumously; (b) periodical, cyclopedic or other composite works on which copyright was originally secured by the proprietor; (c) works copyrighted by a corporation otherwise than as assignee or licensee of the individual author; and (d) works made for hire.

In all other cases,* there is the limitation that only the author, if he be living, or his family, if he be dead, is entitled to the renewal. This portion of Section 23 reads:

"And provided further, That in the case of any other copyrighted work, including a contribution by an indi-

* Bowker (Copyright, Its History and Its Law, p. 114) describes the group of works in which the proprietor may renew as "impersonal" works, and the other as "personal" works.

vidual author to a periodical or to a cyclopedic or other composite work when such contribution has been separately registered, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further*, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication."

It will be observed that there is no provision made here which would entitle an assignee of the author, a proprietor or the author's administrators to the renewal. The exclusion of the assignee from the renewal privilege was not due to inadvertence, but constituted an integral part of the pattern by which Congress sought to preserve for the author and his family the economic benefits which might flow from the survival of a work beyond the original copyright term.

This purpose is explained in the report of the House Committee on Patents which recommended the bill (H. R. Rep. 2222, 60th Congress, 2nd Session). When the Copyright Law was in the course of revision in 1909, a proposal had been advanced that renewals be eliminated and that there be substituted a single term to extend for the life of the author and fifty years. In rejecting the change in the statutory design, the Committee said (p. 14):

"Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens

that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right."

The House Report was adopted by the Senate Committee on Patents as its own (Sen. Rep. No. 1108, 60th Cong. 2nd Session).

Based upon the statutory pattern, it is now settled that an assignee of an author may not in his own right apply for the renewal (1910). *28 Opinions of Attorneys General*, 162; *White-Smith Music Publishing Co. v. Goff*, 187 F. (2d) 47. An administrator of a deceased author has no standing to apply for the renewal. *Danks v. Gordon*, 272 F. 821, 825. Applications for renewal by the individuals named in the statute may be made only in the order of their precedence. *Silverman v. Sunrise Pictures*, 273 F. 909, cert. denied 262 U. S. 758. An executor of a deceased author may apply for the renewal even though the death of a testator takes place prior to the commencement of the 28th year of the original term. *For Film Corp. v. Knowles*, 261 U. S. 326; *Yardley v. Houghton Mifflin Co. Inc.*, 108 F. (2d) 28, 32. An application for renewal by a person not entitled to the privilege is a nullity. *Yardley v. Houghton Mifflin Co. Inc.*, 108 F. (2d) 28, 32; *Tobani v. Carl Fischer, Inc.*, 98 F. (2d) 57, 60, cert. denied 305 U. S. 650.

Moreover, it was recognized in the Court below that no act on the part of the author, if he fails to survive, can have the effect of defeating the right to the renewal accorded by the statute to his widow and children. Judge Clark, writing for the majority, said (125 F. (2d) 949, at 950, R. 77):

"It is also apparent that the assignment here would not have cut off the rights of renewal extended to the widow, children, executors, or next of kin, in the event of Graff's death prior to the renewal period. See Fox Film Corp. v. Knowles, 261 U. S. 326."

The point of divergence in the Court below was the extent to which the statute provided a safeguard to the author against his own improvident act.

The majority reached the conclusion that notwithstanding the limitations written into the statute, and despite the language of the Patent Committees' reports, the intent to make the renewal inalienable by anticipatory assignment had not been expressed with sufficient clarity to effect that purpose. Stress was laid upon the absence of language specifically providing that the attempted assignment would be "void and of no effect" (125 F. (2d) 951 R. 77).

The Committee's report and its expression of intent will be referred to later. At this juncture, we submit that undue weight was given to the absence of prohibitory language in the statute. If, as we urge, it was the purpose of Congress to reserve to the author a renewal right which would be inalienable in advance of its accrual, the limitation written into the Act restricting the privilege to the author if living, is sufficient to accomplish that purpose.

The precision with which Section 23 enumerates the persons to whom the new franchise is available, is in itself equivalent to an express prohibition. The requirement that application be made by the author should be contrasted with the earlier portion of Section 23 which entitles a "proprietor" to renew in his own right when the work comes within the excepted categories. When the statute enables a corporate proprietor to renew the

copyright on impersonal works originally copyrighted by it, the terms specifically exclude from that privilege those works which the corporation copyrighted "as assignee or licensee of the individual author".* No distinction is made between an assignor who survives and one who fails to survive the crucial year.

One should also contrast the explicit language of Section 23 with the more general wording of other sections of the Copyright Law.

Section 9 provides:

"That *any person* entitled thereto by this Act may secure copyright for his work by publication thereof with the notice of copyright required by this Act."

Section 10 reads:

"That *such person* may obtain the registration of his claim to copyright by complying with the provisions of this Act, including the deposit of copies,
• • •"

Section 8 provides;

"That the author or proprietor of any work made the subject of copyright by this Act, or his executors, administrators, or assigns, shall have copyright for

* The language of the statute is: "That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright • • •" (Copyright Law, Section 23, 17 U. S. C. A., 35 Stat. 1080.)

such work *under the conditions and for the terms* specified in this Act: " * * * "

It appears to have been a matter of complete indifference to Congress whether copyright for the first term was secured and registered by the author, by the assignee, or by the publisher-proprietor. That might be a matter of private dealings and contractual relation between the parties. In creating the renewal, however, Congress undertook to designate by name the individuals to whom this new franchise was available in the twenty-eighth year, thereby excluding from the benefits of the statute persons who were not intended to have access to the privilege.

On the proposition that the renewal application must be filed by the author, we anticipate no dispute. The reasoning is advanced, however, that although the application must be filed *by or in the name of the author*, it is not necessary that he be the beneficial owner of the privilege at the time. This reasoning is predicated upon a literal reading of the statute, and presupposes that Congress was completely indifferent to the practical consequences of preserving the renewal pattern. The limitation in the statute is thus relegated to an administrative pro-

* This provision manifestly does not authorize an anticipatory assignment of the renewal. It refers to the author *or* the proprietor in the alternative and speaks of the "terms" of the copyright, and the "conditions" prescribed by the Act. Obviously, the reference is to the respective terms and would include the limitations of the renewal section. Additional indications that Section 8 does not vary or enlarge the terms of Section 23, appears on the one hand from the inclusion in Section 8 of the "administrator", who has no interest in the renewal, and on the other the omission of the widow, children and next of kin who are specifically provided for in Section 23.

After an author has perfected his renewal as the beneficial owner of the right in the 28th year, he may then do with it as he pleases. This seems clear from the language of Section 42, which reads:

"Assignments and bequests. Copyright secured under this title or previous copyright laws of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will." (17 U. S. C. A., 35 Stat. 1084.) (Italics ours.)

vision or a mechanical means by which the term of copyright may be extended.

Adherence to this literal interpretation is, we submit, inconsistent with the doctrine that the courts will effectuate the policy of a statute and will refuse to enforce contracts in contravention thereof even though the statute itself contains no express prohibitions.

Restatement of the Law of Contracts, Sections 512, 580, 2(e), Illustration of Clause (e).

In this respect, the present case comes within the rationale of *Awotin v. Atlas Exchange Bank*, 295 U. S. 209, which concerned the validity of an agreement by a national bank to repurchase securities previously sold to a customer. The Act provided

"that the business of buying and selling investment securities was hereafter to be limited to buying and selling without recourse marketable obligations evidencing indebtedness of any person * * * or corporation in the form of bonds, notes, and/or debentures, commonly known as investment securities."

The contract was there held invalid as coming "within the broad sweep of the statute which by mandatory language sets up the definite limits upon the liability which may be incurred by a national bank * * *" (p. 214).

This court in *National Licorice Co. v. Labor Board*, 309 U. S. 350 held that a contract by which employees agreed "not to demand a closed union shop or a signed agreement by his employer with any union" constituted a violation of the National Labor Relations Act. It said that the restriction was in plain conflict with the public policy of the Act to encourage the procedure of collective bargaining. See also *National Labor Relations Board v. D. v. Reed Prince Mfg. Co.*, 118 F. 2d 874; cert. denied 313 U. S. 595.

In *Overnight Motor Transportation Co., Inc. v. Missel*, 316 U. S. 572, decided by this Court June 8th, 1942, Judge Reed said (p. 579):

"Neither the wage, the hour, nor the overtime provisions of Sections 6 and 7 on their passage spoke specifically of any other method of paying wages except by hourly rate. But we have no doubt that pay by the week, to be reduced by some method of computation to hourly rates, was also covered by the Act."

The New York Court of Appeals, in holding unenforceable an agreement by which a debtor had waived and relinquished his statutory right of exemption of property from execution, imposed the prohibition despite the absence of express language in the statute invalidating such agreements. *Kneetle v. Newcomb*, 22 N. Y. 249. It was said (pp. 251-252):

"By the statutes exempting certain property, the legislature in effect determined that it was inexpedient to allow contracts entailing such results; and this was done by providing that certain property, of limited value, should not be taken. Parties cannot now stipulate that their contracts shall have the same effect as under the former law, for that would be hostile to the policy thus established."

In *Andrews v. Security National Bank* (1932), 121 Tex. 409, the Court said (pp. 417-418):

"In view of their objects and purposes, and the rule of construction stated, it is obvious we should so interpret and apply our homestead laws so that their original intendments to benefit both the citizen and the State may be effectuated. It is equally clear that in doing so we ought not to permit evasive contracts to thwart the purposes of the organic law, even though the creators of the contract may have conceived that they had found a twilight zone between the abandonment of one homestead and the acquirement of another, in which they might create a lien on the homestead other than for purchase money or im-

provements, and thus effectually do the very thing which the Constitution, and statutes which follow it, intended to prohibit."

See also:

Bunker v. Coons (Utah), 60 Pac. 549;

Meyer Bros. Drug Co. v. Bybee (Mo.), 78 S. W. 579;

Green v. Watson, 75 Ga. 471;

Mills v. Bennett (Tenn.), 30 S. W. 748.

The rule was succinctly stated by this Court in a case involving the construction of the Copyright Law itself. In *American Tobacco Co. v. Werckmeister*, 207 U. S. 284, Justice Day wrote (p. 293):

"But in construing a statute we are not always confined to a literal reading, and may consider its object and purpose, the things with which it is dealing, and the condition of affairs which led to its enactment so as to effectuate rather than destroy the spirit and force of the law which the legislature intended to enact.

"It is true, and the plaintiff in error cites authorities to the proposition, that where the words of an act are clear and unambiguous they will control. But while seeking to gain the legislative intent primarily from the language used we must remember the objects and purposes sought to be attained."

The problem, therefore, resolves itself into one of determining the policy of the statute. We believe that the solution of that question lies in the answer to the following questions: When Congress rejected the proposal that there be but one term of copyright, and retained the renewal design, hedging it about with a limitation that the privilege could be exercised by the author alone, did it intend that he should have the substance of the renewal privilege when he filed his application? Is the legislative purpose satisfied if the author is merely a straw man

filing the application in the interest of a publisher, who is excluded by the statute from the privilege of applying in his own right?

The Patent Committee's explanation of its reasons for rejecting a single term assignable in its entirety to a publisher, would seem to be conclusive as to the result sought to be accomplished. Regarding the Congressional Report, however, the majority said:

"We are perfectly willing to uphold a Congressional declaration that public policy forbids assignment of a copyright renewal; but we expect something more than ambiguous inferences drawn from a committee report explicitly arguing only for continuance of an existing statutory scheme with a new renewal period" (125 Fed. (2d) 949, 954, R. 84).

Judge Frank, dissenting, reasoned:

"The Committees almost literally described the facts of the instant case: Graff sold outright his original term for a small sum. His turned out to be one of the comparatively few cases where the work survives the original term.' It was to meet just such a contingency, the Committees said, that Congress gave 'the author the exclusive right' to 'an adequate renewal term' so that he could, in such a case, 'reap the reward' in 'his old age.' We should see to it, that, as Congress intended, the 'right of the author to take the renewal term' is so hedged about that he can *not be deprived of that right* by having it *taken away from him in his old age when he needs it the most.*"

"I find it difficult to regard those expressions of the Committees as mere idle talk, or as so ambiguous that we can laugh them off . . ." (125 Fed. (2d) 949, 958, R. 93). (Italics quoted from the record.)

With all deference to the majority in the Court below, we urge that the Committee's report has been read much too narrowly.

The Committee

"decided that it was distinctly to the advantage of the author to preserve the renewal period."

Had its report ended here, one might well agree with the Court below that the purpose of retaining the statutory scheme was to provide a convenient device by which an author might sell all of his statutory privileges or by which he might part only with the first portion and retain the balance if he chose.

However, the Committee crystalized its purpose by giving an example of the kind of transaction it desired to forestall. It said:

"It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum."

Manifestly, the sole objection to an outright sale is that the author would derive no financial reward if his work proved sufficiently successful to live beyond a twenty-eight-year period. All of the gains from the second term of twenty-eight years would inure to the publisher. This objectionable result would not be remedied by creating a renewal term alienable prior to the end of the first term. Consequently, the Committee argued:

"If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the *exclusive* right of the author to take the renewal term . . ." (Italics ours.)

It is of no small moment in this case that the Committee referred specifically to the author, and not to a deceased author who might leave surviving a widow or children. It rebuts the suggestion that the renewal was retained to safeguard only the widow and children against an improvident disposition.

Finally, the Committee said that

"the law should be framed as is the existing law, so that he could not be deprived of that right.

Judge Clark thought this statement was ambiguous. He said (R. 79-80):

"Does this mean he could not be deprived of it if he 'sells his copyright outright to a publisher'? If so, we agree. Or did they mean that a court was to strike down the author's attempt specifically to dispose of his expectancy? If so, 'deprive' was a poor word to use, for the result is that he is 'deprived' of his privilege to alienate his renewal right, not saved from 'deprivation' of the right itself."*

The fallacy in this reasoning is that the Committee's sole concern lay in the possibility that the author might be deprived of the financial benefits resulting from the renewal. It was not concerned by the fact that he would be "deprived" of the right to alienate it in advance. Its reason for limiting the validity of the privilege and making it personal was to prevent the renewal from passing out of the author's control. Bowker says (*Copyright, Its History and Its Law*, p. 117):

"In the copyright conferences, it was pointed out by publishers that the right of the author to renewal, and the *implied denial* of that right to an assignee proprietor, placed at serious disadvantage a publisher who had made investment in plates of an author's works, and would be deprived of the use of his investment at the end of the original term in case the author prefer-

* This expression of the Court may well be compared with an argument made by Drone in 1878. Drone urged that the author could dispose not only of his own renewal privilege, but also the privilege which would extend to his widow and children if he failed to survive. He said (Drone on Copyright, p. 327):

"The provision under consideration was, doubtless, intended to secure to the author and his family a privilege which is not given directly to an assignee; but it is not reasonable to suppose that the object of the statute was to reserve to the author or his family any rights with which he has voluntarily parted, and for which he has received and enjoyed the consideration." (Italics ours.)

Drone's view has not been accepted by Congress or by the courts.

red to make arrangements with another publisher for the renewal term. The Congressional Committee failed, however, to provide a remedy for this through the proposed Monroe-Smith amendment, requiring that in such case author and publisher should unite in the application for renewal."

When the Committee wrote that "it should be the *exclusive* right of the author to take the renewal term", it obviously had in mind something more than the mere power of an author to withhold from a purchaser some interest in the copyright. Had the renewal been treated merely as an expectancy, subject to conveyance or retention as the author chose, there would be no purpose in the reference to the "exclusive right" of the author to take the renewal term, or the possibility that he might be deprived of it. Concession must be made to the Congressional knowledge that an assignee could acquire the renewal only if the author chose to convey it and would have no interest in the renewal if the author elected to retain it. The use of the expression "deprive" can refer logically only to a relinquishment by the author's act, occasioned by his own improvidence.

The Committee was not dealing in a vacuum. It was interested in the practical consequences of retaining the pattern of a renewal copyright. It sought to forestall disposition by the author of his entire interest in the copyrighted work until time had established its worth. It is difficult to see how this purpose is achieved by construing the statute to permit the author to include in the sale, for the same pittance, the renewal as well as the original term. The renewal privilege was accordingly limited so that the author, despite himself, might have the "exclusive right" and therefore a new opportunity to bargain for the exploitation of his work at the end of twenty-eight years and to derive whatever financial benefit might accrue from the fact that his property was sufficiently meritorious to have a monetary value after that length of time.

The suggestion that authors and their widows ought not to be deprived of the opportunity to realize money by anticipating upon the renewal, and that forced savings should not be imposed upon them (R. 83), not only disregards the language of Congress, but contemplates a highly illusory benefit. Congress certainly did not intend to increase the hazards of improvident sales by authors and their families. Yet, that is the very consequence which results from the interpretation given to the statute. Were the renewal wholly alienable, an author or his widow might sell it for an amount commensurate with its value as literary property. Under the statute, there is no way in which an author or his family can convey a full, complete and marketable title prior to the twenty-eighth year. All that he can sell is the expectancy based upon his survival. No purchaser could logically be expected to pay full value for property which he may never receive. The purchase price must be diluted by the contingency that the seller might not survive to file the application and deliver the renewal. If the author's wife be joined in the conveyance, the title is still not complete. She may fail to survive and the right will pass to the children free of the claims of the purchaser. Efforts to join the children in the sale present troublesome questions of infancy and of the possibility of the birth of additional children. Consequently, the shield erected to protect the necessitous author becomes a weapon to diminish or completely destroy his bargaining power. This result is hardly a sensible one, and to borrow the language of Justice Stone in *U. S. v. Katz*, 271 U. S. 354, at 357:

"All laws are to be given a sensible construction; and a literal application of a statute, which would lead to absurd consequences, should be avoided whenever a reasonable application can be given to it, consistent with the legislative purpose."

The Court below expressed the opinion, however, that "some weight may be attached to the fact that an ambigu-

ous statutory provision has fairly uniformly been interpreted one way, and presumably acted upon" (R. 81). The interpretations referred to are statements of text writers who for the most part expressed doubts on this "vexed question of rights for the renewal term" (See Bowker, Copyright, Its History and Its Law, 1912, p. 118). After 1909, many of them admittedly tended to "hedge".

Any purchasers of renewals knew that they were buying nothing but a speculative interest. They knew at least that if the author failed to survive, their purchases would be worthless. One need not look beyond the present case. Chauncey Olcott, one of the co-authors with Graff, died before the renewal date (R. 18). He had made an agreement conveying his interest in the renewal to the respondent (R. 4; Exh. 1 annexed to affidavit of Herman Starr, R. 8-9). Nevertheless, the respondent, in order to acquire that interest, was obliged to purchase Mrs. Olcott's share in the renewal (R. 5; Exh. G, R. 34-35).

To say that the respondent in the instant case actually purchased the renewal from Graff as part of an independent transaction, loses sight of reality. When in 1917, respondent paid an amount at the rate of \$23 per song, it was buying a release of the royalties which might still accrue under the agreement with Graff made in 1910.* The

* The practice of adding renewals for good measure in contracts conveying the original term or releasing royalties does not seem to be unusual. In *Schirmer, Inc. v. Robbins Music Corp.*, 176 Misc. (N. Y.) 578, the plaintiff claimed the renewal under a contract made in 1912 by which the author originally transferred the musical compositions to the publisher. In *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 42 Fed. Supp. 859, the defendant Harris claimed priority to Joseph E. Howard's interest in the renewal to "I Wonder Who's Kissing Her Now" under an agreement by which for a consideration of \$150.00 Howard had released his royalties and had assigned all his right, title and interest by way of copyright or otherwise (42 Fed. Supp. 862, col. 2, also 865, col. 2). The same case concerned a second song—"The Bird on Nellie's Hat." It appears that this song was sold to plaintiff's predecessor on or about June 26, 1906. One of the authors, Lamb, had released his royalties and conveyed his renewals in January 1907 (p. 866, col. 2). Solman, the co-author, in December 1913, had assigned to the plaintiff's predecessor "all royalties accruing" on a long list of songs "and all renewals and extensions thereof" (p. 866, col. 2). (These cases were decided after the present decision.)

assignment of the renewal was merely an appendage to the agreement, since if renewals could be purchased in advance of their perfection, respondent might have claimed them under the terms of the earlier agreement, to which they were likewise an appendage. We do not argue that the price was inadequate. What we say is that there is no criterion by which adequacy of price can be judged at a time when the sufficiency of the conveyance is dependent upon the seller's survival.

An example of the insecurity of a purchaser's claim to the renewal appears in *Selwyn & Co. Inc. v. Veiller*, 43 F. Supp. 491. Bayard Veiller had in 1914 sold to Selwyn & Co. Inc., play brokers, the play entitled "WITHIN THE LAW" and had conveyed the copyright and any renewals or extensions, giving to the purchaser authority to apply for and receive these renewals. Selwyn & Co., in turn, assigned the motion picture rights in the play to a motion picture company (in 1917 for the original term, and in 1922 for the renewal period). By mesne conveyances, these rights found their way into the hands of Loew's, Inc.

The renewal copyright was effected by Veiller on January 27, 1939. Two days before that, he had entered into an agreement with Loew's under which he received \$5,000 in return for an assignment by himself, his wife and his only son.

In the interim, Selwyn & Co. had been dissolved for failure to pay New York State corporate taxes. Its existence was revived and suit was instituted by Selwyn against Veiller to recover the money paid and to compel an assignment of the renewed copyright. The District Court held that although Veiller was not obligated to pay over the \$5,000, he was required on the authority of the instant case to assign his renewal copyright.

Apparently, as Judge Rifkind pointed out (43 F. Supp. 491, at 493); there was enough doubt concerning the

validity of anticipatory assignment to induce the motion picture company to pay a substantial amount of money on the eve of the renewal application in order to purchase the author's rights. Whether the motion picture company would have paid the same amount of money on the hazard that Veiller might die in the two days which elapsed between the agreement and the filing of the renewal application is highly conjectural.

Nor should it be assumed that the purchaser of the renewal rights will be much better off as a result of the decision in the present case. He will still be subject to the hazard that the author may not survive the crucial year and that a purchase must be made from the widow and children.

Construed, as it has been in the Court below, the limitations in the statute are at most administrative formalities providing no safeguard to the author, or security to the publisher, which may be circumvented by the insertion of a few words in a contract.

If, on the other hand, the statute be construed to prohibit anticipatory assignments, the limitations which it provides and the announced purpose of Congress become consistent. In the twenty-eighth year, the author, if he be alive, or his widow or children, if he be dead, can convey a full marketable title to the property. The purchaser will be assured of the benefits of his bargain, and the price to the seller will not be diluted by the hazards of non-survival.

True, by this construction, the author is deprived of a right to sell his renewal before the twenty-eighth year arrives. By the same token, individuals are deprived of the right to pay usurious rates of interest, or to waive homestead and other statutory exemptions, in order to borrow money. A beneficiary of a trust is often deprived of his

right to assign his income in advance (*Stringer v. Young*, 191 N. Y. 157). Employees are deprived of their right to work for less than minimum wages or to work overtime without extra compensation. These examples might be multiplied infinitely and the considerations in all the instances are of like character. The law often limits the individual's freedom of action in the interests of a broader public policy to be served. If, as must be conceded in the instant case, Congress has the power to impose the limitation, the wisdom or folly of the restriction is a matter only of legislative concern.

To quote Justice Holmes in *Dillingham v. McLaughlin*, 264 U. S. 370, at 374:

"* * * Whatever may be one's own opinion about the wisdom of trying to save the ignorant and rash from folly, it is a recognized power that is used in many ways."

POINT II

The history of copyright legislation in the United States fortifies the view that the renewal privilege may not be alienated by an anticipatory assignment or agreement to assign.

In the first point of this brief our argument was addressed to the limitation contained in Section 25 of the Copyright Law of 1909 and its construction based on its structure and likewise against the background of the Patents Committee Report. The Committee in its report refers to the proposed Bill as re-enacting the existing law, which did not, we submit, by the statutory provisions after 1831, permit anticipatory alienation of the renewal copyright.

An examination of the history of copyright legislation in the United States reveals that under the first federal

copyright statute enacted in 1790, an assignee, by express provision, not only could acquire the author's interest in the renewal, but was entitled to perfect that renewal in his own right. The statute (1 Stat. at L. 124) provided that:

"* * * if, at the expiration of the said term, the author or authors, * * *, be living * * * the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years: Provided, *he or they* shall cause the title thereof to be a second time recorded and published * * * within six months before the expiration of the first term of fourteen years aforesaid." (Italics ours.)

When, however, the Act was amended in 1831, reference to the assignee was eliminated and the right limited to the author and his family (4 Stat. at L. 436, Sec. 2):

"That if, at the expiration of the aforesaid term of years, such author, * * * be still living, and a citizen * * * of the United States, or resident therein, or being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to *such author*; * * * or, if dead, *then to such widow and child, or children*, for the further term of fourteen years." (Italics ours.)

Concerning this change in the wording of the statute, Judge Putnam, writing for the Court in *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247, said (p. 250):

"Here, then, was an entirely new policy, completely dis severing the title, breaking up the continuance in a proper sense of the word, whatever terms might be used, and vesting an absolutely new title *eo nomine* in the persons designated."

The copyright statutes of 1870 (16 Stat. at L. 212, 213) and 1891 (26 Stat. at L. 1107) continued the policy of the

Act of 1831 in its departure from the law of 1790. Section 88 of the Act of 1870 makes it clear that the application for renewal must be filed in the name of the author, his widow or his children, and that the obligation rests upon them to publish notices thereof. It provides:

“ * * * that the author * * * if he be still living * * * or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work * * *. And *such person* shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers * * *.” (Italics ours.)

The amendment of 1891 (26 Stat. at L. 1107) contains the same provision, but eliminates a requirement that the author be a citizen or resident of the United States.

Had there been any doubt concerning the purpose of the prior statutes, this must be considered dissipated by the action of Congress in 1909.

The 1909 revision of the Copyright Law was the result of labors which had commenced some three or four years prior to that time. The need for a complete revision was stated in President Roosevelt's message to Congress in December, 1905. The Copyright Office had, following extended conferences with groups interested in Copyright, prepared a Bill for submission to Congress (Report of House Committee on Patents No. 2222, 60th Cong., 2d Session, pp. 1-4). This Bill (H. R. 19853 and Senate Bill 6330, 59th Cong., 1st Sess.) had proposed a single term

of copyright to extend during the lifetime of the author and for a period of fifty years thereafter.*

Public hearings were held jointly by the House and Senate Committees on Patents, and ultimately, in 1907, proposed Copyright laws were reported to the respective Branches of the 59th Congress (House Report 7083 on H. R. 25133, January 30, 1907, 59th Cong., 2d Sess., Senate Report 6187 and S-8190, February 5, 1907, 59th Cong., 2d Sess.). No action was taken on these Bills (Report of House Committee on Patents No. 2222, 60th Cong., 2d Sess., p. 4).

These Reports and the legislation proposed are, however, important as a step in the development of the Statute now before the Court.

*The Bill proposed by the Copyright Office eliminated the principle of renewals and provided for single terms of copyright. Section 18 of Senate Bill 6330 and H. R. 19853 read as follows (59th Cong., 1st Sess., May 31, 1906):

"Sec. 18. That the copyright secured by this Act shall endure—(a) For twenty-eight years after the date of first publication in the case of any print or label relating to articles of manufacture; *Provided*, That the copyright which at the time of the passing of this Act may be subsisting in any article named in this section shall endure for the balance of the term of copyright fixed by the laws then in force.

(b) For fifty years after the date of first publication in the case of any composite or collective work; any work copyrighted by a corporate body or by the employer of the author or authors; any abridgment, compilation, dramatization, or translation; any posthumous work; any arrangement or reproduction in some new form of a musical composition; any photograph; any reproduction of a work of art; any print or pictorial illustration; the copyrightable contents of any newspaper or other periodical; and the additions or annotations to works previously published.

(c) *For the lifetime of the author and for fifty years after his death, in the case of his original book, lecture, dramatic or musical composition, map, work of art, drawing or plastic work of a scientific or technical character, or other original work, but not including any work specified in subsections (a) or (b) hereof; and in the case of joint authors, during their joint lives and for fifty years after the death of the last survivor of them.*

In all of the above cases the term shall extend to the end of the calendar year of expiration.

The copyright in a work published anonymously or under an assumed name shall subsist for the same period as if the work had been produced bearing the author's true name." (Italics ours.)

The proposal in 1907 was that there be a single term of copyright to continue during the lifetime of the author and for a period of thirty years after his death. It was coupled with a proviso that the term would end twenty-eight years from first publication of the work unless the copyright *proprietor* in the twenty-eighth year recorded a notice that he desired the protection for the full term (Senate Report 6187, 59th Cong., 2d Sess., February 5, 1907, p. 7, H. R. Rep. 7083, 59th Cong., 2d Sess., pp. 13-14).*

Relative to the single term of copyright and the abandonment of the renewal design, the House Committee said (H. R. 7083, 59th Cong., 2d Sess., p. 13):

"Your committee believe that it is better to have a single term without any right of renewal * * *"

The Senate Committee, after referring to the proviso which required the *proprietor* to record the notice necessary to keep the copyright alive, said (Senate Report 6187, 59th Cong., 2d Sess., p. 7):

"This amounts to an initial term of twenty-eight years (identical with the present initial term), with the privilege of a renewal."

* Section 17 of S-8190 (59th Cong., 2d Sess.), which is annexed to Senate Report 6187, page 18, reads in part as follows:

"That the copyright secured by this act shall endure:

(Subdivisions (a) and (b) refer to photographs and posthumous works, the terms of which are twenty-eight and thirty years, respectively.)

(c) In the case of any work not specified in subsections (a) and (b) of this section, for the remainder of the lifetime of the author after such first publication under this Act and for thirty years after his death: *Provided*, That within the year next preceding the expiration of twenty-eight years from the first publication of such work the copyright proprietor shall record in the Copyright Office a notice that he desires the full term provided herein; and in default of such notice the copyright protection in such work shall determine at the expiration of twenty-eight years from first publication. But in the case of renewals and extensions of existing copyrights sought under the provisions of section eighteen of this act such notice may be given within the year next preceding the expiration of the existing term."

The corresponding provision in H. R. 25133 (59th Cong. 2d Sess.) is Section 18 thereof.

It made an interesting observation concerning the duration of the term, saying (p. 8):

"That the duration of the term is a question not so much between the author and the reading public (who get his book at the outset and do not get it any more completely after than during the term) as between the author with his one publisher who pays him something for his work and the other publishers who may wish to publish it without paying him anything."

It needs no argument to demonstrate that if this provision had become law, there could be no controversy over the "renewal". In the first place, there would have been only a single term which could have been assigned in its entirety by an author. Secondly, even were the continuation beyond the twenty-eighth year to have some of the elements of renewal, as we now know it, the statute made the privilege available only to the proprietor and provided the machinery by which he might perfect his right. The length of the term so provided for was said to be for the protection of the author in his old age, but whether he or his assignee benefited from the continued success of the work would depend solely on the author's bargaining power when he first brought the work to the publisher for publication.

In February, 1909, the Bill, which ripened into the Copyright Law of 1909, was reported to the 60th Congress, 2d Session. No longer did the Committees believe that it was better to have a single term and to abandon the renewal pattern. Indeed, there was a complete reversal of position on that subject. As shown earlier in this brief, the Committees in 1909

"decided that it was distinctly to the advantage of the author to preserve the renewal period."

Consequently, we have a statute which gives to the proprietor, to the exclusion of the author and his family,

the renewal privilege only in certain categories of works. In these categories, machinery is provided by which the proprietor may perfect these renewals in his own right. Concerning all other works—personal works of the author—the new franchise is available only to the author or his family.*

It is difficult to explain the 1831 change in the pattern of the Copyright Law and the elimination of the assignee from the category of persons entitled to take the renewal unless it be integrated with a public policy to prevent an anticipatory alienation by the author. Unless that policy be recognized, it is equally difficult to explain the rejection of the single term design and the continuance of the renewal pattern in 1909. The suggestion that this change may have come about only to prevent the author from disposing of the right extended to his widow and his children, if he himself failed to survive, does not account for various factors of the statute. There is, for instance, no machinery provided by which an assignee of an author may perfect his right to the renewal by filing an application in his own name, if the author be living. Under the Statute of 1790, an assignment of the renewal was permitted and the assignee was given the privilege of recording it in his own name. After 1831, however, the assignee was denied that privilege, and the statute accord-

* Judge Clark laid stress upon Bills introduced into Congress after 1909 but which never became law (R. 82). To him, it appeared that these Bills supported a belief that the renewals were subject to anticipatory assignment. It is difficult to follow the argument that an unsuccessful attempt to change the law provides any evidence of an earlier intent. Another difficulty of arguing on the basis of proposed statutes is indicated by the reference to the so-called Vestal Bill (H. R. 12549, 71st Cong., 2d Session, House Report 1689). This Bill would have created a term continuing during the life of the author and for fifty years thereafter, with a provision that during the last twenty-two years of the term there was to be a reversion to the author's family (H. R. Rep. 4689, p. 10). The Report of the Committee shows (p. 3) that the entire structure of the Copyright Law was to be changed. Provision was made for "automatic" copyright, with the result that protection would be had from the moment when a work was created and before there was any publication. The copyright was to be divisible so that an assignment could be made of specific rights without conveying the entire copyright (see H. R. Rep. 4689, p. 5). These elements would have so changed the picture that there is no proper basis for comparison.

ingly provided no machinery by which an application for renewal may be filed by him. In 1909, Congress segregated the category of impersonal works and provided the machinery by which the proprietor, to the exclusion of the author or his family, might file the renewal application. In respect of personal works, the proprietor in turn was excluded. It seems strange that Congress should have varied this machinery unless it intended to preserve to the author the "exclusive right" to both the legal and the beneficial ownership of the renewal until it had been perfected.

In conclusion on this point; we respectfully urge that the majority in the Court below misconceived the purpose which led to the change in the renewal structure in 1831 and which has continued to the present day. The careful distinction made by Congress between those categories of works in which the proprietor is entitled to the renewal, and those in which the author has the exclusive right, the limitations upon the right to apply for the renewal, the explanation of its purpose by the Congressional Committee, all present a uniform design. They point to the intention to create the renewal as a privilege personal to the author, to which he has the "exclusive right" in the twenty-eighth year, and one which by the policy enacted in the statute, he may not dissipate. The renewal is inalienable not because it is an expectancy, but because Congress chose to treat the author as though he were the beneficiary of a spendthrift trust.

POINT III

The policy of the statute to limit the renewal privilege to the author and his family nullifies any agreement by which a third person seeks to acquire in advance of the twenty-eighth year the benefits intended to be reserved to the author and his family alone.

The opinion below states (R₂ 83):

... * * It should require more than an ambiguous committee report on an ambiguous statutory provision to produce such a drastic restriction on free assignability:

This conclusion is reinforced by the history of judicial disapproval of restraints on assignability. Thus lawyers discovered a way around the archaic rule against assignment of cases in action, courts of equity supported them directly, and courts of law winked at the result. * * *

We respectfully submit that considerations of alienability of property and the rules which lead to the recognition of assignments of expectancies or choses in action, are not properly applicable to the case at bar.

A. The limitation by which only the author may apply for the renewal is not a mere technicality or functional impediment which may be overcome by legal devices. It is an obstacle imposed by the statute to safeguard the author against his improvident act.

If it be concluded that no policy was established by the statute to prevent alienation of the renewal by the author prior to the effective year, the same ultimate result follows whether the conveyance is construed as an assignment or an agreement to assign, or is or is not implemented by a power of attorney.

In *Rossiter v. Vogel*, 46 Fed. Supp. 749, 750, Judge Coxe, on the authority of the present case, sustained an anticipatory assignment in the absence of the "traditional power of attorney to enforce its terms."

In *Edward B. Marks Music Corp. v. Jerry Vogel*, 42 Fed. Supp. 859, Judge Leibell stated concerning an agreement which did not specifically mention the renewal copyright (p. 865):

"The defendant Harris argues that Howard's assignment of December 2nd, 1916 to Charles K. Harris included any rights of Howard to a renewal copyright, although not specifically mentioned. By the instrument Howard purported to 'grant and convey' to Harris all Howard's right, title and interest 'by way of copyright or otherwise' in and to all of Howard's musical compositions published by Harris. The language of grant of what Howard 'sold' to Harris is very comprehensive. It may be that Howard thereby parted absolutely with his entire interest in the work. *Tobani v. Carl Fischer, Inc.*, 2 Cir., 98 F. 2d 57, 60. . . ."

Consequently, we must revert to the primary question, which is the policy announced by the statute, and not the form which a particular transaction may take. If this Court should agree with us that Congress intended that the true applicant for the renewal be the author and not a publisher masquerading in the person of the author, then no device, however ingenious, may defeat that purpose.

Justice Holmes, writing for this Court in *Bullen v. Wisconsin*, 240 U. S. 625, said at p. 630:

"We do not speak of evasion, because, when the law draws a line, a case is on one side of it or the other, and if on the safe side is none the worse legally that a party has availed himself to the full of what the law permits. When an act is condemned as an evasion what is meant is that it is on the wrong side of the line indicated by the policy if not by the mere letter of the law."

The form which a transaction takes cannot override its true meaning.

Superior Oil Co. v. Mississippi, 280 U. S. 390;

United States v. San Francisco, 310 U. S. 16.

It is our contention that any attempt, whether it be by way of assignment, agreement to assign, or "conveyance of the work", and whether it be coupled with a power of attorney, is equally on the wrong side of the line drawn by the Legislature in the instant statute. The necessity for resorting to indirection because the statute prevents an assignee from perfecting the renewal in his own right, is an indication of the Congressional intent that he should not have it.

Any other rule increases the confusion in respect of renewals. If, for example, the agreement made by Graff is valid, then that provision by which he undertook (R. 31-32) on behalf of his executors and administrators to "procure the due execution . . . and delivery to the publisher . . . of all papers necessary to secure to it the renewal . . ." would likewise be valid. In default of the delivery of the assignment by the widow or children, Graff's estate could be required to respond in damages. By this circuitous method, therefore, Graff's widow and children would suffer through the diminution of his estate, even if he had died prior to the accrual of the renewal term, because of their refusal to part with they retain what the statute gave them as a new grant.

We have no doubt that this provision would be stricken down, not because it lacks the elements of an agreement, but because of the statutory policy which forbids it in this case. Agreements may sometimes be freely made, expectancies as such may now be assigned; but not when the law forbids the result sought to be accomplished.

Avotin v. Atlas Exchange Bank, 295 U. S. 209;

295 U. S. 209;

Kneetle v. Newcomb, 22 N. Y. 249;

National Licorice Co. v. Labor Board, 309 U. S. 350;

Overnight Motor Transportation Co., Inc. v. Missel, 316 U. S. 572.

Judge Cardozo, in *Holyoke Power Co. v. Paper Co.*, 300 U. S. 324 wrote, 341:

"In the last analysis, the case for the petitioner amounts to little more than this, that the effect of the Resolution in its application to these leases is to make the value of the dollars fluctuate with variations in the weight and fineness of the monetary standard; and thus defeat the expectation of the parties that the standard would be constant and the value relatively stable. Such, indeed, is the effect, and the covenant of the parties is to that extent abortive. But the disappointment of expectations and even the frustration of contracts may be a lawful exercise of power when expectation and contract are in conflict with the public welfare. 'Contracts may create rights of property, but when contracts deal with a subject matter which lies within the control of the Congress, they have a congenital infirmity.' *Norman v. Baltimore & Ohio R. Co.*, *Sapra*, pages 307, 308. To that congenital infirmity this covenant succumbs."

Courts have in many instances given recognition to restraints and limitations imposed by law and which could not be disregarded directly or by indirection.

Recently, it was held by the New York Court of Appeals that a contract between an employer and its salesmen which attempted to fix their status as independent contractors, could not prevail against their true status as employees under the Unemployment Insurance Law of the State.

Electrolux Company v. Miller, 288 N. Y. 440.

A purchaser of securities was held entitled to recover the price paid because the seller's salesman was not

licensed under the state law. *Dougherty v. Bartlett*, 81 F. 2d 920.

In *Copeland v. Melrose National Bank*, 229 A. D. 311, aff'd 254 N. Y. 632, a national bank employed the plaintiff as a vice-president for a period of 3 years. Since under the Federal statute an officer is subject to dismissal at pleasure, the contract read that if it were terminated prior to the date of expiration, the plaintiff would receive as liquidated damage a sum equal to the total compensation for the unexpired period. This was stricken down, the Court saying (p. 313):

"To uphold the liquidated damage provision of the contract would be to countenance a patent subterfuge designed to circumvent the law. It is idle to say that the statute merely gives the power to discharge the official, without the right to do so."

An agreement to waive the statutory homestead exemption has likewise been held invalid as against public policy.

Bunker v. Coons (Utah), 60 Pac. 549.

See also:

Meyer Bros. Drug Co. v. Bybee (Mo.), 78 S. W. 579.

In *Traders' Inv. Co. v. Macon Ry. & Light Co.* (Ga.), 59 S. E. 454, the Court refused to enforce a provision in a contract by which a laborer had waived the statutory exemption of his wages from garnishment.

See also:

Green v. Watson, 75 Ga. 473;

Mills v. Bennett (Tenn.), 30 S. W. 748.

An agreement by a debtor, in advance of the filing of a bankruptcy petition, to waive the defense of the Bankruptcy Act has been held unenforceable.

Federal National Bank v. Koppel, 253 Mass. 157.

The interest of a beneficiary in the income of a trust may not be assigned.

Stringer v. Young, 191 N. Y. 157.

A receiver may not assign his fees until after they are earned.

Fischer v. Liberty Bank, 53 Fed. (2d) 856.

An executor may not dispose of his fees in advance of their accrual.

In re Worthington, 141 N. Y. 9.

Public officers may not assign their salaries.

Bliss v. Lawrence, 58 N. Y. 442;

Bowery National Bank v. Wilson, 122 N. Y. 478;

Diehl, C. E., Inc. v. Sheehan, 233 App. Div. 258, affirmed 258 N. Y. 624.

A right of entry for breach of a condition subsequent is not assignable.

People v. Wainwright, 237 N. Y. 407.

One may not assign the right to file a mechanic's lien.

Tisdale Lumber Co. v. Read Realty Co., 154 A. D. 270, where the court said:

"The right to file a mechanic's lien is a personal right limited to the person performing the labor or furnishing the material and is not assignable."

In *Rochester Ry. Co. v. Rochester*, 205 U. S. 236, the Court held that a railroad could not transfer its right to enjoy immunity from assessment on a franchise.

In *Romaine v. Chauncey, et al.*, 129 N. Y. 566, the Court of Appeals of New York held that the right to receive alimony could not be alienated.

The doctrine which we urge is neither novel nor unusual. Some instances cited are based on protection to the public rather than to the individual or the class covered by the rule. In others, it is the benefit to the individual as a member of the class which provides the foundation for the rule of policy. The principle, we submit, is the same. Within the realm of its legislative power, Congress may impose restrictions upon the right of individuals to contract, and in some cases even to the extent that their freedom to be improvident is curtailed.

B. The doctrine that the law favors alienability of property lends no support to the contention that the renewal may be disposed of by an author in advance of the twenty-eighth year. The statute is so framed that at no time before the twenty-eighth year can a complete title be conveyed.

We have referred above to the statutory limitations which make it impossible for an author to sell or an assignee to acquire a complete title to the renewal in advance of the specified year. The holding that an author may bar himself from the financial benefits of the privilege does not make the renewal itself alienable. All that the author can sell is the possibility that he will survive.

These are drastic restrictions admittedly imposed by the statute and which are not made substantially more onerous by permitting one interest out of many to be forestalled.

We respectfully urge that the test of the alienability favored by the law is that which permits a complete title to be transferred by persons in being who, joining together, may make an absolute conveyance.

See: *Goesele et al. v. Bimeler*, 55 U. S. (14 How.) 589, 608;

Ladd, as Trustee, etc. v. Mills, 20 Fed. 792, 794;
Hammerstein v. Equitable Trust Co., 156 App.
 Div. 644, aff'd 209 N. Y. 429.

If the factor of alienability be a consideration in determining the intent of the statute, we submit that the logic is against the decision in the Court below. Congress, by failing to make the property completely alienable, has indicated a purpose to prevent an author from disposing of it.

POINT IV

The case is one of first impression.

The present case is the first under the Copyright Law of 1909 to pass directly upon the validity of an agreement by a surviving author to assign his renewal in advance of its accrual. The question remained unadjudicated under the various statutes enacted in and after the year 1831. Three early cases, *Paige v. Banks*, 80 U. S. (13 Wall.) 608, *Cowen v. Banks*, 24 How. Pr. 73 and *Pierpont v. Fowle*, 2 Woodb. & M. 23, 19 Fed. Cas. 652, are however sometimes referred to as authority that such an assignment is valid.

Although these cases were decided after 1831 and the renewals referred to registered under that Act, they actually involved rights which had already been vested in the assignee under the Act of 1790, which by its terms made the renewal available to the assignee and authorized him to record it in his own right.

In *Paige v. Banks*, the assignment of the author's right, title and interest had been made in 1828. In *Pierpont v. Fowle*, the agreements had been made on July 21, 1823 and on July 12, 1827, respectively. In *Cowen v. Banks*, the assignee's rights had likewise vested before the enactment of the Copyright Law of 1831.

This distinction was pointed out by Judge Patnam in *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247, at 253, in the following language:

"On examining *Paige v. Banks*, as reported in 13 Wall., it appears at page 609 (20 L. Ed. 709) that the contract on which the publisher relied was made in 1828, when the act of 1790 was in force, and when no rule of public policy such as we have explained existed or had been declared."

See also:

28 Ops. Atty. Gen. 162, at 168.

Furthermore, it appears from the report of *Paige v. Banks*, 80 U. S. 608, at 616, that Mr. Paige had asserted a claim to the renewal in 1858. The defendant at that time claimed as an alternative to the ownership under the original agreement, an unlimited license to publish and sell (p. 610). Mr. Paige made no further objection. It was not until ten years later, after Mr. Paige had died, that his executors filed a bill for injunction. It would seem that this acquiescence after the renewal had been perfected was sufficient to defeat the bill on the ground of laches or estoppel.

The observations of the Court in *Pierpont v. Fowle*, 2 Woodb. & M. 23, 19 Fed. Cas. 652, were by way of dictum since the ultimate decision was that the author had not sold the renewal to the defendant.

Another case sometimes referred to as justification for enforcing these contracts is *Carnan v. Bowles*, 2 Bro. C. C. 80, which was decided in 1786 and construed an early English statute, 8 Anne c. 19. That Act was there considered as providing a reversion by way of recapture in favor of the author at the end of fourteen years. The second fourteen year period of copyright, contingent upon the author's survival, was not considered to be a new grant, but the "return" of a portion of a larger grant.

In this respect, the entire concept of the English law was different from that which underlies Section 23 of the Copyright Law of 1909 and its predecessors since 1831. It is well settled that the renewal is under our statute a new grant not dependent on ownership of the original copyright.

Fox Film Corp. v. Knowles, 261 U. S. 326;

White-Smith Music Publishing Co. v. Goff, 187 Fed. 247.

The danger of arguing from the English cases is demonstrated by the difference in the development of the English Copyright Law as compared to that of the United States. Although the Statute of Anne had contained no reference to assignees, the amendment adopted in 1814 made specific provision for them. The Statute (54 George III, c. 156, p. 817) provided (§ IV, p. 820):

"from and after the passing of this Act, the author * * * and his assignee or assigns, shall have the sole liberty of printing and reprinting such book or books for the full term of twenty-eight years, * * * and also, if the author shall be living at the end of that period, for the residue of his natural life." (Italics ours.)

The law in this country, as we demonstrated in Point II of this brief, took an opposite course. The Statute of 1790, by its express language, entitled the assignee of an author to take the renewal. The revision of 1831, in contrast to the earlier Act and to the development in the English law, excluded the assignee and limited the right of renewal to the author and his family.

The text books on Copyright Law present a confusing picture. The writers are substantially in agreement that under the statutes since 1831, the privilege of applying for the renewal is personal to the author and may not be assigned; also, that an assignee may not file an application in his own behalf.

Drone on Copyright, 261;

- Weil, Law of Copyright*, 365;
Bowker, Copyright, Its History and Its Law,
 114, 117;
Curtis, The Law of Copyright, 234;
2 Morgan, The Law of Literature, 227;
MacGillivray, The Law of Copyright, 267, 268;
Marchetti, The Law of Stage, Screen and Radio,
 66;
*2 Ladas, The International Protection of Liter-
 ary and Artistic Property*, 772;
Howell, Copyright Law, 101, 107;
Wittenberg, Literary Property, 45;
Amdur, Copyright Law and Practice, 532;
*Frohlich & Schwartz, Law of Motion Pictures
 and The Theatre*, 548;
De Wolf, Outline of Copyright Law, 65.

The discussions relate to the problems whether and how the same result may be accomplished by indirection. Prior to 1909, the views expressed varied. Some writers advanced the theory that the author might dispose not only of his own renewal, but also of that to which his widow and children might become entitled; others denied the ability of the author to impair the privileges of his widow or children; still others reach the conclusion that if an author sold his work outright, the renewal vanished and neither the author nor his assignee might avail himself of the privilege. Of importance are not only the conclusions arrived at, but also the reasoning by which they are reached.

The most elaborate discussion appears in Drone on Copyright (1879) before Congress had expressed itself so forcibly in the Committee Report of 1909. We have already referred to his statement that (p. 327):

“The provision under consideration was, doubtless, intended to secure to the author and his family a

privilege which is not given directly to an assignee; but it is *not reasonable to suppose* that the object of the statute was to reserve to the author or his family any rights with which he has voluntarily parted, and for which he has received and enjoyed the consideration." (*Italics ours.*)

Upon this premise, Drone predicated the conclusion that the author could divest not only himself of the renewal privileges, but that he could defeat the interest of his widow and children as well. He says (p. 326):

"Author may Divest Himself and Family of Right to Renewal.—It may be claimed that the provision of the American statute above referred to was intended for the personal benefit of the author or of his family. It is reasonably clear that the copyright for the additional term will vest only in the author, if he be living. But there appears to be no reason why he may not divest himself of the right thus reserved for him, either by parting absolutely with his entire interest in a work, or by an agreement to convey the copyright for the additional term when it shall be secured. In the former case, he has no interest in the work, and cannot rightly claim the additional privilege guaranteed to him by the statute. In the latter case, he is bound by his agreement to transfer to another the right when it shall be secured to him. *The principle is the same in case the author be not living at the end of the first term.* Then the copyright for the additional term will vest only in his widow or children. But their rights are dependent on his. Their title is derived from him, and stands or falls with his. There must be a good foundation on which to rest their claim. If the author has parted with his absolute property in the work, and could not, if living, himself secure the copyright, it seems to be clear that his representatives are equally incapable of securing it, for the reason that the work does not belong to them. So, when he has bound himself to assign his future term, there is no reason why such agreement should not be equally binding on

them after his death, unless there is in it some condition or other circumstance to warrant a different construction." (Italics ours.)

MacGillivray, *The Law of Copyright* (1902), after expressing merely a doubt whether the right to obtain an extension was assignable under the statute, and saying that a contract to assign the renewal would be valid, then makes a distinction between conveyances of published and unpublished works. In the latter case, his solution is that the renewal vanishes completely. He writes (p. 268):

"If the author of an unpublished work conveys all right, title, and interest in it to another, he certainly cannot take out an extended term to run against his grantee. It seems doubtful whether he can take it out at all. Certainly, his grantee cannot, and probably the author could not for his benefit."

Curtis on Copyright (1847) states without reference to authority that the author may undoubtedly assign his contingent interest, but that he cannot defeat the rights of his widow or children, should he fail to survive. He says (p. 235):

"It is not easy to see how the author can dispose of this interest. It is not created for him, but for his family; it vests only in case of his death, and the policy of the statute, it seems to me, has removed it from his control." (Italics ours.)

In 2 Morgan, *The Law of Literature* (1875), we find the recognition at page 227 that the renewal is a new interest and that it "looks entirely to the author and his family, not to assignees." Strangely, however, the author seems to believe that the statute may be disregarded by a court of equity and that the assignee might be "entitled to be protected in it, in equity, rather than according to any mere technical rule of law." (Italics ours.)

Drone's concept that the statute could not reasonably have intended to preserve rights after an author has parted with them, and that the renewal is but an appendage to ownership of the work for the original term of copyright, has been repudiated both by Congress and by the courts. As we have attempted to show earlier in this brief, there is no basis in the statute to warrant a construction that the limitations were intended to safeguard the widow and children alone, and were not inserted to protect the author against his own improvidence. The stress in the Committee's Report of 1909 is laid upon the very necessity of providing a safeguard to the author himself against improvident sales.

At first blush, the reasoning of these earlier authors seems entirely plausible. Upon analysis, it becomes apparent that they disregard the basic premise that the subject matter is a statutory privilege. It can hardly be said that a statutory policy is to be treated as a "technical rule of law", one which may be overridden in "equity". The attempted distinction between the sale of the "work" before publication, and the sale of the "copyright", loses sight of the fact that it is the "copyright" which is in issue. That right is separate and distinct from the tangible object itself and likewise distinct from the common law property which it supersedes.

American Tobacco Co. v. Werckmeister, 207
U. S. 284, 301.

When a publisher copyrights a work or deals with copyright property, and thus avails himself of the privileges of the statute, he subjects himself to its limitations as well.

Weil, who wrote after 1909, addressed himself to the very nub of the controversy. Referring to Drone's premise, he says (Weil, *The Copyright Law*, p. 367):

"* * * The difficulty with this argument is that it fails to recognize that the rights involved are purely statutory, and hence dependent not on the ownership of a work, not on authorship, but on the statute. Authorship furnishes the foundation for the legislation under which copyrights are granted, but it does not furnish the measure of rights granted by the statutes. The distinction is between the occasion for, and the results of, legislation."

A number of writers after 1909 expressed doubt concerning the validity of contracts by which authors attempted to alienate their renewal privilege.

As the majority opinion below indicates, Weil definitely "hedged" on the validity of an anticipatory sale of a renewal by the author. He said (p. 365):

"* * * If the author be living when a copyright expires, *he may, it seems*, be compelled in a proper case, to assign the renewal copyright to the proprietor of the original copyright, if the contract between them so provided." (*Italics ours.*)

Bowker, who participated in the conferences which led to the formulation of the 1909 Law (Copyright, Its History and Its Law, vi) and whose book appeared in 1912, displays a complete lack of certainty. He says (p. 114):

"The new code differs in making the renewal period a second twenty-eight years and extending the right of renewal to the executors or next of kin and to the proprietors of composite or other impersonal works; but it still denies renewal to assignee proprietors of personal works."

Again at page 117:

"No contract on the part of an author can give a publisher the right to claim copyright renewal under the new code, although a contract to make claim for the renewal period and transfer the copyright for the

renewal period to the publisher, *might be enforced by the courts through a writ requiring the author to enter such claim and assign the renewed copyright in accordance with the contract.*" (Italics ours.)

Finally, at page 118:

"Where an author has sold 'outright' all his right, title and interest in his work, it is possible that this may estop him from application for renewal or invalidate a renewal, but this question must be decided by the courts when a case arises. It is important that any contract between author and publisher should be clear and specific *on this vexed question of rights for the renewal term.*" (Italics ours.)

De Wolf, Outline of Copyright Law (1925), is equally hesitant. He says (p. 66):

"It will be seen that, although the renewal copyright is a new copyright, and not merely the continuation of the original copyright, yet the policy of the law is that it shall go to the author or to his relatives. It cannot in any case go to an administrator, for the general benefit of the author's estate, or for the payment of his debts. Much less can it go to an assignee of the author. (*White-Smith Publishing Co. v. Goff*, 187 Federal Reporter, 247.) Contracts between authors and publishers were formerly often made, by which the author undertook to grant not only the right to obtain the original copyright, but also the right to renew. *It may be that if the author is living when the time for renewal arrives, he can be compelled to carry out the terms of his contract by taking out the renewal in his own name and then assigning it without further compensation to the publisher. But if he dies before the time for renewal registration arrives, i. e., before the beginning of the last year of the original twenty-eight year term, his obligations die with him, so far as the copyright law is concerned. His widow, or children, are not bound by his agreement and they receive the renewal copyright free of all incumbrance.*" (Italics ours.)

Mr. Howell (*The Copyright Law*, 1942), formerly Assistant Register of Copyrights, after citing the rule in the present case (p. 108), hastens to add at page 109:

"The renewal right being personal to the author, it is doubtful whether, in the event of his dying before the statutory year arrives, the widow or children could be bound by having joined in any such contract. This would plainly be contrary to the general policy of the Act, and enable the author to accomplish indirectly what he is not permitted to do directly."

Ladas, 2 *International Protection of Literary and Artistic Property*, 772 (1938), and Wittenberg, *Literary Property*, 45 (1937), merely accept the proposition that an author may assign the renewal by contract.

Frohlich & Schwartz, *The Law of Motion Pictures and The Theatre* (1918), call attention (p. 549) to the difficulty of obtaining a decree in a court of equity within one year if the author refuses to renew the copyright.

Marchetti, *Law of Stage, Screen and Radio*, 67 (1936), relying entirely upon Drone, reverts to the proposition that an outright sale of the work will convey the renewal although an assignment of the "copyright" might be limited to the first twenty-eight years.

The later writers who accept the doctrine of assignability, do not seem to have given any consideration to the reasons which in 1909 motivated Congress to retain the renewal pattern. They do not attempt to discuss the policy of the statute. Those writers, such as Weil, De Wolf, Bowker and Howell, who give consideration to the question of statutory policy, are obviously troubled about the incongruity of recognizing an assignment of the substance of the renewal application when Congress sought to prevent that result.

In the Court below, reference was made (R. 75) to a strong dictum in the case of *Tobani v. Carl Fischer, Inc.*, 98 Fed.

(2d) 57, cert. denied 305 U. S. 650. There, the question was whether Tobani's works had been written "for hire". The Court found this to be the fact and that Tobani's family did not have the privilege of filing the renewal.* The works produced by Tobani came, therefore, within that class of impersonal works in respect of which the proprietor alone might file the application. The Court moreover held that no proper application had been filed and the renewals obtained by Tobani's family were, therefore, nullities. In the course of his opinion, Judge Manton, wholly unnecessarily, we submit, reverted to Drone's theory that an author who sells his work outright retains no interest upon which to predicate a right to renew the copyright. As Judge Frank indicated in his dissent below (R. 90), the force of the *Tobani* case has been weakened by a later opinion—*Shapiro, Bernstein v. Bryan*, 123 Fed. (2d) 697, 700.

It is sometimes said that an opinion rendered by the Attorney General in 1910 (28 Opinions Attorneys General 162) is forceful authority that an agreement to assign the renewal is unenforceable.

There had been presented to the Attorney-General questions relating to the right of assignees to file applications for renewal. These applications were of two classes (p. 162):

(1) Applications made by assignees under direct assignments of the renewal or extension term from the persons named in the statute as entitled to renewals or extensions.

"(2) Applications made by assignees who purchased the copyrighted work, either when the original copyrights were secured or subsequent thereto, and who also took assignments of the copyrights."

* Although the exception does not appear in Section 24 under which the *Tobani* case arose, the Court read into that section a definition of "author" which appears in Section 62.

It was the Attorney-General's opinion that none of the applications could be accepted. He said (p. 170):

"The applicants here in question are the owners of the works by purchase, and assignees of the original copyrights, and in some cases, have taken assignments of the renewal terms. But in neither case does the statute authorize the extension to be made in the name of the assignee, and the applications should, therefore, be disallowed."

In the course of his discussion, the Attorney-General made the observation that the rights in the renewal might be the subject of a valid contract which would carry the equitable, if not legal, title. He pointed out, however (p. 169):

"It is not intended in this opinion to determine any question of law which relates to the relative rights of authors and their assigns, and such rights are mentioned only by way of illustration or argument."

In the light of the disagreements amongst the writers, particularly concerning the intent of the statute, it cannot in justice be said that their views settled the law on the enforceability of an author's agreement disposing of his renewal in advance of the twenty-eighth year of the first term. The reluctance on Drone's part to recognize the policy enacted into the statute must now be disregarded. The attempts of some writers to differentiate between the right to alienate the privilege of filing the application and the right to dispose of beneficial ownership of the renewal before the application is filed, is too tenuous for acceptance to defeat a statutory policy. Similarly, argument that the sale of a "work" before publication conveys the renewal and a sale of the "copyright" does not, seems to be a distinction without a difference. The theory that the statute was intended to safeguard the author's widow and his children and not the author himself finds no basis in the statute or in the Committee's Report. All

of these shadings of interpretation, based on so-called equitable principles, are in reality but a refusal to recognize the Congressional policy and another way, perhaps unconsciously, of phrasing Drone's argument that it is not reasonable to suppose Congress intended to make the renewal inalienable.

We respectfully submit that Congress recognized or assumed that authors are improvident individuals, prone to bargain away for a mere pittance valuable economic rights in their artistic creations. Desiring to insure to authors financial benefits from their writings, Congress, in Section 23, created two separate and distinct terms of copyright, each enduring for a period of twenty-eight years. By limiting to the author and his family the right to secure the second or renewal term, Congress intended to make certain that the author and his family would, at the expiration of twenty-eight years, obtain the financial benefits of the renewal term. In order to make effective, this Congressional purpose, Section 23 must be construed as rendering invalid and unenforceable any agreements entered into by the author prior to the twenty-eighth year alienating the beneficial ownership of the renewal copyright. Any other construction completely frustrates the Congressional intent to protect the author and his family, and makes utterly meaningless the statutory purpose in creating two separate terms of copyright, and limiting the privilege of renewal to the author and his family.

POINT V

The interlocutory judgment appealed from should be reversed; the decree *pendente lite* vacated and set aside; and the case remanded with instructions to deny respondent's motion for a temporary injunction.

Respectfully submitted,

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APPENDIX A

Statute Involved

Section 23 of the Copyright Law reads as follows:

“Duration; renewal. The copyright secured by this title shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided*, That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further*, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work when such contribution has been separately registered,* the author of such work; if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within

* The clause "when such contribution has been separately registered" was deleted by Act of March 15, 1940, c. 57, 54 Stat. 51. Otherwise, the Section has remained unchanged since 1909.

one year prior to the expiration of the original term of copyright: *And provided further*, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication. (Mar. 4, 1909, c. 320, § 23, 35 Stat. 1080.)”

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Supreme Court of the United States

OCTOBER TERM—1942

**FRED FISHER MUSIC CO., INC. and
GEORGE GRAFF, JR.,**

Petitioners,

against.

M. WITMARK & SONS,

Respondent.

PETITIONERS' REPLY BRIEF

ARTHUR GARFIELD HAYS,
Solicitor for Petitioners.

JOHN SCHULMAN,
of Counsel.

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PETITIONERS' REPLY BRIEF

Throughout the respondent's brief, there runs the refrain that the statutory renewal privilege is no different from any other property and should therefore be equally alienable. Phrased in many ways, the argument resolves itself into a modification of that which was advanced by Mr. Drone in 1878—it is not reasonable to suppose that the object of the statute was to preserve to the author or his family any rights with which he has voluntarily parted (Drone on Copyright, 327).

We also find reverberations from a book written by Bowker in 1886 (Copyright, Its Law and Its History, Chapter XI, pp. 33, *et seq.*) which urged that the relationship between authors and publishers was not properly within the scope of a copyright code; that there should be no interference with freedom of contract between parties to a business transaction; and that the author might reserve the renewal for his own benefit or freely contract away the renewal as part of the original bargain.

We know, however, that the courts and the text writers have not followed Mr. Drone, at least in respect of the

right of the author to dispose of the renewal privilege enuring to his family. Congress adopted the Statute of 1909 and continued the renewal privilege limited to the author and his family after Drone and Bowker wrote.

In our main brief, we quoted from the later book written by Mr. Bowker in 1912 (Copyright, Its History and Its Law) where he was no longer so certain of his ground (Petitioners' main brief, pp. 51-52). In 1912, after Congress had stated what its intention was, Bowker wrote that a contract to transfer the copyright renewal period *might* be enforced by the courts. He also suggested that if an author sold his work outright, the renewal might be invalidated completely. Bowker was undoubtedly obliged to undergo a change in thought as a result of the new Copyright Law.

The respondent finds itself hard pressed to square the doctrine of free alienability with the limitations on the renewal privilege imposed by Congress. For instance, when counsel for the respondent is faced with the necessity of answering the statement in the Patent Committee's Report that "your Committee felt it should be the exclusive right of the author to take the renewal term", his only answer is (Brief 27) that the exclusivity referred to is that which flows from the ownership of copyright. He does not explain the vital words "to take the renewal term."

Similarly, in an attempt to overcome the distinction in Section 23 between impersonal works which may be renewed by the proprietor, and personal works where the exclusive right of renewal vests in the author, the respondent argues (Brief 14) that it is unthinkable that a proprietor should not be able to sell the renewal right. Counsel suggests that Congress had no purpose in protecting a proprietor against an improvident act, and that since the two portions of Section 23 are parallel they

should be read alike. Respondent, however, fails to take into account that the two portions are not parallel. Proprietorship has reference to ownership of copyright. As ownership passes from person to person, proprietorship varies accordingly. Consequently, the statute in providing that the "proprietor" may take the renewal, refers to the person who owns the copyright at the crucial time. This interpretation was given to the Act in a preliminary decision in *Shapiro, Bernstein & Co. v. Bruhn*, 27 Fed. Supp. 11, 13. Judge Cox said:

"I think the words 'proprietor of such copyright' in this connection plainly means the proprietor at the time of the renewal, and not at the time of the original copyright."

Mr. Howell, "The Copyright Law", page 102, likewise adopts this view.

Authorship, however, never changes. It bespeaks the relation of the creator of a work to the work itself. Proprietorship varies with ownership. Authorship, on the other hand, remains constant. This thought may be stated in another way. Authors who own or purchase their copyright are proprietors. A person who buys a copyright does not become the author. It follows, therefore, that the concept which underlies the proprietor's renewal of copyright, is totally different from that which restricts the privilege to the author.

Since the respondent adopts the premise that the statutory renewal privilege does not differ from other property, his conclusion that it may be alienated follows readily enough. It is the premise, therefore, which must be examined, and if that be fallacious, the entire structure must fall.

In examining that premise, we find that a number of questions are not answered by the respondent.

1. Why was the renewal created and why was it made contingent upon the author's life? The answer obviously is that the purpose was to benefit the author. The renewal privilege is a special kind of property existing only by force of the statute and available only in accordance with the legislative grant. If it had been intended that the publisher might acquire the renewal with the first term, there was no reason to deprive him of the monopoly for a second twenty-eight years because the author failed to outlive the original term.

2. The next inquiry is, why did the Statute of 1831 eliminate the assignee from the category of persons entitled to take the renewal? Judge Putnam, in *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247, 250, said it was to disserve the title and to create a new grant—a privilege available only to the persons named in the statute. Respondent replies (Brief 50) that Judge Putnam misinterpreted the statute, but provides no alternative reason, except to say that the exclusion made no difference (Brief 36).

3. All writers, and the decided cases, agree that the author may not confer upon the assignee the privilege of applying for the renewal in his own right. Respondent replies (Brief 15) that the author may "have someone act for him" and that this limitation has no bearing upon the beneficial ownership. This argument disregards reality. If the publisher owns the renewal and files it in the name of the author, is he acting for the author or is he acting for himself? Respondent provides no adequate answer to the question whether Congress was concerned only with the name in which the renewal was registered, or whether it was interested in the tangible advantages flowing from his special privilege.

4. Most writers agree that legal title to the renewal may not be assigned in advance, but some say that

contract to assign may be enforced in equity. Others say that a disposition of the ownership may destroy the renewal privilege entirely.

Since the legal "technicality" was imposed by statute, why was that impediment created and how may a court of equity disregard the legislative will? To this, respondent provides no answer. To assert that a legislative limitation is a mere technicality does not meet the issue.

5. When the Copyright Law was in the course of amendment in 1905 to 1909, the suggestion had been made—and the Committees of both houses originally adopted this suggestion—that there be a single term of copyright which would have been alienable in its entirety. This provision was later rejected and the renewal pattern retained for the author's benefit.

The most that respondent can say about this history is that the purpose was to make it "easy" for the author to keep the renewal term (Brief 25). This is hardly an answer. If the word "assigns" had been included in the statute, it would still have been "easy" for the author to omit the assignment from the contract. If a single term had been adopted, it would still have been easy for the author to grant only twenty-eight years of that term and to retain the balance for himself.

The difficulty which the Committees envisioned was not in the preparation of contracts, but one of a lack of business acumen and bargaining power. They stated that authors not infrequently sell their copyrights outright for comparatively small sums. This was not because proper contracts could not have been written, but because authors, either by reason of improvidence or driven by necessity, failed to provide for the future. We agree that Congress wanted to aid the author. The safeguard which it provided took the form of preventing an author from disposing of his special privilege until the twenty-eighth year of the original term.

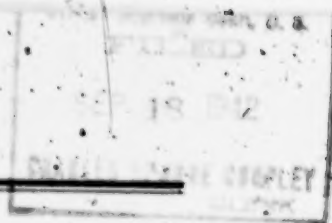
It is respectfully submitted that the respondent has failed to meet the real issue in the case, namely, the purpose which was sought to be accomplished by the limitations written into Section 23 of the Copyright Law. This purpose was to safeguard the author against his own improvidence. That purpose can be effectuated only if contracts purporting to alienate the renewal in advance are held void and unenforceable.

Respectfully submitted,

ARTHUR GARFIELD HAYS,
Solicitor for Petitioners.

JOHN SCHULMAN,
of Counsel.

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IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942—NO. 327

FRED FISHER MUSIC CO. INC. and GEORGE
GRAFF, JR.,

Petitioners,

against

M. WITMARK & SONS,

Respondent.

**RESPONDENT'S BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

ROBERT W. PERKINS,
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STUART H. AARONS,
SIDNEY BARROWS,
of Counsel.

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**RESPONDENT'S BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

Introductory Statement

Petitioner Graff, in collaboration with another, wrote the words of the song "WHEN IRISH EYES ARE SMILING" pursuant to a contract under which respondent was granted the "copyright or copyrights of" the song "with renewals and with right to copyright and renew", subject to the payment of royalties (R. 37, 38). Several years later, Petitioner Graff, in consideration of a lump sum payment, relinquished his right to royalties, confirmed in respondent "all copyrights and renewals of copyrights and the right to secure all copyrights and renewals of copyrights" in the song, and formally appointed respondent his attorney to take such action as might be

necessary to secure to respondent the renewal term of the copyright (R. 44). Accordingly, at the beginning of the twenty-eighth year of the original term, respondent renewed the copyright in the name of Petitioner Graff and assigned it to itself. A few days later, Petitioner Graff purported to renew the copyright and to assign it to Petitioner Fisher, who had full knowledge of all the facts, and who proceeded to publish the song.

Respondent sued for an injunction and an accounting for profits, and damages, and made a motion for an injunction *pendente lite* restraining petitioners from publishing the song. The motion was granted upon affidavits and counter-affidavits (R. 81). On appeal, the Circuit Court of Appeals affirmed the order for the preliminary injunction, Judge Frank dissenting.^{*} Both the majority and dissenting opinions were concerned largely with the question of whether the Copyright Act of 1909** makes invalid any assignment or agreement to assign the renewal term before the twenty-eighth year of the original term. On this question the majority opinion held that although the statute made the author's right to the renewal term expressly contingent upon his being alive during the twenty-eighth year, it did not restrict his right to assign the renewal term while it was still contingent, and if the author was alive the assignee took the renewal term. Judge Frank dissented, saying that the statute as a matter of policy made invalid any assignment of the renewal term while contingent. The two opinions differed on a question of fact affecting their respective interpretations of the statute. Both opinions also considered other questions of law and fact not affecting the statutory question.

^{*} 125 F. (2d) 949, 954; R. 95, 105.

^{**} 37 Stat. 1075.

POINT I

Certiorari should not be granted because the order is not final.

Petitioners frankly point out that the order sought to be reviewed is interlocutory. They seek to avoid the usual rule in such cases by making the following statement:

"However, in the instant case, the sole issue presented is one of statutory construction. The facts upon which this question is presented are not in dispute * * * (Petition, p. 7).

Both of the sentences quoted from the petition are erroneous. On a question of fact relating solely to statutory construction, there was a sharp disagreement between the majority and dissenting opinions in the Circuit Court of Appeals. The majority found there had been a fairly uniform interpretation, presumably acted upon by the trade, that an author could make binding agreements with respect to his contingent right to renew (R. 101). Judge Frank disputed this (R. 115).

Further, petitioners forget that there were questions of fact and law involved in the decision of the Circuit Court of Appeals not relating to the question of statutory construction, and that the majority and dissenting opinions below differed on those questions. Thus Judge Clark, writing for the majority, stated:

"We are limiting our discussion, as did the parties before us, to the question of statutory interpretation. On this interlocutory issue we ought not to foreclose other contentions which the parties may wish and be entitled to raise on the merits, including possibly claims of inadequacy of consideration

4.
in 1917 so gross as to prevent negative enforcement of the assignment, with which would go the question of adequacy of damages as a remedy for breach. 2 Restatement, Contracts, §§ 358, 363, 367, 380. But we think we should say that the record contains no evidence which casts doubt on the consideration; certainly defendant Graff's statement that royalties on the songs covered by the assignment had amounted to as much as \$5,000 annually (i.e., as a maximum) does not do so, particularly in view of the well-known ephemeral nature of popular song hits." (R. 104, 105)

In contrast, Judge Frank argues as the first point in his dissenting opinion that the order for a preliminary injunction should be reversed for reasons having nothing to do with statutory construction. He states:

"That order was improper, if, on the facts presented, assuming, for present purposes, that they will be the facts on final hearing, it seems unlikely that plaintiff will be granted the final relief sought, a decree for specific performance. I think the order should be reversed, because on the facts as they now appear, a court of equity should not grant specific performance, in the light of the subject matter of the contract, the circumstances and relations of the parties when it was made, and the consideration paid." (R. 105, 106).

He devotes four pages of his dissent to a discussion of the law and the facts involved in this proposition with an extended discussion of authorities (R. 105, 109, incl.).

In their discussion of the finality of the proceeding petitioners make the following statement:

"Should this writ be granted and the question of law determined in accordance with the petitioners'

contentions, the practical effect will be a final determination of the action *adverse to the respondent*. (Italics ours.) (Petition, p. 7)

We believe that the question of law should be decided against petitioners' contentions, and petitioners nowhere admit that in such event the action would be finally determined.

The preliminary injunction was granted on affidavits and counter-affidavits. If certiorari is denied the case will proceed to trial in the usual course. If the testimony at the trial establishes facts differing from those shown by the affidavits in the present proceedings, the trial may result in the denial of the relief sought on facts and law having nothing to do with the construction of the statute.

No possibility of the disposition of the case on issues not reviewed by the Supreme Court existed in any of the four cases relied upon by petitioners to get around the difficulty confronting them in the lack of finality of the order sought to be reviewed. The general rule is succinctly stated in *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U. S. 251, 258:

"And, except in extraordinary cases, the writ is not issued until final decree. *Amex. Const. Co. v. Jacksonville Railway*, 148 U. S. 372, 378, 384; *The Three Friends*, 166 U. S. 1, 49; *The Conqueror*, 166 U. S. 110, 113; *Denver v. N. Y. Trust Co.*, 229 U. S. 123, 133. The decree that was sought to be reviewed by certiorari at complainant's instance was not a final one, a fact that of itself alone furnished sufficient ground for the denial of the application;

POINT II

This is not a case of first impression.

Petitioners contend that this is a case of first impression. But they admit that on the question of statutory construction the Act of 1831 is the same as the Act of 1909. We submit that *Paige v. Banks*, 13 Wall. 608, is a decision under the Act of 1831 holding that contingent rights of renewal are assignable. Although Judge Clark states that the question of statutory construction "has apparently never arisen before", in the second footnote of his opinion he agrees with our interpretation of *Paige v. Banks*.^{*} It is true that the assignment held valid in that case was made in 1828 before the Act of 1831 was passed, but the renewal term involved was created by the Act of 1831. This is clearly shown in the facts given in the report of the same case below in 7 Blatch: 152.

POINT III

Certiorari should be denied because the statutory question raised affects practices presumably long continued, under which rights are vested, and involves questions of policy which should be left to Congress.

The majority opinion gave much weight to the practical construction that had been given to the statute. It says:

"If we could find that the statute had been interpreted—in the light of the committee's report—to forbid such assignments as we find here, we might well be inclined to give the committee the benefit of any doubts as to the language they had

^{*}R. 95, 97.

chosen. * * *. But we do not find such interpretation; so far as we can ascertain, the general view has been to the contrary." (R. 100).

The opinion then quotes the opinion of Assistant Attorney General Fowler rendered soon after the passage of the Act:

"no doubt it (the renewal) may be the subject of a valid contract before renewal, which would carry the equitable, if not the legal, title thereto when renewed." 28 Ops. Atty. Gen. 162, 169." (R. 100)

The majority opinion further says:

"Such also appears to have been the attitude of the people affected by copyright law as manifested in the treatises on the subject" (R. 100).

citing the many treatises published before and after 1909. To this list of treatises there should be added the one just published in which the former Assistant Register of Copyrights states:

"The statute does not prevent the author from specifically agreeing to assign in futuro his own renewal rights, but the fulfillment of such contract is contingent upon his surviving into the renewal year". Howell, The Copyright Law, 108.

From the treatises, the majority presumed that the trade had acted upon the basis that the author could make binding agreements with respect to his contingent renewal rights (R. 101).

This practical construction is one with which courts should be loathe to interfere, since any change should be made by the Legislature. *Bate Refrigerating Co. v. Sulzberger*, 157 U. S. 1, 37, 44; *United States v. Finnell*,

185 U. S. 236, 244. Disposition of the matter by Congress is appropriate because legislation would affect only future transactions, whereas adjudication by the court upsets what has taken place in the past. This point is clearly stated in the majority opinion:

"Notwithstanding this history, we might well be moved by a demonstration that only by holding all assignments void could we further the policy of the act. But even this seems to us quite doubtful. True, it would be nice for an author to look forward to more money when the renewal time comes. But he can do that by not assigning. What we would be saying is that all authors who have already assigned can eat their cake and have it too. Only in the future would such a ruling be fair all around." (R. 103)

Aside from the question of upsetting past transactions, there are difficult problems of policy in determining whether or not the renewal term should be inalienable before it vests. The majority opinion states the problem as follows:

"Furthermore, it is not clear that authors wish to be deprived of the privilege of obtaining more money now, or that a widow whose husband dies penniless wishes to be deprived of the privilege of anticipating on her statutory renewal right." (R. 103)

Moreover, if renewal rights are made unassignable prior to the twenty-eighth year, then when the original term has almost expired and only the few remaining years of that term could be disposed of, the work might become unmarketable. For instance, near the end of the original term a motion picture producer could not afford to pur-

chase a story because the limited term which he could acquire would not justify the investment necessary for the production of the picture. It is true that even on our interpretation the acquisition of the renewal term involves some risk, but there is always a risk in purchasing property in which there are contingent estates. Our interpretation tends towards the preservation of the marketability of literary works, with the resultant possibility of public enjoyment, and unlike petitioners' contention, does not take valuable literary property off the market toward the end of the original term.

The majority opinion emphasizes the fact that many bills, amendatory to the Statute of 1909, have been introduced into Congress, on the assumption that contingent rights of renewal under the Act of 1909 are assignable (R. 102, 103). Problems of copyright and copyright reform have been continually before Congress. The statute has been amended ten times since 1909*. There are now pending eleven bills, at least three of which are of comprehensive nature (C. C. H. Congressional Index Service 1941-2, pp. 3303 ff.). In the face of such legislative activity, it would seem appropriate for this Court to refrain from passing upon the question sought to be reviewed.

POINT IV

Petitioners' arguments to support their construction of the Act of 1909 are unsound.

Copyright legislation in this country has extended over a period of one hundred and fifty years. Following the

* 37 Stat. 488 (1912); 37 Stat. 724 (1913); 38 Stat. 311 (1914); 41 Stat. 369 (1919); 44 Stat. 818 (1926); 45 Stat. 713 (1928); 53 Stat. 1142 (1939); 54 Stat. 51 (1940) (amended Section 23 of Copyright Act of 1909); 54 Stat. 106 (1940); Sept. 25, 1941, P. L. 258.

precedent of the earliest English statute,—8 Anne, c. 19, 1709,—it has always provided for two terms of copyright, an original term and a renewal term. The renewal term has always been a contingent term, depending upon survivorship. In our earliest statute, that of 1790 (1 Stat. 124), the author's right to the renewal term, as in all subsequent statutes, was contingent on his surviving. If he did not survive, the work went into the public domain. The statute of 1831 (4 Stat. 436) changed this only to the extent of providing that if the author did not survive, his widow and children would have the renewal term; and if they did not survive, the work would go into the public domain. Finally in 1909 (35 Stat. 1080), the same contingencies were provided with respect to the renewal term except that if the widow and children did not survive, the renewal term would go to the executor of the author or, if there was no executor, to his next of kin.* If neither the author, widow nor children survived and there was no will or next of kin, the work would go into the public domain. Under this statutory scheme, the author, the widow, and the children have a contingent right, or expectancy, but that does not import any restriction on their freedom to assign it.

"The right of an author in his intellectual production is similar to any other personal property right" (*Buck v. Swanson*, 33 Fed. Supp. 377, 387), and the policy of the law in general is against restrictions on the alienation of rights in personal property. *Dr. Miles Medical Company v. John D. Park & Sons Company*, 220 U. S. 373, 404. The original term of copyright is freely assignable before the copyright is taken out, or even before the literary work is

* Of course, with respect to four special categories not involved here, the renewal term under the Statute of 1909 was not contingent upon survivorship. See p. 13, *infra*.

created (*T. B. Harms v. Stern*, (C.C.A. 2d), 231 Fed. 645; *Callaghan v. Myers*, 128 U. S. 617), and petitioners, of course, admit that the renewal term can be freely assigned after it has been taken out. In fact, Petitioner Fisher claims the right to publish the song under an assignment of the renewal term by Petitioner Graff.

Petitioners, in support of their contention that the contingent renewal term is not assignable, rely upon a strained construction of the Act of 1909 and the Committee Report introducing it. They lay much emphasis upon the presence or absence in the Act of the word "assigns", or of what they consider an equivalent word "proprietor". They use this approach, first, in comparing Section 8 with Section 23, second, in comparing the first proviso in Section 23 with the second proviso in Section 23, and third, in comparing the Act of 1790 with the Acts of 1831 and 1909.

In comparing Section 8 with Section 23 of the Act of 1909, petitioners state that the word "assigns" in Section 8 refers to the original term of copyright, and argue that its presence in that Section shows that the original term is assignable, whereas its absence from Section 23 shows that the renewal term is not assignable.

Petitioners' statement that the word "assigns" in Section 8 refers only to the original term of copyright is definitely wrong. The language of that section shows that the word "assigns" is as applicable to the renewal term as to the original term. Section 8 reads in part as follows:

"The author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and for the terms specified in this title." (Italics ours.)

The word "assigns" refers to "the author or proprietor" of the copyright "for the *terms* specified in this title." "Terms" is in the plural and unquestionably covers both terms referred to in Section 23. The original term is defined in that Section as follows:

"The copyright secured by this title shall endure for twenty-eight years from the date of first publication. . . ."

Then follows the definition of the renewal term. This is given in the first proviso in the Section for the four special categories in which the proprietor of the original term is entitled to the renewal term, the language being

"... the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the *further term* of twenty-eight years. . . . (Italics ours.)

The second proviso covering all works not covered by the first proviso, such as the one at bar, gives the following definition for the renewal term:

"... the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, . . . shall be entitled to a renewal and extension of the copyright in such work for a *further term* of twenty-eight years. . . . (Italics ours.)

Section 8, therefore, would seem to settle adversely to petitioners the question of statutory construction which they seek to raise.

Petitioners' next approach is to compare the first proviso of Section 23 with the second proviso of that Section, arguing that the presence of the word "pro-

prietor" in the first and its omission from the second indicates the intention on the part of Congress to prevent assignments of the renewal term created by the second proviso. Of course this argument is fallacious because it would strike down an assignment of the renewal term made after it had vested as well as an assignment made while it was contingent, a result which petitioners cannot accept.

Again Section 8, as just analyzed in its application to the two provisos of Section 23, makes it clear that there is no limitation on assignability anywhere in Section 23. There is a further reason why petitioners' argument fails. In the four categories established by the first proviso, the renewal term accrues regardless of any survivorship, or of any contingency other than the registration. For that reason, it was appropriate to use the word "proprietor", and its omission in the second proviso is merely to make it clear that here the renewal term is contingent upon survivorship. The distinction drawn is not one between assignable and nonassignable rights, but between vested and contingent rights.

Finally, petitioners' third approach is to compare the Act of 1790 with the Acts of 1831 and 1909. They argue that the Act of 1790 in providing that the renewal term should continue to the author his "executors, administrators or assigns", necessarily made the right of renewal assignable whereas the omission of such words in the Act of 1831 and the Act of 1909 indicated an intent on the part of Congress to restrict the alienability of the renewal term.

Of course we believe that Section 8 of the Act of 1909 relates to the renewal term provisions of Section 23, which disposes of petitioners' argument. Moreover, if the omission of the word "assigns" is to be given effect

with respect to the renewal term, it must apply as much to the renewal term after it has vested as it applies to the renewal term while contingent, and the effect of the argument would be that the vested renewal term could not be assigned. Finally, as the majority opinion says, it may be just as well argued that the omission of the word "assigns" was

"only to prevent an assignment that would cut off the widow's and children's rights in case the author died;" (R. 98)

Petitioners argue that under the Act of 1909 the application for renewal must be made by the author, and that this evidences a public policy to prevent an anticipatory alienation of the renewal right. We do not concede that an assignee may not make an application for the renewal term if the author be living. Section 23 merely provides that the author, if living, or his widow, etc., if the author be not living, shall be entitled to a renewal and extension of the copyright

"when application for such renewal and extension shall have been made to the copyright office * * *

There is no language here specifying what person shall make the application, and for all that appears, the assignee may do so. And whether this is so or not, the language here relied on by petitioners cannot be tantamount, as they contend, to an absolute prohibition against the making of an anticipatory assignment. We have already stated our belief that Section 8 shows Congressional intent to the contrary. The Court's attention is also called to Sections 41 to 46 of the Act dealing with assignments. If Congress had any thought of prohibiting the assignment of any interest in copyright, it would have been

easy to insert a few words to that effect among these provisions.

Petitioners, and Judge Frank in his dissenting opinion, refer to certain language in the Committee report recommending the passage of the Act of 1909 as evidencing Congressional intent to make the contingent renewal term inalienable. They especially refer to the italicized portion of the following language:

"The present term of twenty-eight years, with the right of renewal for fourteen years, in many cases is insufficient. The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period that there would be no probability of its being *taken away from him in his old age, when, perhaps, he needs it the most.*" (Italics ours.)

The majority opinion points out that the direct purpose of that part of the Committee's report relating to the renewal term was

"clearly to explain the *continuance* of a renewal term as against the substitution of a single long term. In other words, it argued for an existing arrangement—"the existing law"—and so not necessarily or clearly for an absolute prohibition. If the committee had really meant the latter, they could easily have so drafted the statute. And they could easily have stated their purpose in unambiguous words in their report." (R. 99)

The Committee had in mind not the question of alienability but the question of two terms as against a single term and the duration of copyright protection. A bill introduced in 1907 (H. R. 25133, 59th Congress, 2d Ses-

sion) provided for a single term of copyright for the author's life and thirty years. The Committee on Patents recommended its passage, and in discussing the single but long term of copyright (life and thirty years), used the following language:

"Your committee believe that it is better to have a single term without any right of renewal, and that that term should certainly cover the lifetime of the author. If an author is entitled to any protection on his work, that should not be *taken away from him in his old age, when perhaps he needs it most.*" (Italics ours.) Report No. 7083, House of Representatives, 59th Congress, 2nd Session, Jan. 30, 1907, p. 13.

This language related solely to the duration of copyright. The words italicized are identical with those in the report of the Committee on Patents in 1909 above quoted recommending the retention of two terms but extending the length to a total of fifty-six years. Obviously, the language is not concerned with restrictions on alienability.

Petitioners make much of the fact that the Committee Report on the 1909 Statute used the words "exclusive right" in stating

"your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right."

The phrase "exclusive right" does not of itself connote inalienability. The phrase applies equally to the original and the renewal term. The Constitution and Section 1 of the 1909 Statute use the phrase to show that the rights secured to authors are "exclusive", not "non-exclusive". The Committee Report itself in the next paragraph uses the phrase "exclusive right" in exactly that sense.**

* R. 98-99.

** R. 99.

Petitioners also refer to the words in the Report "so that he could not be deprived of that right". Judge Clark points out how inappropriate these words are to express any intention to restrict the alienation of the renewal term prior to its vesting (R. 99-100). The concern which the Committee had for the author was taken care of by the continuance of the double term of copyright and the enlargement of the renewal term from fourteen to twenty-eight years.

CONCLUSION

The order sought to be reviewed is not final. There remains for final hearing an issue of fact affecting the question of statutory construction, as well as other issues which might determine the case without regard to that question. The decision of the Circuit Court of Appeals is sound and any change in the construction of the Statute, which would involve difficult problems affecting the rights of authors, and of the public, should be left for the determination of Congress in the light of present day conditions.

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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APPENDIX

Relevant Sections of the Copyright Act of 1909 As Amended

§8. AUTHORS OR PROPRIETORS, ENTITLED; ALIENS. The author or proprietor of any work made the subject of copyright by this title, or his executors, administrators or assigns, shall have copyright for such work under the conditions and for the terms specified in this title * * *

§23. DURATION; RENEWAL AND EXTENSION. The copyright secured by this title shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided*, That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further*, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work, the author of such work, if still living, or the widow,

widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living; then the author's executors; or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright; *And provided further*, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication. (As amended Mar. 15, 1940, c. 57, 54 Stat. 51.)

§41. COPYRIGHT DISTINCT FROM PROPERTY IN OBJECT COPYRIGHTED; EFFECT OF SALE OF OBJECT, AND OF ASSIGNMENT OF COPYRIGHT. The copyright is distinct from the property in the material object copyrighted, and the sale or conveyance, by gift or otherwise, of the material object shall not of itself constitute a transfer of the copyright, nor shall the assignment of the copyright constitute a transfer of the title to the material object; but nothing in this title shall be deemed to forbid, prevent, or restrict the transfer of any copy of a copyrighted work the possession of which has been lawfully obtained. (Mar. 4, 1909, c. 320, §41, 35 Stat. 1084.)

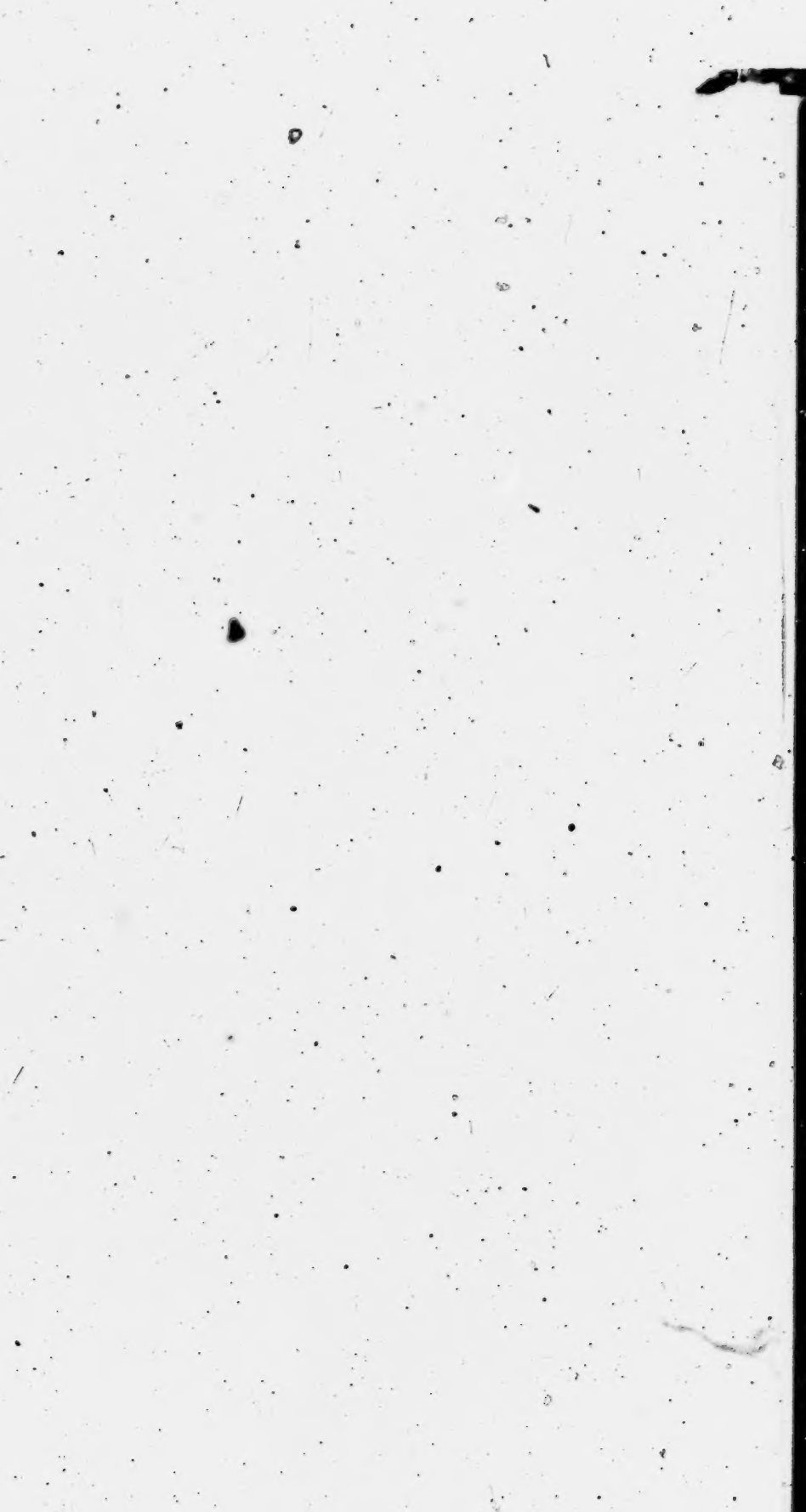
§42. ASSIGNMENTS AND REQUESTS. Copyright secured under this title or previous copyright laws of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will. (Mar. 4, 1909, c. 320, §42, 35 Stat. 1084.)

§43. SAME; EXECUTED IN FOREIGN COUNTRY; ACKNOWLEDGMENT AND CERTIFICATE. Every assignment of copyright executed in a foreign country shall be acknowledged by the assignor before a consular officer or secretary of legation of the United States authorized by law to administer oaths or perform notarial acts. The certificate of such acknowledgment under the hand and official seal of such consular officer or secretary of legation shall be prima facie evidence of the execution of the instrument. (Mar. 4, 1909, c. 320, §43, 35 Stat. 1084.)

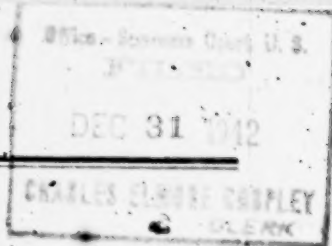
§44. SAME; RECORD. Every assignment of copyright shall be recorded in the copyright office within three calendar months after its execution in the United States or within six calendar months after its execution without the limits of the United States, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, whose assignment has been duly recorded. (Mar. 4, 1909, c. 320, §44, 35 Stat. 1084.)

§45. SAME; CERTIFICATE OF RECORD. The register of copyrights shall, upon payment of the prescribed fee, record such assignment, and shall return it to the sender with a certificate of record attached under seal of the copyright office, and upon the payment of the fee prescribed by this title he shall furnish to any person requesting the same a certified copy thereof under the said seal. (Mar. 4, 1909, c. 320, §45, 35 Stat. 1085.)

§46. SAME; USE OF NAME OF ASSIGNEE IN NOTICE. When an assignment of the copyright in a specified book or other work has been recorded the assignee may substitute his name for that of the assignor in the statutory notice of copyright prescribed by this title. (Mar. 4, 1909, c. 320, §46, 35 Stat. 1085.)



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IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942—NO. 327

FRED FISHER MUSIC CO. INC. and GEORGE
GRAFF, Jr.,

Petitioners,

against

M. WITMARK & SONS,

Respondent.

ON WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT

BRIEF FOR RESPONDENT

ROBERT W. PERKINS,
Solicitor for Respondent.

STUART H. AARONS,
SIDNEY BARROWS,
of Counsel.

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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1942—No. 327

FRED FISHER MUSIC CO. INC. and GEORGE GRAFF, JR.,
Petitioners,
against
M. WITMARK & SONS,
Respondent.

BRIEF FOR RESPONDENT

The Agreements

In both agreements the author assigned the original copyright and the renewal term. The 1910 agreement, made before the song was written, obligated the publisher to pay royalties, the rate being the same during the original and renewal terms (R. 26, 27).

Under the 1917 agreement, made after the song had been copyrighted and published for five years, the author for a lump sum released his royalties to the publisher, and appointed the publisher his attorney-in-fact to do all things necessary to secure the renewal copyright to the publisher (R. 31).

The Circuit Court of Appeals treated the action as one for specific performance (R. 84, 85). The order before the Court granted a preliminary injunction. The Court decided on two issues,—the validity of the agreements with respect to the renewal term and the adequacy of the con-

sideration for the 1917 agreement to support equitable relief. The adequacy of the consideration still remains for trial. Certiorari was sought only on the issue of the validity of the agreements.

The Issue

Does the Copyright Act make null and void all dealings by the author beyond the original term of copyright if entered into prior to the twenty-eighth year of the original term? Is it impossible before the last year of the original term to make a valid agreement disposing of any interest in the renewal term?

Summary of Argument

1.

The division of the copyright grant into an original and renewal term, with the right to the renewal term contingent upon survivorship, does not import any restriction on the right to alienate the renewal term while contingent. Insofar as assignments are covered in the Copyright Act of 1909, the implication is that all rights under copyright are assignable. There is nothing in Section 23 of the Act negating this. In the first proviso of this section the proprietor of the original term in the works covered is designated as the party entitled to the renewal term; in the second proviso covering other works, the author, if he be living, or his widow or children, if they be living, are designated as the parties entitled to the renewal term. This does not mean that such parties under either the first or second proviso cannot assign their right to the renewal term while it is contingent, and under the ordinary rules of law such right is assignable. No policy to the contrary is manifested in the statute.

2.

The report of the Congressional Committee dealing with Section 23 shows no such policy. The report was discussing the problems first, whether there should be a single term, or a double term, and, second, the length of term. It had been testified before the Committee that authors sometimes assigned their renewal term with the original term, and sometimes did not. The advantage to the author which led the Committee to recommend retaining the double term was to facilitate such transactions, and moreover, with the double term, an assignment of the copyright would pass only the original term, while with a single term, an assignment of the copyright would pass the entire interest. The report showed there was no intention to make the renewal term inalienable when it stated that the law should be framed as was the existing law, because all the authorities at that time agreed that under the existing law the contingent renewal term was assignable. All statutes, since the beginning of statutory copyright, were construed to permit the assignment of the contingent renewal term. The authorities give the same construction to the Act of 1909.

Argument

Introductory Statement

Petitioners present their case on the broad ground of the policy of the statute. They say that "Congress chose to treat the author as though he were the beneficiary of a spendthrift trust" (Brief, p. 36). They do not attack Respondent's rights on the common-law technicality that the renewal term cannot be assigned prior

to the last year of the original term because it does not come into existence until then. Their position would defeat all actions on agreements involving the contingent renewal term whether in law or in equity. So far as renewal rights are concerned, their position would invalidate not only the 1917 agreement, based upon a lump sum payment, but also the 1910 agreement, based upon the payment of royalties throughout the renewal as well as the original term. Until the twenty-eighth year of the original term, say Petitioners, only the original term can be disposed of, dealt in, or licensed, and if there are only a few years left in the original term, only those few years can be dealt in. They would taint with original sin all dealings in the renewal term prior to the twenty-eighth year of the first term (Brief, p: 37).

Petitioners' case rests on an alleged policy which they read into the Copyright Act to give to authors and their families an economic benefit in the twenty-eighth year of the original term "unfettered by prior commitments" (Brief, p. 12). We believe that an examination of the statute will show no such policy.

True, the exclusive right or monopoly granted by the Act is in two terms,—an original term and a renewal term, following the precedent of the Statute of Anne of 1709 (8 Anne, c. 19). The renewal term is not a present estate but is an expectancy or contingency depending upon the author's survivorship of the original term. In the Statute of Anne, and in our earliest statute, that of 1790 (1 Stat. 124), the author's right to the renewal was contingent on his surviving. If he did not survive, the monopoly of the copyright expired and his work went into the public domain. The Act of 1831 (4 Stat. 436) changed this only to the extent of providing that if the author did not

survive, his widow and children would have the renewal term. If they did not survive, the monopoly of the copyright expired and the work went into the public domain. This was continued in the Act of 1870 (16 Stat. 212), the Revised Statutes of 1873-1874 (Rev. Stat. §4948, *et seq.*) and the Act of 1891 (26 Stat. 1106). Finally, under the Act of 1909 (35 Stat. 1075), the same contingencies are provided with respect to the renewal term except that if the widow and children do not survive, the renewal term goes to the author's executors or, if there is no will, to his next of kin. If neither the author, widow, nor children survive, and there is no will nor next of kin, the monopoly of the copyright expires and the work goes into the public domain. Under this statutory scheme, the author, and the widow and children in their turn, have a contingent right in the renewal term. But that does not import any restriction on their right to assign what they have. Of course, if the author assigns the renewal term, but does not survive, the assignee, whose rights cannot be greater than the author's, will take nothing.

Petitioners argue that since copyright is the creature of statute, "the privileges extended and the persons to whom they are available must be determined by the provisions of the Copyright Law" (Brief, Point 1A). It is true that "copyright is the creature of the Federal statute passed in the exercise of the power vested in the Congress", *Fox Film Corp. v. Doyal*, 286 U. S. 123, 127, and that "the right of an author to a monopoly of his publications is measured and determined by the copyright act", *Holmes v. Hurst*, 174 U. S. 82, 85. But Petitioners cannot contend that all attributes of copyrighted property are found in the Copyright Act.

The Act creates the property but the ordinary principles of law determine those of its attributes not covered

by the Act. Thus a State may tax income derived wholly from copyrights, *Fox Film Corp. v. Doyal*, 286 U. S. 123; the ordinary principles of tenancy in common attach to copyrights, *Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909 (C.C.A. 2d, 1921); *Carter v. Bailey*, 64 Me. 458 (1874); copyrights and renewal copyrights may be held in express, and in constructive trust, *Bisel v. Ladner*, 1 F. (2d) 436 (C.C.A. 3d, 1924); *Southern Music Pub. Co. Inc. v. Bibbs Lang*, 10 F. Supp. 972, 974 (S. D. N. Y., 1935); *Sebring Pottery Co. v. Steubenville Pottery Co.*, 9 F. Supp. 383 (N. D. Ohio, 1934). The Copyright Act says nothing as to equitable title, tenancy in common, or income from copyrights, so the courts applied the principles governing other forms of property. Unless Petitioners can show that the Copyright Act, as a result of the words it uses or the policy it establishes, invalidates assignments of the renewal term prior to the twenty-eighth year of the original term, the ordinary rules as to the assignability of contingent interests will control. It is well settled that such interests are assignable. 4 Pomeroy, *A Treatise on Equity Jurisprudence* (1941) Sec. 1270 *et seq.* *In re Barnett*, 124 F. (2) 1005 (C.C.A. 2d, 1942); *Nugent v. Smith*, 202 App. Div. 279, 281, *affd.* 234 N. Y. 611 (1922).

POINT I

There is nothing in the Copyright Act of 1909 which restricts the alienation of the renewal term prior to the twenty-eighth year of the original term or which manifests any policy against such alienation.

No language restricting assignments of the contingent renewal term, or evidencing any policy against such assignments, we submit, can be found in the Copyright Act

of 1909. On the contrary, the statute indicates that all rights which it secures are assignable.

1. The provisions of the statute dealing with assignments indicate that the contingent renewal term is assignable.

Assignments are dealt with in Section 8 and Sections 41 to 46 of the statute:

The first part of Section 8 reads as follows:

"That the author or proprietor of any work made the subject of copyright by this Act, or his executors, administrators, *or assigns*, shall have copyright for such work under the conditions *and for the terms specified in this Act*; * * * (35 Stat. 1077). (Italics ours.)

The word "assigns" relates to the "author or proprietor" who "shall have copyright * * * for the terms specified in this Act". "Terms" is in the plural and includes both terms mentioned in Section 23. That section defines the original term by stating:

"That the copyright secured by this Act shall endure for twenty-eight years from the date of first publication, * * * (35 Stat. 1080)

It then defines the renewal term in two provisos. In each proviso the definition of renewal term is:

"a renewal and extension of the copyright in such work for the *further term* of twenty-eight years". (*ibid.*) (Italics ours.)

Obviously the "further term" representing the renewal in these provisos is included in the "terms" covered by Section 8 with its expressive use of the words "or as-

signs". There is no suggestion of any restriction on the assignability of the terms, whether original or renewal, vested or contingent, in being or in expectancy.

Sections 41 to 46, inclusive, deal with the assignment of copyrights in various phases*. Nowhere is there any restriction on alienation except, perhaps, Section 44 making "void" as against a subsequent purchaser for value any assignment not recorded within three months after its execution. If Congress intended to lay down restrictions on the assignment of renewal copyrights while contingent, the natural expectation would be to find apt words to that effect among these provisions.

2. The language of Section 23 does not restrict assignments of the contingent renewal term or evidence any policy against such assignments.

Petitioners rely upon Section 23 of the statute. This section in no way indicates that the renewal term cannot be assigned prior to the twenty-eighth year of the original term. The word "void" is missing from this section. Equally missing, we submit, is any policy against anticipatory assignments of the renewal term. This section reads as follows:

* Section 42 reads:

"That copyright secured under this or previous Acts of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will." (39 Stat. 1084.)

Petitioners seek to read the phrase "copyright secured" as covering renewal copyrights only after the author has "perfected" them (Brief, p. 17, footnote). Obviously no such limitation can be read into the phrase with respect to the original copyright, for it is freely assignable before it is taken out. *T. B. Harms v. Stern* (C.C.A. 2d, 1916), 231 Fed. 645; *Callaghan v. Myers*, 128 U. S. 617. The phrase is merely a comprehensive expression covering all interests in copyright and derives from the authority of Congress under the Constitution "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". (Italics ours.)

“That the copyright secured by this Act shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name:

Provided, That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright:

And provided further, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work when such contribution has been separately registered,* the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such

* The words “when such contribution has been separately registered” were deleted by the amendment of March 15, 1940, c. 57, 54 Stat. 51, 17 U. S. C. A. §33 (Supp. 1942).

work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright:

And provided further, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication." (35 Stat. 1080)

Petitioners argue that the specific designation in the second proviso of the author and his family as the parties entitled to the renewal term means that they cannot assign the renewal before they have obtained it (Brief, p. 15). No such meaning can be read into this language. The Constitution designates only "authors and inventors" as entitled to "the exclusive right to their respective writings and discoveries". But no one contends that authors and inventors are prevented by this language from assigning their rights before the copyright or the patent issues. Moreover, if the designation of the author and his family in the second proviso of Section 23 creates a restriction on alienation, it would apply to the renewal term after it was obtained as well as before, a result which Petitioners disclaim.

To bolster their argument, Petitioners point out that in the first proviso in Section 23 the "proprietor" is designated as the party entitled to the renewal, and they seek to contrast the designation of the "proprietor" with the designation of the author and his family in the second proviso (Brief, p. 15).

The first proviso creates the renewal term for four specific categories of works; the second proviso creates the renewal term for all other works. "The first proviso merely provides exceptions to the second." *Shapiro, Bernstein & Co., Inc. v. Bryan*, 123 F. (2d) 697, 699 (C.C.A. 2d, 1941).

The statutes prior to the Act of 1909 did not make any such exceptions, and all works fell within the provisions of what corresponded to the second proviso. The language used in the previous statutes was substantially the same as that used in the second proviso of the Act of 1909, designating the author and his family as entitled to the renewal, and making their rights contingent on survivorship. See Appendix p. 1 *et seq.* The introduction into the Act of 1909 of the exceptions of the first proviso would hardly be sufficient to change the meaning of the language in the second proviso, which under the previous statutes had been construed not to import any restrictions on the alienability of the renewal term. (Point III *infra*.)

Moreover, it is important to see what is meant by the word "proprietor" in the first proviso. Examination will show that the word is limited to the proprietor of the original copyright.

Section 23 begins:

"That the *copyright* secured by this Act shall endure for twenty-eight years from the date of first publication" (Italics ours.)

Immediately following is the first proviso, as follows:

"*Provided*, That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the *copyright* was origin-

ally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author)* or by an employer for whom such work is made for hire, the *proprietor of such copyright* shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright." (Italics ours.)

The only correct construction of the words "proprietor of such copyright" here is *proprietor of the original copyright, i.e., of the original term*. In a case involving the fourth category of the first proviso, namely, a work made for hire, the Second Circuit Court of Appeals gave such construction to the word "proprietor". Circuit Judge Learned Hand, speaking for the Court, said:

"The simple meaning of the words is that when the employer has become *the proprietor of the original copyright* because it was made by an employee 'for

* Petitioners make some point with respect to this parenthetical clause affecting corporate bodies. The language of the proviso here is as follows.

"That in the case * * * of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) * * * the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work. * * *"

The proviso is speaking of the corporate body as proprietor of the original copyright. Similarly the parenthetical clause refers to a corporate body which is the assignee of the original copyright. Obviously it was unnecessary to mention the author's survivorship in a case where only the original copyright has been assigned. Consequently there is no point to Petitioners' argument (Brief, p. 16) that survivorship of the individual author is not mentioned in the clause. But for the clause, a corporate assignee of the original copyright in a work by an individual author would be entitled to the renewal of the copyright. The parenthetical clause was necessary to prevent confusion with respect to works by an individual author which were assigned to corporations, and such works assigned to others than corporations.

hire, the right of renewal goes with it, unlike an assignment." (*Shapiro, Bernstein & Co., Inc. v. Bryan*, 123 F. (2) 697, 700 (C.C.A. 2nd, 1941).)

If instead of the proprietor of the original term the designation in the first proviso had been the proprietor of the renewal term, Petitioners might have gained some slight comfort from contrasting it with the designation of the author and his family in the second proviso. But the designation of the proprietor of the original term is another matter, and it in no way shows that the designation of the author and his family in the second proviso was intended to make it impossible for them to assign in advance the renewals to which they were "entitled". In both provisos the statute designates the party entitled to the renewal, but in neither proviso does it appear that he may not assign the right to which the statute "entitles" him.

The argument that the language of the second proviso makes the renewal term inalienable until the twenty-eighth year is exploded by comparing it with the language of the first proviso. Under the first proviso, *the proprietor of the original copyright* (say of a posthumous work or a work made for hire) :

"shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright".

In identical language, under the second proviso, the author of the work (say the song in litigation), if still living:

"shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright."

If the author of the song, because of this language, cannot assign or agree to assign the renewal term until he has made the application during the twenty-eighth year of the original term, then, *since the language is identical*, the proprietor of the original copyright of a work made for hire or of a posthumous work cannot assign or agree to assign the renewal term until he has made application during the twenty-eighth year. This would produce the curious result that the proprietor of a work made for hire who retained the original copyright could not agree to assign the renewal term to the author-employee, or any one else. Again the publisher of an author's posthumous writings who retained the original copyright, could not agree to assign the renewal term to the author's widow, or any one else. Obviously such agreements would contravene neither the language nor the policy of the statute. To support Petitioners' contention, it is necessary to read words into the statute which are not there, and to give opposing meanings to the same words in the same section.

* Except for the difference, without significance, that in the first proviso the definite article precedes the phrase "further term", while in the second proviso the indefinite article is used.

This analysis also disposes of the support which Petitioners seek to get from the language of the second proviso:

“when application for such renewal and extension shall have been made”,

which they say means that such application can be made only by the party designated as “entitled” to the renewal, i.e., the proprietor in the case of the first proviso, and the author and his family in the case of the second proviso (Brief, pp. 35-36). Since proprietor means, as we believe we have demonstrated, the proprietor of the original copyright, it is certainly carrying matters to an extreme to say that under the first proviso no one but that proprietor may make the application and that the assignee of the renewal may not. Similarly, under the second proviso, we do not admit, although Petitioners indicate that we do (Brief, p. 17), that only the author or his family can make the application for the renewal. Obviously the author would not have to make out the application personally, or to go with it to the Copyright Office. He could have someone act for him. Obviously also in the case of co-authorship, an application in the name of one author would preserve the renewal term for both authors, *Southern Music Pub. Co., Inc. v. Bibb-Lang* (S. D. N. Y. 1935), 10 F. Supp. 972, 974, or in the case of next of kin, an application in the name of one would preserve the renewal term for all. *Silverman v. Sunrise Pictures Corp.* (C.C.A. 2d, 1921), 273 Fed. 909, 914. Although as Petitioners state, the opinion of the Assistant Attorney General (28 Ops. Attys. Gen. 162, 170 (1910)), and *White-Smith v. Goff* (C.C.A. 1st, 1911), 187 Fed. 247, are that the renewal must be in the author's name, and the practice of the

Copyright Office is in conformity, we doubt that the statute insists upon this formality. The statute does not state who shall make the application, but merely, "when application shall have been made."

But even if the application must be made in the author's name,** we do not believe that the author must retain the beneficial, as well as the legal interest in the renewal term until after the application is made. In the cases just cited involving applications for renewals where there are co-authors or several next of kin, the legal title does not coincide with the equitable title.

Section 23 sets up the method of effecting renewals. Under the first proviso, where numerous authors might be involved, the right to the renewal is not contingent upon survivorship and the proprietor of the original term is designated as the party entitled to the renewal term. In the second proviso, where the right to the renewal

*Petitioners (Brief, pp. 30, 31) stress the wording of the Act of 1870 which, in requiring that a copy of the record of the renewal term be published, use the words, "such person" in stating who shall cause the record to be published. "Such person" here refers to "the author" if he be living. But the language in the Act of 1870 is of no substantive significance. Under the Act of 1831, to perfect the renewal it was necessary to publish notice in a newspaper. Section 3 of the 1831 Act provided that in all renewals of copyright

"Each author or proprietor shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more of the newspapers printed in the United States." (4 Stat. 437)

(Obviously this is recognition that under the Act of 1831 the proprietor of the renewal copyright was expressly authorized to cause the necessary publication to perfect the renewal term. Petitioners completely ignore this provision when they contend that under the Act of 1831 the renewal term is unassignable (Brief, p. 29). We do not believe that the language of the Act of 1870 has any more significance than the language of the Act of 1831, and we emphasize the fact that in the Act of 1909 no one is named as the party to make the application because the language is simply "when application . . . shall have been made".

** An administrative advantage of insisting that the application for the renewal under the second proviso should be in the name of the author would be to make sure that the author is living.

term is contingent upon survivorship, the particular individuals in the sequence named are designated as being entitled to the renewal term. In both cases the final determination of the rights in the renewal term is subject to any contract which may have been made by the parties designated by the statute as being entitled to the renewal term.

POINT II

The report of the Congressional Committee in dealing with Section 23 discussed the problems of a single term versus a double term and the duration of the copyright protection, and did not indicate that the contingent renewal term should be made inalienable. In recommending that "the law should be framed as is the existing law" the report negated any such intention.

Not finding sufficient support in the Copyright Act itself for their contention, Petitioners turn to the report accompanying the bill which became the Copyright Act. (H. R. Rep. No. 2222, 60th Cong., 2d Sess. (1909).) The report was that of the House Committee on Patents whose Chairman, Representative Currier, introduced the bill and report. The Senate Committee on Patents adopted the same report. (S. Rep. No. 1108, 60th Cong., 2d Sess. (1909).)

The report was a comprehensive one. It dealt with the philosophy of copyright, and gave a specific analysis of each section of the bill. With respect to the philosophy, the report said:

"In enacting a copyright law Congress must consider, as has been already stated, two questions:

First, how much will the legislation stimulate the producer and so benefit the public; and, second, how much will the monopoly granted be detrimental to the public? The granting of such exclusive rights, under the proper terms and conditions, confers a benefit upon the public that outweighs the evils of the temporary monopoly." (p. 7)

The report continued further on:

"Section 23 deals with the term of the copyright. Under existing law the copyright term is twenty-eight years, with the right of renewal by the author, or by the author's widow or children, if he be dead, for a further term of fourteen years. The act of 1790 provided for an original term of fourteen years, with the right of renewal for fourteen years. The act of 1831 extended the term to its present length. It was urged before the committee that it would be better to have a single term without any right of renewal; and a term of life and fifty years was suggested. Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right. —"

"The present term of twenty-eight years, with the right of renewal for fourteen years, in many cases is insufficient. The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period that there would be no probability of its being taken

away from him in his old age, when, perhaps, he needs it the most. A very small percentage of the copyrights are ever renewed. All use of them ceases in most cases long before the expiration of twenty-eight years. In the comparatively few cases where the work survives the original term the author ought to be given an adequate renewal term. In the exceptional case of a brilliant work of literature, art, or musical composition it continues to have a value for a long period; but this value is dependent upon the merit of the composition. Just in proportion as the composition is meritorious and deserving will it continue to be profitable, provided the copyright is extended so long; and it is believed that in all such cases where the merit is very high this term is certainly not too long.

"Your committee do not favor and the bill does not provide for any extension of the original term of twenty-eight years, but it does provide for an extension of the renewal term from fourteen years to twenty-eight years; and it makes some change in existing law as to those who may apply for the renewal. Instead of confining the right of renewal to the author, if still living, or to the widow or children of the author, if he be dead, we provide that the author of such work, if still living, may apply for the renewal, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or, in the absence of a will, his next of kin. It was not the intention to permit the administrator to apply for the renewal, but to permit the author who had no wife or children to bequeath by will the right to apply for the renewal." (pp. 14-15)

The Committee was here concerned chiefly with two problems,—first, should there be a single term, or an orig-

inal and a renewal term; and second, how long should the copyright protection endure. The Committee was dealing with these problems in the light of its desire to give "exclusive rights" which would "stimulate the producer and so benefit the public", but which would not create a "monopoly" . . . detrimental to the public".

1. The single term versus the double term.

The first paragraph quoted is devoted to the first problem,—a single or a double term. Petitioners rest much of their case on the following language in the first paragraph:

" . . . It was urged before the committee that it would be better to have a single term without any right of renewal, and a term of life and fifty years was suggested. Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right."

In thus arguing for the retention of the renewal term, we submit that the Committee had no thought of recommending that the renewal term be made inalienable.

When the Committee said, "It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum", the Committee was referring to the sale of the original copyright without

the renewal. Much of the fallacy in Petitioners' brief stems from their attempt to interpret this sentence as referring to the sale of the original and renewal copyright (Brief, p. 22). In thus misinterpreting the words of the Committee, Petitioners fall into a contradiction. In straining to find in the report an intent to make the renewal term inalienable, Petitioners give a construction to the report which would mean that the renewal term was "not infrequently" assigned under the then existing law. This of course runs squarely counter to a fundamental point in Petitioners' brief that under the then existing law assignments of the renewal term were void (Brief, p. 29 *et seq.*).

When the Committee said that it was "to the advantage of the author to preserve the renewal period", the Committee had in mind that authors frequently sold the original copyright without the renewal term. The courts and the textwriters had given much attention to the interpretation of assignments from authors to publishers to determine whether the language used in the assignments passed the original copyright only. The authorities held that it was a question of the intent of the parties as expressed in the assignment, and that an assignment of "the copyright" did not carry with it an assignment of the renewal term. *Pierpont v. Fawle* (1846), 19 Fed. Cas. 652; Morgan, *The Law of Literature*, Vol. II (1875), 228; Ellsworth, *Copy-Right Manual* (1862), 29. See these and other authorities discussed, *infra*, Point III, subd. 5.

Moreover, the Committee had in mind the testimony before it in hearings on certain bills introduced prior to the bill which became the Copyright Act of 1909. (Hearings before Committee on Patents on H. R. 19553, 59th Cong., 1st Sess. (June 6, 7, 8 and 9, 1906); id. 2d Sess.

(December 7, 8, 10 and 11, 1906); Hearings before Committee on Patents on *pending bills to amend and consolidate the acts respecting copyright*, 60th Cong., 1st Sess: (1908.) It learned from these hearings that sometimes authors assigned the renewal term with the copyright, and sometimes they did not. Thus, in the case of composite works*, it was testified that the authors usually assigned their renewal rights with the original copyright, although the witness pointed out the difficulties in the situation because the publisher would not secure the renewal under the assignment if the author did not survive. This testimony is as follows:

"Mr. Hale.† * * * These joint authors of composite works have always been treated by publishers as having the right of renewal, and those books have always been renewed by virtue of the right of the authors, the men who compiled them. That is the only way under the present law that a proprietor can get the renewal term. The contract covers it usually, but they get it from the author.

"Representative Currier. In the case of a composite work, does not the contract always cover the renewal period? Would you think anybody would employ a whole lot of authors to create a composite work and not, by contract, provide for the renewal period?

"Mr. Hale. But it is only possible to cover the right of renewal of the actual author. The right of renewal is contingent. It does not vest until the end. If he is alive at the time of renewal, then the original contract may pass it, but his widow or children or other persons entitled would not be bound by that contract." (Hearings (1908), p. 77.)

* It should be noted that under the statutes prior to the Act of 1909 there was no distinction between composite and other works.

† W. B. Hale, representing the American Law Book Company, wrote the article "*Copyright and Literary Property*" published in 13 *Corpus Juris* 936 (1917).

With respect to other classes of works, one witness testified that the assignment included the renewal term at times, but not often:

"Mr. Hinshaw (Representative). Are these contracts for royalty made to include a possible extension of the copyright?"

"Mr. Ogilvie (Witness). Not generally; because the author may be dead when the time for the renewal comes.

"Mr. Currier. But it can be renewed then by his widow.

"Mr. Ogilvie. But they do not do it generally.

"Mr. Currier. I should suppose that in almost all cases under *the existing law* they would get a renewal.

"Mr. Ogilvie. They do at times, but not often."
(Italics ours.) (Hearings (1906), 1st. Sess., p. 47.)

An interesting illustration was brought to the attention of the Joint Committee by Representative Currier himself:

"Representative Currier. Mr. Clemens told me that *he sold the copyright* for *Innocents Abroad* for a *very small sum*, and he got very little out of the *Innocents Abroad* until the twenty-eight-year period expired, and then *his contract did not cover the renewal period*, and in the fourteen years of the renewal period he was able to get out of it all of the profits." (Italics ours.) (Hearings (1908), p. 20.)

Later in the same day Mr. Currier remarked:

"Representative Currier. Representing the authors, then, do you not think it is in the interest of the authors to have a renewal period? If you were going to give a hundred years, would you not divide

that, giving one term, and then a renewal term? Do you not think it would be to the advantage of the authors, speaking solely for the authors, to (have) a renewal period?

"Mr. Johnson. I have never considered that as being a matter of any importance one way or the other.

"Representative Currier: As I said here to-day, when you, perhaps, were not present, Mr. Samuel Clemens told me he found it of very great importance to him; that *he sold the copyright of 'Innocents Abroad' for a very small sum*, and all he ever got out of it, practically, was the *renewal period*." (Italics ours.) (Hearings (1908), p. 62.)

The example of "Innocents Abroad" had great effect. In 1907 Chairman Currier and the Committee had sponsored a bill providing for a single term of life and thirty years (*infra*, p. 28). But here in 1908, Chairman Currier was asking the witness whether he did not

"think it would be *to the advantage of the authors, speaking solely for the authors, to (have) a renewal period*." (Italics ours.)

To prove his point Chairman Currier was telling the Committee that Samuel Clemens

"*sold the copyright for Innocents Abroad for a very small sum* * * * his contract did not cover the renewal period, and in the fourteen years of the renewal period he was able to get out of it all of the profits". (Italics ours.)

Substantially this same language was used in the report of Chairman Currier and the Committee in 1909 when the report said, reversing the stand taken in 1907,

"Your Committee, after full consideration, decided that it was distinctly *to the advantage of the author to preserve the renewal period*". (Italics ours.)

and when the report said,

"It not infrequently happens that the author *sells his copyright outright * * * for a comparatively small sum*". (Italics ours.)

It is apparent that Chairman Currier and the Committee had in mind "*Innocents Abroad*", and it was on the basis of that example that they rejected the single term they had previously sponsored and recommended the retention of the double term.

The distinct advantage to the author,* which the Committee saw in the retention of the double term was to make it easy for him, if he wished, to dispose of only the original copyright, and to keep for himself the renewal term. Moreover, if there were but one term, a sale of the copyright would pass the author's entire interest. But if there were two terms, a sale of the copyright would pass only the original term. The Committee had these considerations in mind and not the entirely different proposition that the renewal term should be made inalienable.

No author, and no one of the numerous representatives of authors who appeared before the Committee, made any suggestion that the renewal term should be made inalienable. Only one person, a lawyer, who stated that he was merely a private citizen, not representing

* Copyright being indivisible (*Goldwyn Pictures Corporation v. Howells Sales Co.*, 282 Fed. 9, (C.C.A. 2nd, 1922); *M. Witmark & Sons v. Pastime Amusement Co.*, 298 Fed. 470, 474 (D.C.S.C. 1924) *affd.*, 2 F. (2d) 1029 (C.C.A. 4th, 1924)), if there were but a single term, technical difficulties would confront an author who wished to dispose of the first portion of the term and to retain the remaining portion. Moreover, as the report indicates in the next paragraph, the public obtains an advantage from the double term because many copyrighted works, which are not renewed, fall into the public domain at the end of the original term.

any interest, brought up the question. He suggested that there should be, in addition to the original term, two renewal terms, and in discussing the question whether if this were done, publishers would not contract with authors for both renewal terms, he said:

"Mr. Jenner. It is never done, and I have some doubt about whether it legally could be done. But I should be glad to see that so provided for that it could not be done under the law.

"Representative Law. Then put it in the bill itself.

"Mr. Jenner. Put it in the bill itself, and say that it cannot be done, so that the author is certain to have that extension as a provision for his age or a provision for his widow and his children. (Applause.)" (Hearings (1908), p. 128.)

That Mr. Jenner's "doubt" as to the legality of an assignment of a renewal term under the law then existing was entirely unjustified is shown, we believe, in Point III, subd. 5 of this brief. And if he meant to refer to the assignments of renewal terms under the existing law when he said "it is never done," he not only is contrary to Witnesses Hale and Ogilvie and the remarks of Chairman Currier, and to all the authorities, but he belies all reason for his suggestion that the renewal terms should be made inalienable.

But Mr. Jenner's suggestion, which related to an entirely different bill, was not followed. If the Committee had intended to make the renewal term inalienable, it would have "put it in the bill itself", and have said "that it cannot be done." But instead the Committee stated that the law should be framed "as is the existing law". The Committee knew that under the existing law anticipatory assignments of renewal terms were made, and as

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we believe we demonstrate later, the existing law was clear that there were no restrictions against such assignments:

2. Exclusive right.

Petitioners also rely upon the words "exclusive right" in the clause in the first paragraph of the report dealing with Section 23. This clause reads:

"your committee felt that it should be the exclusive right of the author to take the renewal term. * * *

There is no significance in the phrase "exclusive right". All the author's rights are exclusive. The phrase comes from the Constitution and the statutes creating copyright. It is used to show that the rights secured to authors are not "non-exclusive". The Committee report in the paragraph immediately following makes similar use of the phrase when it says:

"The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period * * *"

An exclusive right is a right to exclude others acting without the owner's permission and is not at all a right which can be exercised only by the owner.

3. Duration of the term.

The first paragraph of the report dealing with Section 23 rejected a single term for the life of the author and fifty years in favor of a double term. The second paragraph turns to the question of duration. It was concerned that the author should receive protection throughout his life. It states that the then existing term of twenty-eight years, with the right of renewal for fourteen years, was

in many cases insufficient, and that the terms, taken together, ought to be long enough to give the author the exclusive right to his work

"for such a period that there would be no probability of its being taken away from him in his old age, when, perhaps, he needs it the most." (Italics ours.)

The dissenting opinion below finds in this language an intent to make the renewal term inalienable (R. pp. 92, 93). But if such had been the Committee's intent, it would not have used the word "probability" in this clause. Properly read in its context, this clause is solely concerned with the length of the terms. What the Committee meant was "taken away from him" by expiration, not by assignment. Substantially the same language was used in a report submitted by the same Congressman, Representative Currier, in a preceding session of Congress, when he and his Committee were recommending a single term consisting of life and thirty years. That report reads in part as follows:

"Your committee believe that it is better to have a single term without any right of renewal, and that that term should certainly cover the lifetime of the author. If an author is entitled to any protection on his work, that should not be taken away from him in his old age, when perhaps he needs it most." (Italics ours.) (H. R. Rep. No. 7083, 59th Cong., 2nd Sess., January 30, 1907, p. 13.)

This language, used to support a proposal for a single term, measured by the life of the author, related solely to the duration of copyright. It had no relation to any restriction on the author's right to deal in his property. The substantially identical language used by the same

Congressman in his later report on the 1909 bill similarly related solely to the duration of the term and had no reference to any restriction.

4. "The law should be framed as is the existing law."

The Committee report makes constant reference to existing law, pointing out the instances in which the bill changes the existing law, and those in which the existing law is retained. At the beginning of the discussion of Section 23 the report says:

"Under existing law the copyright term is twenty-eight years, with the right of renewal by the author, or by the author's widow or children, if he be dead, for a further term of fourteen years. The act of 1790 provided for an original term of fourteen years, with the right of renewal for fourteen years. The act of 1831 extended the term to its present length."

Later on in this discussion, the Committee points out that the bill

"makes some change in existing law as to those who may apply for the renewal".

For our purposes, the vital reference to "existing law" is in the very sentence so heavily relied upon by Petitioners, where the report says:

"If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right

* The report states that in the bill it followed existing law in Sections 1a, 4, 6, 8—"first part", 23, 25(a), 25(b) first and second subds., 31(a), (b), (c), 31(d) second subd., 33, 34, 37, 38, 40, 41 and 47. It states it changed existing law in the following Sections: 9, 12, 13, 14, 20, 21, 23 as to who may apply for renewal, 25(b), 28, 31d. first and third subsecs. and subd. fourth, 36, 39, 50, 61. It designated as new provisions the following Sections: 1b, c, d, e, 2, 8 the "previso", 25b. third subd., 25(c), (d), 32, 35 and 49.

of the author to take the renewal term, and *the law should be framed as is the existing law*, so that he could not be deprived of that right." (Italics ours.)

The Committee made the statement that "the law should be framed as is the existing law" in the light of the testimony at the hearings which was inconsistent with any restrictions in law on the alienation of the renewal term. Presumably the Committee also made the statement in the light of the authorities which were unanimous at that time that under the existing law the contingent renewal term was alienable.

POINT III

From the beginning of statutory copyright there was no restriction on the alienability of the renewal term, and this was the "existing law" at the passage of the Act of 1909.

A brief historical survey of copyright legislation shows that from the beginning of statutory copyright the division of the copyright grant into two terms, an original term and a contingent renewal term, was never accompanied with a restriction on the alienation of the contingent renewal term.

1. Statute of Anne, 1709.

Statutory copyright began with the Statute of Anne in 1709. (8 Anne c. 19). *Holmes v. Hurst*, 174 U. S. 82, 85. *MacGillivray, The Law of Copyright* (1902), 4. That

statute created the pattern of two terms of copyright, an original term and a renewal term contingent upon the author's survivorship. The author was given an original term of fourteen years and a renewal term of an additional fourteen years, expressed as follows:

... * * that the author of any book or books already composed, and not printed and published, or that shall hereafter be composed, and his assignee or assigns, shall have the sole liberty of printing and reprinting such book and books for the term of fourteen years, to commence from the day of the first publishing the same, and no longer;

"Provided always, That after the expiration of the said term of fourteen years, the sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years." (8 Anne c. 19). (Italics ours.)

The renewal term was contingent on survival by the author, but the author's right to alienate it at any time was in no way restricted.

It was expressly held that under the Statute of Anne the contingent right of renewal was assignable, and if the author survived the original term, he was bound by his assignment. *Carnan v. Bowles*, 2 Bro. C. C. 80, 29 English Reports (Full Reprint) 45 (1786). In that case the author of a book sold it to the plaintiff-publisher. After the fourteen year term of the original copyright, the author attempted to sell the rights in the book to the defendant, a competing publisher. The plaintiff, claiming the renewal rights, moved for an injunction to restrain the defendant from publishing the book. The defendant, anticipating by a century and a half Petitioners' points

in the case at bar, argued that the renewal term was designed to protect authors against their own acts, and that the Statute gave the renewal to "the authors" but not to their assigns. Defendant argued:

"• • • The expression in the act meant to secure something to authors, *even against their own acts*. It gives the right to authors and their assigns during the first fourteen years, and no longer, and then, by the proviso, the right shall *return to the authors* (not their assigns), if living; so that it is a *personal bounty to the authors only*. In selling the right, the author sells all that is in him, not the contingent right that may return to him." (Italics partly ours.) (2 Bro. C. C. 82.)

In reply, the plaintiff argued:

"With respect to the author's second term, he has an absolute and a contingent right; they are both capable of being disposed of. The counsel on the other side have stated nothing in the act to make a difference between them. The *return* is only between the public and the author, not between him and his assignee. There are no negative words in the act to prevent his assigning that, as well as his other rights. In many cases, if he could not assign it, the disability would be productive of great inconvenience." (2 Bro. C. C. 83.)

Lord Chancellor Thurlow held for the plaintiff and said:

"With respect to the first point, it strikes me that the contingent interest must pass by the word *interest* in the grant. • • • It must, I think, be considered as conveying his whole right." (2 Bro. C. C. 83-84.)

Maugham, in his work on *Laws of Literary Property* (1828); after discussing this case, thus states the rule under the Statute of Anne:

"If an author who has assigned his right, outlive the first fourteen years, * * * his assignee, by the general assignment, will have the benefit of the resulting term, fourteen years, * * * (p. 73.)

The right to assign the renewal term at any time under the Statute of Anne was recognized by Lord Chancellor Eldon in *Rundell v. Murray*, Jacob Reports 310 (1821), 37 English Reports (Full Reprint), page 868.

2. Resolution of the Continental Congress of 1783 and early state statutes.

The Continental Congress on May 2, 1783, passed a resolution recommending copyright legislation by the separate states. This resolution retained the pattern fixed by the Statute of Anne of an original term of fourteen years with a renewal term of an additional fourteen years contingent on the author's survival. The resolution was as follows:

"RESOLVED, That it be recommended to the several states, to secure to the authors or publishers of any new books not hitherto printed, being citizens of the United States, and to their executors, administrators and assigns, the copyright of such books for a certain time not less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, and to their executors, administrators and assigns, the copyright of such books for another term of time not less than fourteen years, such copy or exclusive right of printing, publishing and vending the same, to be secured to the original

authors, or publishers, their executors, administrators and assigns, by such laws and under restrictions as to the several states may seem proper." (Journals of Congress, May 2, 1783.)

Some states had already enacted such legislation. All of the remaining states, except Delaware, thereupon passed statutes as suggested by the Continental Congress. Noah Webster, *A Collection of Papers* (1843), 173; Solberg, *Copyright Enactments of the United States* (1906), 11 *et seq.*

3. Copyright Act of 1790.

The adoption of the Constitution conferred upon Congress the function of legislating upon copyright. Congress acted promptly and the first federal copyright statute was passed on May 31, 1790. That statute also followed the model of the Statute of Anne. Weil, *American Copyright Law* (1917), 18; Drone, *A Treatise on the Law of Property in Intellectual Productions* (1879), 1. It gave an original term of fourteen years, and a renewal term of an additional fourteen years, contingent upon the author's survival. It read:

"... the author and authors of any book or books, being a citizen or citizens of these United States, or resident therein, and his or their executors, administrators or assigns, shall have the sole right and liberty of printing, reprinting, publishing and vending such book, for the like term of fourteen years from the time of recording the title thereof in the clerk's office as aforesaid. And if, at the expiration of the said term, the author or authors, or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his

or their executors, administrators or assigns, for the further term of fourteen years: *Provided*, he or they shall cause the title thereof to be a second time recorded and published in the same manner as is herein after directed, and that within six months before the expiration of the first term of fourteen years aforesaid." (1 Stat. 124.)

This statute was enacted by Congress after the decision in *Carnan v. Bowles*, *supra*, that the Statute of Anne put no restrictions upon the alienation by the author of his contingent renewal right. The Act of 1790 contained certain formal words with respect to the renewal term which Petitioners contend differentiate it from other acts. These words do not appear in the Statute of Anne, nor in the Act of 1831. Their effect will be discussed in connection with the Act of 1831 immediately following.

4. Copyright Act of 1831.

In 1831 a new copyright act was passed. Again the model of the Statute of Anne and the 1790 Act was followed. The 1831 Act read:

"That . . . the author or authors of any book or books, . . . and the executors, administrators, or legal assigns of such person or persons, shall have the sole right and liberty of printing, reprinting, publishing, and vending such book or books, . . . for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

"Sec. 2. *And be it further enacted*, That if, at the expiration of the aforesaid term of years, such author, . . . be still living, . . . or being dead, shall have left a widow, or child, or children,

either or all then living, the same exclusive right shall be continued to such author, . . . or, if dead, then to such widow and child, or children, for the further term of fourteen years: *Provided*, That the title of the work so secured shall be a second time recorded, and all such other regulations as are herein required in regard to original copyrights, be complied with in respect to such renewed copyright, and that within six months before the expiration of the first term." (4 Stat. 436.)

Here again were the two terms of copyright, the original term, and a renewal term contingent upon survival. The original term was increased from fourteen to twenty-eight years. The renewal term was kept at fourteen years, and its contingent nature was retained. However, under the previous legislation there was no renewal copyright unless the author survived the original term, and if he did not survive, the work went into the public domain. Under the Act of 1831 if the author did not survive the original term and his widow or children did, the work did not go into the public domain but the renewal copyright accrued to them. There was no change in the assignability of the renewal term. Of course, if the author assigned the renewal term, but did not survive the original term, his assignee would take nothing because by the language of the statute the author would take nothing unless he survived. In this respect, the Act of 1831 was just the same as the Act of 1790. But if the author survived, there is nothing in either statute indicating that the assignee could not hold the author to his assignment, or agreement to assign.

Petitioners, however, contend that the Act of 1831 made a change in the law as to the assignability of the renewal term. They point out that the renewal provision

of the Act omits the formal words of assignability contained in such provision of the Act of 1790. The language in the Act of 1831 is

“if, at the expiration of the aforesaid term of years, such author, * * * be still living, * * * the same exclusive right shall be continued to such author, * * * for the further term of fourteen years:”

In the Statute of Anne the original term was given to the “author * * * and his assignee or assigns”; but the renewal term was given to the author without any mention of the word “assigns”. In the Act of 1790 the original term was given to the “author * * *, and his * * * executors, administrators, or assigns” and the renewal term was given to the author “his * * * executors, administrators or assigns.” In the Act of 1831 the original term was given to the “author * * * and the executors, administrators, or legal assigns” and the renewal term was given to the author without any mention of assigns. Under all three statutes, the renewal term was construed to be assignable while contingent. The inclusion of the formal word “assigns” in the provisions respecting the renewal term, or its omission, is without significance unless, perhaps, as is said in the opinion of the majority below, the omission in the Act of 1831 was to make it clear that the rights of the widow and children, there created for the first time, were superior to the rights of the assignee holding an anticipatory assignment from the author, if the author did not survive (R. 78).

Petitioners’ argument defeats itself. No one would contend that the omission of the formal words of assignability from the statute would restrict the author from

assigning the renewal term after it has vested. But their omission has no more significance with respect to the assignment of the renewal term before vesting than after vesting.*

That Congress, in enacting the Copyright Act of 1831, had no intention of changing the law by restricting the alienation of the renewal right but was concerned with other things, appears from the report of the Judiciary Committee of the House of Representatives sponsoring the legislation. The bill which became the Act of 1831 was drafted by Representative Ellsworth who introduced it in the House, together with the report (Noah Webster, *A Collection of Papers* (1843), 177). The purpose of the bill was stated in the report as follows:

"It has been the aim of your committee in preparing the accompanying bill, . . . chiefly to enlarge the period for the enjoyment of copy-right, and thereby to place authors in this country more nearly upon an equality with authors in other countries.

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"In the United States, by the existing laws, a copy-right is secured to the author, in the first instance, for fourteen years; and if, at the end of that period, he be living, then for fourteen years more, but, if he be not then living, the copy-right is determined, although, by the very event of the death of the author, his family stand in more need of the only means of subsistence ordinarily left to them.

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* Of course, in so far as Petitioners might argue that the word "assigns" does not appear in Section 23 of the Act of 1909 with respect to the author's right of renewal, they are confronted by the provisions of Section 8 of that Act.

"This bill secures to the author a copy-right for twenty-eight years, in the first instance, with a right of renewal for fourteen more, if, at the end of the first period, the author be living, or shall leave a family. It is believed that the provisions of the bill are not too liberal, and that Congress ought not to do less than is proposed. Even this is less than is done in any one of the European States referred to." (Register of Debates in Congress, Vol. VII, Appendix CXIX-CXX)

The dissenting opinion below makes much of a sentence which appears in this report in connection with the discussion of the duration of the copyright (R. pp. 91, 92). The report here reads:

"Your committee do not perceive any reason for denying to authors the protection of the law, to the extent proposed. There is no serious danger of a monopoly. The question is, whether the author or the bookseller shall reap the reward. It is for the interest of the author to supply the market upon such terms as will ensure the greatest sale; and he will always do this."

Obviously the Committee was here concerned with the chief problem of the legislation, the extension of the original term of the monopoly from fourteen to twenty-eight years. The language:

"The question is, whether the author or the bookseller shall reap the reward:"

had nothing at all to do with alienation. It merely stated the problem of how long the copyright protection should be and shows the position of the author after the copyright expired and the work fell into the public domain.

At that point booksellers would be able to exploit the work without any obligation to pay royalties to the author. As the context clearly shows, the Committee was not discussing the question whether the author could assign the renewal term to a bookseller. In fact it was not discussing the renewal term at all but merely the enlargement of the original term from fourteen to twenty-eight years.

A similar commentary on the problem of duration of the copyright monopoly was made in a report accompanying a copyright bill introduced in the Senate in 1907. That report says:

"That the *duration of the term* is a question not so much between the author and the reading public (who get his book at the outset and do not get it any more completely after than during the term) as between the author with his one publisher who pays him something for his work and the other publishers who may wish to publish it without paying him anything." (Italics ours.) (S. Rep. No. 6187, 59th Cong., 2d Sess. (1907), 8.)

5. The authorities under the Copyright Act of 1831 and subsequent statutes, constituting the "existing law" at the passage of the 1909 Act, were unanimous that there was no restriction on the alienability of the renewal term.

Proof that nothing in the Act of 1831 restricted or was intended to restrict the alienation of the renewal term is found in the writings of Representative Ellsworth, who was the author of the Act. In 1862, after he retired from the Supreme Court of Errors of Connecticut, he wrote "Copy-Right Manual" in which he said, page 29:

"After renewal, the renewed term of the copy-right has all the qualities of property in the person or persons obtaining the renewal, as fully as the first

term had in the author or proprietor who obtained that term. Before the renewal takes effect, there is nothing but a possibility in the persons or person who shall live to renew; which possibility, perhaps, is not capable of being alienated as property, unless, possibly, by the author himself, he being the owner of the manuscript; but if a sale cannot in law be made at that time, *those who are anticipating this possible interest may bind themselves, by covenant, that whatever interest they may live to acquire, shall become the proper estate of the person so purchasing,—which covenant will be enforced in a court of equity.* (Italics ours.)

“We may here dispose of a question sometimes made between authors and those who hold under them by purchase of the copyright. Does a sale of the copyright carry with it a right to *renew* at the expiration of the existing copyright, or is the effect of the sale to be confined to the first term of the book? This must depend upon a fair and just interpretation of the agreement between the parties. It *may* certainly be included and enforced in equity, but it need not be included. This possibility certainly may be contracted for in purchasing the copyright, but it is not so of necessity, nor of course, nor *prima facie*. The mere sale of a copyright already obtained would not seem to embrace anything more than the copyright mentioned in the sale. That satisfies the terms of the sale, and courts are not inclined to a forced construction, on this delicate point, when it could easily have been made clear and certain, if more than the existing copyright was intended. Lord Eldon said, in *Burr v. Murray*, *Jacobs R.* 315: ‘I conceive that an author will not be taken to have assigned his contingent right in case of his surviving the fourteen years, unless the assignment is so expressed as to purport to pass it.’” (Italics the authors.)

Ellsworth was only one of the numerous authorities holding that under the Act of 1831 the renewal term was assignable before it took effect. The question came up in *Pierpont v. Fowle* (C. C. Mass., 1846), 19 Fed. Cas. 652. Although the Court held that the language of the particular instrument did not convey the renewal term, it recognized that if the author expressed his intention clearly, the renewal term would pass. The Court said:

"In the next place, it is the author and not the assignee, to whom the extension of the right is *eo nomine* given, by the statute of Anne, as well as the acts of congress. Jeremy, Eq. Jur. p. 318. By that, 'the sole right shall return to the author for fourteen years more, if then living.' So by 54 Geo. III., after the enlarged term of twenty-eight years is conferred on an author or his assigns, it is he alone on whom fourteen years more is conferred, if he be then living. *Id.* So here the copyright is in the act of 1790 and 1831, given to the author alone, and to others, only, who purchase it from him. By construction, then, we should not extend it beyond the words and design of the statute, made to benefit authors, *unless it seems to be actually meant by the author to be transferred forever, and including any future contingency, and a clear and adequate consideration paid for the extended term.* See *Wilson v. Rousseau*, 4 How. (45 U. S.) 677, opinion of minority; and *Washburn v. Gould* (Case No. 17,214); *Woodworth v. Sherman* (*Id.* 18,019)." (19 Fed. Cas. 659.) (Italics *ours.*)

The Supreme Court, in *Paige v. Banks*, 13 Wall. 608, specifically held, we submit, that the contingent right of renewal under the Act of 1831 was assignable. Petitioners contend in their brief, page 44, that the Copyright Act of 1790 was controlling in this case. We disagree.

The facts appear clearly in the decision of Judge Blatchford, in the trial court, 18 Fed. Cas. 1001.

In 1821 Paige, a law reporter, agreed to furnish reports of the Chancery Court in New York to his publishers. The publishers agreed to pay \$1,000 for every volume published. Paige delivered a particular volume to his publishers, who copyrighted it in 1830. Thus it is true that the work was copyrighted under the Act of 1790, which created an original term of fourteen years, with a right of renewal, contingent upon the author's survivorship, of fourteen additional years. However, the Act of 1831, passed one year after this copyright was taken out, by Section 16 extended the original term of then subsisting copyrights to twenty-eight years, and in addition gave a renewal term of fourteen years contingent on survivorship. The original term of the copyright, thus lengthened by the Act of 1831, expired in 1858. The litigation was over the fourteen-year renewal period which began in 1858 and which was granted by Section 16 of the Act of 1831.

The Court below thus expressed the issue:

"It is claimed that Mr. Paige, by proper steps taken, renewed the copyright of such first volume under the act of 1831, for his own benefit, for the term of fourteen years from the 5th of January, 1858, and that the assignors to the defendants, by like proper steps, renewed such copyright under said act, for their own benefit, for the same term." (18 Fed. Cas. 1002.) (Italics ours.)

The Court held that Paige's agreement had transferred the renewal term to the publishers.

In the Supreme Court, appellant attempted to distinguish the Act of 1831 from the Act of 1790 by pointing

out the omission of the formal words "executors, administrators or assigns" from the renewal provisions, saying:

"The act of 1831 which created this new term (the renewal term), gives it specifically to the author if living, to *his family*, if he is dead. *Assignees are not mentioned in it, nor provided for.*" 13 Wall. 612. (Italics partly ours.)

The Supreme Court, however, affirmed the decision of the trial court and held that Paige's agreement passed the entire interest in his work, including the renewal term.

The text writers were unanimous that the Act of 1831 imposed no restrictions on the alienability of the renewal term. We have already quoted from Ellsworth. Similarly, George Ticknor Curtis, whose "Treatise on the Law of Copyright", published in 1847, became standard, says:

"In like manner, the question may arise, whether a general assignment of copyright, by the author, will deprive his representatives of the additional term of fourteen years, given by the act of congress of 3d February, 1831, Sec. 2; or whether the author himself has any power over this additional term, so far as the interests of his representatives are concerned: The statute provides that the author, if living at the expiration of the first term of twenty-eight years, shall have a further term of fourteen years, on making a new entry for that purpose. *This contingent interest the author may undoubtedly assign.* But if the author is not living at the end of the first term, the additional term vests in his widow and child, or children, living at the time. It is not easy to see how the author can dispose of this interest. It is not created for him, but for his family; it vests only in case of his death, and the policy of the statute, it seems to me, has removed it from his control." (p. 235) (Italics ours.)

The Copyright Act of 1870 (16 Stat. 212) made no change in the law with respect to the renewal term.* The authorities writing after the passage of this Act were unanimous that the contingent renewal term was assignable.

2 Kent's Commentaries (12th Ed. by Holmes, 1873), at page 510, clearly indicates that the assignment by the author of his renewal term is effective if he survives the original term.

Morgan in *The Law of Literature* (1875), in Vol. 2 at page 229 states:

"The assignment of a 'copyright', in general terms, will be referred to what was in existence at the date of the assignment, and not to any future contingency; and it will in no case be construed to operate as an assignment of a second and future renewal or term, unless the author so expressly state it, or unless it seems so actually to be meant by the author, beyond a reasonable doubt; as when the contract of assignment, or sale uses language looking beyond the existing copyright; such as referring to 'all the 'interest' in the matter, or to the 'manuscript' thereof, or some term in itself more expressive than 'copyright'."

Spalding in *The Law of Copyright* (1878), at page 111, states:

"An assignee alone cannot take out a second or extended term unless he has clearly and unequivocally contracted and paid for it, and is entitled to be protected in it in equity rather than according to any mere technical rule of law".**

* No change was made in the renewal term in the Revised Statutes of 1873-4 (Rev. Stat. §4948 ff.) or in the Act of 1891 (26 Stat. 1106).

** This book contains contract forms some of which limit the rights granted to the original copyright and some of which include the renewal term (pp. 37, 38, 40).

Drone in *A Treatise on The Law of Property in Intellectual Productions* (1879), at page 326, states:

"It is reasonably clear that the copyright for the additional term will vest only in the author, if he be living. But there appears to be no reason why he may not divest himself of the right thus reserved for him, either by parting absolutely with his entire interest in a work, or by an agreement to convey the copyright for the additional term when it shall be secured. In the former case, he has no interest in the work, and cannot rightly claim the additional privilege guaranteed to him by the statute. In the latter case, he is bound by his agreement to transfer to another the right when it shall be secured to him".

Bowker on Copyright (1886), at page 20, states:

"An assignee cannot obtain a renewal, although an author may contract with the assignee to take out and to convey to him the benefit of a renewal; he may also contract not to renew, and so bar his own right".

and on page 34, he states:

"The relations between author and publisher are simply those between principal and agent, or, where an author sells 'outright', between buyer and seller. The 'outright' price of a book is purely a matter of bargain, and no general rule applies. The author may reserve the 'renewal' for his own benefit, or contract to renew as part of the original bargain".

4 American and English Encyclopaedia of Law (1888), at page 161, note 1, states:

"An assignment of an existing copyright for twenty-eight years does not include an assignment

of the renewal of the copyright for the additional term of fourteen years, unless specially expressed. *Pierpont v. Fowle*, 2 Woodb. & M. 41; *Cowen v. Banks*, 24 How. Pr. (N. Y.) 72.

"It will be different where the assignment of the manuscript has been made before any copyright was taken out. In such a case an absolute right to the renewal will vest in the assignee. *Pulte v. Derby*, 5 McLean (U. S.), 328; *Paige v. Banks*, 7 Blatchf. (U. S.) 152; 13 Wall. (U. S.) 608.

9. Cye. (1903), at page 933, states:

"as has been previously stated; the right to renew for the additional term provided by statute is in the author, his widow, or children. Whether an assignment by an author, either before or after publication, will be construed to convey his whole interest or only his interest for the first term, will depend upon the terms of the contract".

Thorvald Solberg, Register of Copyrights, was very active in the movement for revision of the copyright law which resulted in the Act of 1909. He was present at all the Committee hearings. In an address published in 1904 entitled "Copyright Protection and Statutory Formalities", at page 24, Mr. Solberg states:

"The language of the statute would seem to give to the author an inchoate right which reverts to his widow or children, should he have married and have died before the expiration of the first term of the copyright. *This contingent interest the author may undoubtedly assign; and if he is living during the six months' term when action to secure the renewal right must be taken, the author presumably is then under obligation to the assignee to take such steps to comply with the statutory formalities as will make the right good.* * * * (Italics ours.)

With this array of authorities and none *contra*, the Committee must have known that under the "existing law" the contingent renewal term was assignable. We have already cited the testimony of witnesses before the Committee that the renewal term was at times sold with the original copyright. The Committee's statement that "the law should be framed as is the existing law" was utterly inconsistent with any intention to make the renewal term inalienable prior to the twenty-eighth year.

POINT IV

The authorities under the Act of 1909 are that there is no restriction on alienability of the renewal term.

1. Text writers and cases.

The authorities declare that under the Copyright Act of 1909 an author surviving the twenty-eighth year of the original copyright is bound by his agreement to assign the renewal term made prior to the twenty-eighth year.

A year after the Copyright Act was passed, Assistant Attorney General Fowler gave an official opinion in which he discussed this question in the light of the Committee report. His opinion made it clear that the right of renewal could be contracted away by the author prior to the twenty-eighth year. The opinion reads:

"When the application for renewal is presented to the register of copyrights, the only thing left for his consideration is whether the applicant is one of the persons designated in the statute. But who may possess the legal or equitable right in the copyright after renewal is another question, and one which is to be determined by the terms of such contract as the author or other person or persons

entitled to the renewal may have entered into *before* or after the renewal is had." (28 Ops. Attys. Gen. 162, 166 (1910).) (Italics ours.)

Then after quoting from the report of the Committee, the opinion reads:

"It readily appears how the right of renewal may be a valuable asset to an author, though he may have previously parted with all interest in the copyrighted work. When renewed, like all other copyrights, it is assignable. (Sec. 42 of act; Drone on Copyrights, 3337. And no doubt it may be the subject of a valid contract *before* renewal, which would carry the equitable, if not the legal, title thereto when renewed." (id. at 169.) (Italics ours.)

The following textbooks are to the effect that the contingent renewal term may be assigned or made the subject of an agreement to assign:

Bowker—"Copyright, Its History and Its Law" (1912), pages 117, 435, 438;

Weil—"American Copyright Law" (1917), page 365 *et seq.*;

Frohlich & Schwartz—"The Law of Motion Pictures" (1918), page 549;

DeWolf—"An Outline of Copyright Law" (1925), page 66;

Marchetti—"Law of the Stage, Screen and Radio" (1936), page 67;

Wittenberg—"The Protection and Marketing of Literary Property" (1937), page 45;

2 Ladas—"International Protection of Literary and Artistic Property" (1938), page 773;

Corpus Juris Secundum (1939), vol. 18, par. 79, page 203;

Howell—"The Copyright Law" (1942), page 108.

There is a strong dictum to this effect in *Tobani v. Carl Fisher, Inc.* (C.C.A. 2d, 1938), 98 Fed. (2d) 57, 60 (cert. denied 305 U. S. 650).

Petitioners bear down hard on the language of Judge Putnam in *White-Smith Music Pub. Co. v. Goff* (C.C.A. 1st, 1911), 187 Fed. 247. In that case, a publisher agreed to pay a lump sum for each musical composition furnished by an author over a period of years, in return for "the exclusive right and title" thereto. One of the compositions was published and copyrighted in the publisher's name. Thirty-three years later, during the twenty-eighth year of the original copyright, the publisher, under Section 24 of the Act of 1909, attempted to register the renewal copyright in its name. As the opinion states (187 Fed. 247):

"Whether at this time the author was living does not appear".

The registration was refused. The defendants, making "no claim under any copyright" (*ibid.*), published the song after the expiration of the original term, and the publisher brought suit for infringement. The court held for the defendants.

With the holding of this case, we do not disagree. If the author did not survive, the publisher assignee would take nothing. Moreover, the agreement with the author did not mention the renewal term, and the lower court held (180 Fed. 256, 260) that the publisher had no rights except as proprietor of the original copyright.

The court, however, indicated that the author's renewal right could not be transferred prior to the twenty-eighth year. The court was led to this erroneous conclusion primarily because of its misinterpretation of the Act of

1831. We have demonstrated, we believe, that under that Act there was no restraint upon dealings in the renewal term.

2. Congressional interpretation of the Act of 1909.

Many bills introduced into Congress since the passage of the Copyright Act of 1909 indicate that the Act should be interpreted as authorizing the anticipatory assignment of the renewal term. One of such bills, S. 3047, 74th Cong., 1st Sess., passed the Senate on August 7, 1935. There were nine other bills with similar provisions,—H. R. 8557, 74th Cong., 1st Sess. (1935); H. R. 10632, 74th Cong., 2nd Sess. (1936); H. R. 5275, 75th Cong., 1st Sess. (1937); S. 2240, 75th Cong., 1st Sess. (1937); H. R. 926, 76th Cong., 1st Sess. (1939); H. R. 4871, 76th Cong., 1st Sess. (1939); H. R. 6160, 76th Cong., 1st Sess. (1939); H. R. 9703, 76th Cong., 3d Sess. (1940), and H. R. 3997, 77th Cong., 1st Sess. (1941). These bills were drafted as amendments to various sections of the Copyright Act of 1909. The bills proposed to amend Section 23 by combining the two twenty-eight year terms into a single term of fifty-six years.* The bills also proposed to amend Section 24 by providing that the copyright subsisting in any work when the section as amended should take effect would

* In all of these bills (except S. 3047, 74th Cong. 1st Sess.; H. R. 8557, 74th Cong., 1st Sess.) there was a specific proviso "that no assignment of the copyright and no grant of any interest therein made by the author shall be operative to vest in the assignee or grantee any rights with respect to the copyright in the work beyond the expiration of twenty-eight years from the date of copyright, and the reversionary interest in the copyright expectant at the termination of that period shall, notwithstanding any agreement to the contrary, devolve on the author of such work if living, or the widow, widower, or children of the author if the author be not living, * * * and any agreement entered into by the author as to the disposition of such reversionary interest shall be null and void". This proviso, dealing with copyright which might be taken out after the effective date of the proposed amendment, shows the language Congress will use when it desires to restrict alienation of interests in copyright.

be continued until the expiration of fifty-six years from the date of the beginning of the original copyright. Then comes the provision of importance here. In all of the ten bills above mentioned, the amended Section 24 was to read as follows:

"If, on the date when this section, as amended, takes effect, *less than twenty-eight years have elapsed since the copyright began*, then the copyright for the period of such continuation beyond twenty-eight years shall vest, * * * in the person or persons living on said date, * * * who would have been entitled to the renewal term under this Act prior to the date when ~~this~~ section, as amended, takes effect, *subject to any agreement, valid in law or equity, which may have been made for the disposal of the renewal term prior to the date when this section, as amended, takes effect* * * *".
(~~Italics~~ ours.)

These bills, one of which passed the Senate, specifically recognized that the Copyright Act of 1909 permitted agreements disposing of the renewal term prior to the twenty-eighth year of the original term.

Another bill, H. R. 12549, 71st Cong., 2nd Sess. (1930), provided for a single term for the life of the author and fifty years. With respect to copyrights subsisting upon the effective date of the proposed bill, the term was to be extended to include the life of the author and fifty years. If with respect to such subsisting copyrights an application for renewal had not been registered under the Act of 1909, and if the author

"shall have parted with any or all of the author's rights for the first term under the Act heretofore in force, and shall have agreed to part therewith or shall have parted therewith for the renewal term under said Act, on a royalty basis" (§14)

then the assignee of such rights would be entitled to the additional period granted by the bill upon the payment of the same royalties. In the case of an outright purchase, the assignee would only get the added term if he reached an agreement with the author, or if a court fixed the conditions of such agreement. This is a clear recognition that under the Act of 1909 the author, prior to the application for the registration of the renewal of copyright, could dispose of the renewal term.

Three other bills are of like import: S. 176, 72nd Cong., 1st Sess. (1931); H. R. 6990, 71st Cong., 2nd Sess. (1929) and H. R. 10434, 69th Cong., 1st Sess. (1926).

Two other bills specifically recognize that in the case of a copyright subsisting under the Copyright Act of 1909, the author could have "agreed to renew the copyright for the renewal term for the benefit of the assignee or licensee". H. R. 10976, 72nd Cong., 1st Sess. (1932); H. R. 11948, 72nd Cong., 1st Sess. (1932).

In none of the many bills involving copyright introduced into Congress since the Act of 1909 have we been able to find any intimation that the right of renewal under that Act is at any time inalienable.

POINT V

During the period when the patent law provided for a renewal or extension of the patent upon the fulfillment of certain conditions, it was held that the patentee could assign the renewal or extended term while it was contingent.

Petitioners spend much effort to prove that it is not necessary to find in a statute express words of prohibition to strike down an agreement contrary to the policy of the

statute. They cite cases arising under such laws as the National Labor Relations Act and the federal statutes regulating national banks and cases dealing with such matters as homesteads and mechanics' liens (Brief, pp. 18, 40 to 43). In these cases the agreement held void contravened a public policy created by the statute. We agree with the elementary principle on which these cases stand, but it is not applicable to the case at bar.

If analogies are desired, there is none closer to copy-rights than patents. Both are monopolies created by statute by authority of the same constitutional clause. Although there has been no provision for a renewal term for patents since the Patent Act of 1872, there was a contingent renewal term granted under the 1836 Patent Act, and the question of whether or not it was assignable during the original term of the patent came before the courts. This question was determined, in the absence of specific provisions in the statute, by the ordinary rules governing assignability of contingent rights.

Under the 1836 Patent Act (5 Stat. 117), an initial term of fourteen years was granted to the patentee with the right to an extended or renewal term of seven years. The renewal term was conditioned upon proof before a statutory commission that the patentee, without fault on his part, had failed to obtain a reasonable remuneration from the patent. If the condition was fulfilled the patent would be renewed for a further term of seven years. This contingent right of renewal was held assignable.

In *Clum v. Breiver*, 5 Fed. Cases 1097 (Circuit Court, Mass., 1855), the court had before it the question of whether a deed by Samuel F. B. Morse bargaining and selling his invention in the electric telegraph transferred the right to the extended term of the patent. At the time

of the deed the patent had not been issued and of course an extension of the patent had not been issued. Judge Curtis, in construing the deed to pass the title to the extended term when issued, said:

"But the inventor has not only an inchoate right to obtain letters patent securing to him the exclusive right to his invention for the term of fourteen years, but also a further inchoate right to have the term extended, provided he shall fail, without fault, to obtain a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into public use. Though it has not been expressly determined that this last right is the subject of a contract of sale, I conceive there can be no reasonable doubt that it is so. The reasoning of the court in *Wilson v. Rousseau*, 4 How. (45 U. S.) 646, assumes and indeed asserts that it is so. And there is nothing in the nature or incidents of such a right, to distinguish it as a subject of sale, from the inchoate right to obtain the original patent. Each appertains to the inventor by reason of his invention. Each is incomplete, and its completion depends upon the compliance by the inventor with conditions, and the performance by public officers of certain acts, prescribed by law. It is true, the title of an inventor to an extension is still further qualified by a further condition, of his failure to obtain remuneration from the enjoyment of the exclusive right, for the first term of fourteen years. But though this is an additional condition, which may render parties less willing to contract, its existence does not change the nature of the right, and it no more prevents it from being the subject of a contract of sale, than any other condition which is attached to it." (5 Fed. Cas. 1102.)

The same doctrine was applied in *Nicholson Pavement Co. v. Jenkins*, 14 Wall. 452, and *Heudrie v. Sayles*, 8 Otto (98 U. S.) 546. In the latter case an assignment covered the inventor's right, title and interest "in and to said invention and patent and any extension thereof that may hereafter be granted." (8 Otto (98 U. S.) 549-550). Thereafter application was made for a renewal and extension of the patent and the application was granted. The controversy between the parties was whether the assignment passed title to the extended term of the patent. The court reviewed the authorities including *Clum v. Brewer*, *supra*; it also relied on *Carman v. Bowles*, *supra*, which dealt with assignments of contingent renewals of copyright. The court said:

"it is equally clear that they may sell, assign or convey the invention, including the inchoate right to obtain the patent, and to surrender and re-issue it or to procure a renewal or extension of the monopoly from the Commissioner; if the instrument of assignment contains apt words to show that such was the intent of the grantor." (p. 551)

The dissenting opinion below in the case at bar attempts to throw off the effect of these authorities by intimating that the Patent Act of 1836 made express provision for the assignment of the contingent renewal term (R. 119), quoting from the Act as follows:

"And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein"

But this provision refers only to "assignees and grantees of the right to use the thing patented," and in

Wilson v. Rousseau, 4 How. (45 U. S.) 646, was specifically held not to refer to assignees and grantees of the renewal.

POINT VI

The practical considerations are against the interpretation that there are restrictions on the alienability of the renewal term.

1. The problem of determining when the restrictions cease.

Although Petitioners strike broadly at all attempts by the author to make anticipatory assignments of his renewal term, they, of course, admit that the renewal term after it has vested can be assigned. But nowhere in their brief do they make it clear just when the right to assign attaches. Can the author assign at any time after the twenty-eighth year has begun? Can he assign only after "application * * * shall have been made to the copyright office"? Can he assign only after such application has been "duly registered"? If Petitioners' theory should be upheld, there will still remain much uncertainty, unless it is determined when the restrictions on alienation cease.

2. Advantages to the author and his family from the right to deal in the contingent renewal term.

Petitioners argue that because the author's right in the renewal term prior to the twenty-eighth year is contingent on his survivorship, its value is necessarily speculative, and the statute intended to forbid all dealings in the contingent right in order to protect the author.

Petitioners thus say that since in this respect authors have little, that little which they have they may not dispose of. The Copyright Act has no general policy against dealing in works on a speculative basis. No one can fix the value of a book or song before it is written, yet it is clear that an author is held to a bargain transferring the rights in a work which he has yet to create. *Harms, et al. v. Stern* (C.C.A. 2d, 1916), 231 Fed. 645.

The speculative element surrounding transactions involving renewal rights has not prevented purchasers from paying substantial sums for them. The author, his wife and children were paid for their contingent renewal rights in *Selwyn & Co., Inc. v. Veiller* (S.D.N.Y., 1942), 43 F. Supp. 491. In another case, the author's wife received five thousand dollars for her contingent rights, even though, as events turned out, she predeceased her husband. *Tobani v. Fischer, Inc.*, 263 App. Div. 503 (2nd Dept., 1942), *aff'd*, N. Y. Court of Appeals, Dec. 3, 1942. The present practice of Respondent, when a songwriter is in need of money, is to make advances against royalties to accrue and to take an assignment of the contingent renewal copyright as security for the advance (R. 58). In these transactions the author or his wife is passing to the purchaser the risk of survivorship. If the author is forbidden to deal in the contingent renewal term, then the risk must remain with the author because if he does not survive, he takes nothing.

Many transactions involving the contingent renewal term, such as the 1910 agreement in the case at bar, eliminate this speculative element. There is no more speculation in a royalty agreement covering the original and renewal term than there is in one covering the original term alone, except that fifty-six years are involved and not twenty-eight.

3. Difficulty in marketing the work toward the end of the original term.

If renewal rights are made unassignable prior to the twenty-eighth year, then, as the original term approaches expiration, only the few remaining years of that term can be disposed of or licensed. For instance, near the end of the original term a motion picture producer could not afford to buy a license to make a motion picture of a story because the limited term which he could acquire would not justify the investment necessary for the production of the picture. It is true that even on our interpretation the acquisition of the renewal term involves the risk of the author's survivorship, but there is always such risk in purchasing property in which there are contingent estates. Our interpretation tends towards the preservation of the right to deal in copyrighted works, and unlike Petitioners' contention, does not take such property off the market toward the end of the original term.

4. Upsetting transactions entered into in good faith.

The renewal term has been considered assignable after, as well as before, the passage of the 1909 Act, and, unquestionably, many transactions have taken place on this basis. See for example forms of contract covering book publishing rights and motion picture rights in Wittenberg, "The Protection and Marketing of Literary Property", 195, 261 (1937). If Petitioners are successful, many now exercising in good faith rights in a renewal term would become copyright infringers retroactively since the renewal term began.

5. The problem of licenses.

Many, if not most, transactions under the Copyright Act take the form of licenses rather than assignments. Suppose the author for a consideration agrees, prior to the last year of the original term, to grant a license under the renewal term. If the author survives, of course he would be entitled to the renewal term, and the application for it would be made in his name. Even under Petitioners' interpretation there is no language in the Act which is not completely complied with. But Petitioners cannot admit the validity of the agreement to license, or of an agreement to take out the renewal and assign it, because the admission would destroy the broad policy which Petitioners seek to find in the Act.

CONCLUSION

The order of the Circuit Court of Appeals affirming the order of the District Court granting a preliminary injunction should be affirmed in so far as it is based on the holding that the Copyright Act does not invalidate an assignment of the renewal term made prior to the twenty-eighth year of the original term.

Respectfully submitted,

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SIDNEY BARROWS,
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APPENDIX

Act of 8 Anne c. 19 (1709)

WHEREAS, *Printers, booksellers, and other persons have of late frequently taken the liberty of printing, reprinting, and publishing, or causing to be printed, reprinted, and published, books and other writings, without the consent of the authors or proprietors of such books and writings, to their very great detriment, and too often to the ruin of them and their families: for preventing therefore such practices for the future, and for the encouragement of learned men to compose and write useful books; may it please your Majesty, that it may be enacted, and be it enacted by the Queen's most Excellent majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present parliament assembled, and by the authority of the same, That from and after the tenth day of April, one thousand seven hundred and ten, the author of any book or books already printed, who hath not transferred to any other the copy or copies of such book or books, share or shares thereof, or the bookseller or booksellers, printer or printers, or other person or persons, who hath or have purchased or acquired the copy or copies of any book or books, in order to print or reprint the same, shall have the sole right and liberty of printing such book and books for the term of one and twenty years, to commence from the said tenth day of April, and no longer; and that the author of any book or books already composed, and not printed and published, or that shall hereafter be composed, and his assignee or assigns, shall have the sole liberty of printing and reprinting such book and books for the term of fourteen years, to commence from the day of the first publishing the same, and no longer;*

.

XI. Provided always, that after the expiration of the said term of fourteen years, the sole right of printing or

disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years.

Resolution of May 2, 1783 of the Continental Congress

Resolved, That it be recommended to the several states, to secure to the authors or publishers of any new books not hitherto printed, being citizens of the United States, and to their executors, administrators and assigns, the copyright of such books for a certain time not less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, and to their executors, administrators and assigns, the copyright of such books for another term of time not less than fourteen years, such copy or exclusive right of printing, publishing and vending the same, to be secured to the original authors, or publishers, their executors, administrators and assigns, by such laws and under restrictions to the several states may seem proper. (Journal of Congress, May 2, 1783.)

Act of May 31, 1790

Section 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That from and after the passing of this act, the author and authors of any map, chart, book or books already printed within these United States, being a citizen or citizens thereof, or resident within the same, his or their executors, administrators or assigns, who hath or have not transferred to any other person the copyright of such map, chart, book or books, share or shares thereof; and any other person or persons, being a citizen or citizens of these United States, or residents therein, his or their executors, administrators or assigns, who hath or have purchased or legally acquired the copyright of any such map, chart, book or books, in order to print, reprint, publish or vend the same, shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the term of fourteen

years from the recording the title thereof in the clerk's office, as herein after directed: And that the author and authors of any map, chart, book or books already made and composed and not printed or published, or that shall hereafter be made and composed, being a citizen or citizens of these United States, or resident therein, and his or their executors, administrators or assigns; shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the like term of fourteen years from the time of recording the title thereof in the clerk's office as aforesaid. And if, at the expiration of the said term, the author or authors, or any of them, ~~be living,~~ and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years: *Provided*, he or they shall cause the title thereof to be a second time recorded and published in the same manner as is herein after directed, and that within six months before the expiration of the first term of fourteen years aforesaid.

Sec. 3. *And be it further enacted*, That no person shall be entitled to the benefit of this act, in cases where any map, chart, book or books, hath or have been already printed and published, unless he shall first deposit, and in all other cases, unless he shall before publication deposit a printed copy of the title of such map, chart, book or books, in the clerk's office of the district court where the author or proprietor shall reside; * * * And such author or proprietor shall, within two months from the date thereof, cause a copy of the said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks. (1 Stat. 124 (1790)§)

Act of February 3, 1831

Be it enacted by the Senate and House of Representatives of the United States of America, in Congress assembled, That from and after the passing of this act, any

person or persons, being a citizen or citizens of the United States, or resident therein, who shall be the author or authors of any book or books, map, chart, or musical composition, which may be now made or composed, and not printed and published, or shall hereafter be made or composed, or who shall invent, design, etch, engrave, work, or cause to be engraved, etched, or worked from his own design, any print or engraving, and the executors, administrators, or legal assigns of such person or persons, shall have the sole right and liberty of printing, reprinting, publishing, and vending such book or books, map, chart, musical composition, print, cut, or engraving, in whole or in part, for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

Sec. 2. *And be it further enacted*, That if, at the expiration of the aforesaid term of years, such author, inventor, designer, engraver, or any of them, where the work had been originally composed and made by more than one person, be still living, and a citizen or citizens of the United States, or resident therein, or being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to such author, designer, or engraver, or, if dead, then to such widow and child, or children, for the further term of fourteen years: *Provided*, That the title of the work so secured shall be a second time recorded, and all such other regulations as are herein required in regard to original copyrights, be complied with in respect to such renewed copyright, and that within six months before the expiration of the first term.

• Sec. 3. *And be it further enacted*, That in all cases of renewal of copyright under this act, such author or proprietor shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more of the newspapers printed in the United States, for the space of four weeks.

Sec. 4. *And be it further enacted*, That no person shall be entitled to the benefit of this act, unless he shall, before publication, deposit a printed copy of the title of such book, or books, map, chart, musical composition, print, cut, or engraving, in the clerk's office of the district court of the district wherein the author or proprietor shall reside, * * * And the author or proprietor of any such book, map, chart, musical composition, print, cut, or engraving, shall, within three months from the publication of said book, map, chart, musical composition, print, cut, or engraving, deliver or cause to be delivered a copy of the same to the clerk of said district. * * *

Sec. 5. *And be it further enacted*, That no person shall be entitled to the benefit of this act, unless he shall give information of copyright being secured, by causing to be inserted, in the several copies of each and every edition published during the term secured on the title-page, or the page immediately following, if it be a book, or, if a map, chart, musical composition, print, cut, or engraving, by causing to be impressed on the face thereof, or if a volume of maps, charts, music, or engravings, upon the title or frontispiece thereof, the following words, viz: "Entered according to act of Congress, in the year , by A.B., in the clerk's office of the district court of , " (as the case may be.)

* * *

Sec. 16. *And be it further enacted*, That, whenever a copyright has been heretofore obtained by an author or authors, inventor, designer, or engraver, of any book, map, chart, print, cut, or engraving, or by a proprietor of the same: if such author or authors, or either of them, such inventor, designer, or engraver, be living at the passage of this act, then such author or authors, or the survivor of them, such inventor, engraver, or designer, shall continue to have the same exclusive right to his book, chart, map, print, cut, or engraving, with the benefit of each and all the provisions of this act, for the security

thereof, for such additional period of time as will, together with the time which shall have elapsed from the first entry of such copyright, make up the term of twenty-eight years, with the same right to his widow, child, or children, to renew the copyright, at the expiration thereof, as is above provided in relation to copyrights originally secured under this act. And if such author or authors, inventor, designer, or engraver, shall not be living at the passage of this act, then, his or their heirs, executors and administrators, shall be entitled to the like exclusive enjoyment of said copyright, with the benefit of each and all the provisions of this act for the security thereof, for the period of twenty-eight years from the first entry of said copyright; with the like privilege of renewal to the widow, child, or children, of author or authors, designer, inventor, or engraver, as is provided in relation to copyrights originally secured under this act; *Provided*, That this act shall not extend to any copyright heretofore secured, the term of which has already expired. (4 Stat. 436 (1831).)

Act of July 8, 1870

SEC. 86. *And be it further enacted*, That any citizen of the United States, or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and his executors, administrators, or assigns, shall, upon complying with the provisions of this act, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others; and authors may reserve the right to dramatize or to translate their own works. (16 Stat. 212.)

SEC. 87. *And be it further enacted*, That copyrights shall be granted for the term of twenty-eight years from

the time of recording the title thereof, in the manner hereinafter directed.

SEC. 88. *And be it further enacted*, That the author, inventor, or designer, if he be still living and a citizen of the United States or resident therein, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term. And such person shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers, printed in the United States, for the space of four weeks.

SEC. 89. *And be it further enacted*, That copyrights shall be assignable in law, by any instrument of writing, and such assignment shall be recorded in the office of the librarian of Congress within sixty days after its execution, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.

Relevant Sections of the Copyright Act of 1909 As Amended

§8. That the author or proprietor of any work made the subject of copyright by this Act, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and for the terms specified in this Act . . . (35 Stat. 1077.)

§23. That the copyright secured by this Act shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided*, That in the case of any posthumous work or of any ~~periodical~~ encyclopedic, or other composite work upon which the copyright was originally secured by the

proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright; *And provided further*, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright; *And provided further*, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication. (54 Stat. 51.)

§41. That the copyright is distinct from the property in the material object copyrighted, and the sale or conveyance, by gift or otherwise, of the material object shall not of itself constitute a transfer of the copyright, nor shall the assignment of the copyright constitute a transfer of the title to the material object; but nothing in this Act shall be deemed to forbid, prevent, or restrict the transfer of any copy of a copyrighted work the possession of which has been lawfully obtained. (35 Stat. 1084.)

§42. That copyright secured under this or previous Acts of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will. (35 Stat. 1084.)

§43. That every assignment of copyright executed in a foreign country shall be acknowledged by the assignor before a consular officer or secretary of legation of the United States authorized by law to administer oaths or perform notarial acts. The certificate of such acknowledgment under the hand and official seal of such consular officer or secretary of legation shall be prima facie evidence of the execution of the instrument. (35 Stat. 1084.)

§44. That every assignment of copyright shall be recorded in the copyright office within three calendar months after its execution in the United States or within six calendar months after its execution without the limits of the United States, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, whose assignment has been duly recorded. (35 Stat. 1084.)

§45. That the register of copyrights shall, upon payment of the prescribed fee, record such assignment, and shall return it to the sender with a certificate of record attached under seal of the copyright office, and upon the payment of the fee prescribed by this Act he shall furnish to any person requesting the same a certified copy thereof under the said seal. (35 Stat. 1085.)

§46. That when an assignment of the copyright in a specified book or other work has been recorded the assignee may substitute his name for that of the assignor in the statutory notice of copyright prescribed by this Act. (35 Stat. 1085.)

SUPREME COURT OF THE UNITED STATES.

No. 327.—OCTOBER TERM, 1942.

Fred Fisher Music Co., Inc., and George Graff, Jr., Petitioners. vs. M. Witmark & Sons.	} On Writ of Certiorari to the United States Circuit Court of Appeals for the Second Circuit.
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[April 5, 1943.]

Mr. Justice FRANKFURTER delivered the opinion of the Court.

This case presents a question never settled before, even though it concerns legislation having a history of more than two hundred years. The question itself can be stated very simply. Under § 23 of the Copyright Act of 1909, 35 Stat. 1075, as amended,¹ a copyright in a musical composition lasts for twenty-eight years from the date of its first publication, and the author can renew the copyright, if he is still living, for a further term of twenty-eight years by filing an application for renewal within a year

¹ The relevant provisions of the Copyright Act read as follows:

SEC. 23. That the copyright secured by this Act shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided*, That in the case of any posthumous work or of any periodical, cyclopaedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made, for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further*, That in the case of any copyrighted work, including a contribution by an individual author to a periodical or to a cyclopaedic or other composite work, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further*, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication.

SEC. 42. That copyright secured under this or previous Acts of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will.

before the expiration of the first twenty-eight year period. Section 42 of the Act provides that a copyright "may be assigned by an instrument in writing signed by the proprietor of the copyright." Concededly, the author can assign the original copyright and, after he has secured it, the renewal copyright as well. The question is—does the Act prevent the author from assigning his interest in the renewal copyright before he has secured it?

This litigation arises from a controversy over the renewal rights in the popular song "When Irish Eyes Are Smiling". It was written in 1912 by Ernest R. Ball, Chauncey Olcott, and George Graff, Jr., each of whom was under contract to a firm of music publishers, M. Witmark & Sons. Pursuant to the contracts Witmark on August 12, 1912, applied for and obtained the copyright in the song. On May 19, 1917, Graff and Witmark made a further agreement under which, for the sum of \$1600, Graff assigned to Witmark "all rights, title and interest" in a number of songs, including "When Irish Eyes Are Smiling". The contract provided for the conveyance of "all copyrights and renewals of copyrights and the right to secure all copyrights and renewals of copyrights in the [songs], and any and all rights therein that I [Graff], or my heirs, executors, administrators or next of kin may at any time be entitled to". To that end Witmark was given an irrevocable power of attorney to execute in Graff's name all documents "necessary to secure to [Witmark] the renewals and extensions of the copyrights in said compositions and all rights therein for the terms of such renewals and extensions". In addition, Graff agreed that, "upon the expiration of the first term of any copyright", he would execute and deliver to Witmark "all papers necessary in order to secure to it the renewals and extensions of all copyrights in said compositions and all rights therein for the terms of such renewals and extensions". This agreement was duly recorded in the Copyright Office.

On August 12, 1939, the first day of the twenty-eighth year of the copyright in "When Irish Eyes Are Smiling", Witmark applied for and registered the renewal copyright in Graff's name.²

² Ball and Olcott were no longer living at the time, and under § 23 of the Act their interests in the renewal passed to their widows. Witmark is also the assignee of Mrs. Olcott's interest in the renewal copyright, and Mrs. Ball has assigned her interest to another music publisher. The validity of neither assignment is involved in this suit.

On the same day, exercising its power of attorney under the agreement of May 19, 1917, Witmark also assigned to itself Graff's interest in the renewal. Eleven days later Graff himself applied for and registered the renewal copyright in his own name, and on October 24, 1939, he assigned his renewal interest to another music publishing firm, Fred Fisher Music Co., Inc. Both Graff and Fisher knew of the prior registration of the renewal by Witmark and of the latter's assignment to itself. Relying upon the validity of the assignment made to it on October 24, 1939, and without obtaining permission from Witmark, Fisher published and sold copies of "When Irish Eyes Are Smiling", representing to the trade that it owned the renewal rights in the song. Witmark thereupon brought this suit to enjoin these activities. The District Court granted a preliminary injunction *pendente lite* solely upon the ground that there was no statutory bar against an author's assignment of his interest in the renewal before it was secured. The court considered no evidence and made no findings upon the question whether equitable relief should be denied on other grounds, such as inadequacy of consideration and the like.³ Upon appeal to the Circuit Court of Appeals for the Second Circuit under § 129 of the Judicial Code, 28 U. S. C. § 227, permitting appeals from interlocutory decrees, the order was affirmed. 125 F. 2d 949. The Circuit Court of Appeals limited itself, as did the parties before it, to the question of statutory construction, wholly apart from the particular circumstances of the case. The court expressly left open "other contentions which the parties may wish and be entitled to raise on the merits, including possibly claims of inadequacy of consideration". 125 F. 2d at 954. The petition for certiorari in this Court stated that the "sole question is whether . . . an agreement to assign his renewal, made by an author in advance of the twenty-eighth year of the original term of copyright, is valid and enforceable". Because of the obvious importance of this question of the proper construction of the Copyright Act, we brought the case here. 317 U. S. —

Plainly, there is only one question before us—does the Copyright Act nullify an agreement by an author, made during the original copyright term, to assign his renewal? The explicit words of the

³ In opposing the motion for a preliminary injunction Graff submitted an affidavit stating he "was in desperate financial straits" when he entered into the agreement of May 19, 1917. The district court made no findings upon and did not otherwise deal with the issue that this allegation may raise.

statute give the author an unqualified right to renew the copyright. No limitations are placed upon the assignability of his interest in the renewal. If we look only to what the Act says, there can be no doubt as to the answer. But each of the parties finds support for its conclusion in the historical background of copyright legislation, and to that we must turn to discover whether Congress meant more than it said.

Anglo-American copyright legislation begins in 1709 with the Statute of 8 Anne, c. 19. That act gave the author and his assigns the exclusive copyright for fourteen years from publication, and after the expiration of such term, if the author was still living, the copyright could be renewed for another fourteen years. The statute did not expressly provide that the author could assign his renewal interest during the original copyright term. But the English courts held that the author's right of renewal, although contingent upon his surviving the original fourteen-year period, could be assigned, and that if he did survive the original term he was bound by the assignment. *Carnan v. Bowles*, 2 Bro. C. C. 80; *Rundell v. Murray*, Jac. 311; see Maugham, *Law of Literary Property* (1828) 73; Curtis on Copyright (1847) 235. Subsequent English legislation eliminated the problem by providing for one continuous term of copyright. In 1814 the statute was amended to provide that the author and his assigns should have the copyright for twenty-eight years, "and also, if the author shall be living at the end of that period, for the residue of his natural life". 54 Geo. III, c. 156. In 1842 the copyright term was extended to forty-two years or the life of the author and seven years, whichever should prove longer. 5 & 6 Viet., c. 45; see Macgillivray, *Law of Copyright* (1902) 56-57. The English law today, with minor qualifications not relevant here, gives the author and his assigns the exclusive copyright for the life of the author and fifty years after his death. Copyright Act of 1911, 1 & 2 Geo. V, c. 34; see Oldfield, *Law of Copyright* (1912) 60-66; Robertson, *Law of Copyright* (1912) 44-50; Copinger, *Law of Copyright* (7th ed. 1936) 78-86.

In this country the copyright laws enacted by the original thirteen states prior to 1789 were based largely upon the Statute of Anne. In 1783 the Continental Congress passed a resolution calling upon the states to adopt copyright legislation for the protection of authors and publishers. The resolution recommended that copyright be given to authors and publishers "for a certain time, not

less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, and to their executors, administrators and assigns, the copyright of such books for another term of time not less than fourteen years". *Journals of the Continental Congress, 1774-1789* (1922), vol. xxiv, pp. 326-27. When the resolution was adopted, laws governing copyrights were on the statute-books of at least three states, Connecticut, Massachusetts, and Maryland. The Connecticut and Maryland statutes substantially followed the Statute of Anne: in both states copyright was granted for a term of fourteen years, renewable for another term of the same length if the author survived the original term. Connecticut, *Acts & Laws* (Green, 1783) 617-19; Maryland, *Laws* (Green, 1783) c. 34. The Maryland statute employed the phraseology of the Statute of Anne, providing simply that the privilege of renewal belonged to the author. The Connecticut statute, however, explicitly incorporated the construction made by the English courts, and conferred the right of renewal upon the author and "his heirs and assigns". The Massachusetts statute created a single copyright term of twenty-one years. *Massachusetts, Acts & Laws* (Edes, 1783) 236.

In response to the resolution of the Congress, nine of the ~~ten~~ other states enacted copyright legislation. Only Delaware did not adopt a copyright statute. Five states accepted the recommendation of the Congress and followed the Statute of Anne: two copyright terms of fourteen years, the second term contingent upon the author's surviving the first. New Jersey, *Acts of the General Assembly* (Collins, 1783) c. 21; Pennsylvania, *Laws* (Bradford, 1784) c. 125; South Carolina, *Acts, Ordinances and Resolves* (Miller, 1784) 49-51; Candler, *Colonial Records of Georgia* (1911), vol. xix, part 2, pp. 485-89; *Laws of New York*, 1786, c. 54. Four of these, like the earlier Connecticut statute, explicitly provided that the right of renewal could be exercised by the author's heirs and assigns, namely, New Jersey, Pennsylvania, Georgia, and New York. The four remaining states enacted statutes providing for single terms of varying lengths, ranging from fourteen to twenty-one years. New Hampshire, *Laws* (Mekher, 1789) 161-62; Rhode Island, *Acts and Resolves* (Carter, 1783) 6-7; Virginia, *Acts* (Dunlap & Hayes, 1785) 8-9; North Carolina, *Laws* 1785, c. 24.

Exercising the power granted by Article 1, § 8 of the Constitution—"To promote the Progress of Science and useful Arts, by

securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries"—the first Congress enacted a copyright statute, the Act of May 31, 1790, 1 Stat. 124. As might have been expected, this Act reflected its historical antecedents. The author was given the copyright for fourteen years and "if, at the expiration of the said term, the author or authors, or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years". 1 Stat. 124. In view of the language and history of this provision, there can be no doubt that if the present case had arisen under the Act of 1790, there would be no statutory restriction upon the assignability of the author's renewal interest. The petitioners contend, however, that such a limitation was introduced by subsequent legislation, particularly the Copyright Acts of 1831 and 1909.

The Act of February 3, 1831, 4 Stat. 436, amended the 1790 Act in two important respects: the original term was increased from fourteen to twenty-eight years, and the renewal term, although still only fourteen years long, could pass to the author's widow or children if he did not survive the original term. The renewal provision, like the Statute of Anne, did not refer to the author's "assigns". The purpose of these changes, as stated in the report of the Committee on the Judiciary of the House of Representatives was "chiefly to enlarge the period for the enjoyment of copy-right, and thereby to place authors in this country more nearly upon an equality with authors in other countries."

In the United States, by the existing laws, a copy-right is secured to the author, in the first instance, for fourteen years; and if, at the end of that period, he be living, then for fourteen years more; but, if he be not then living, the copy-right is determined, although, by the very event of the death of the author, his family stand in more need of the only means of subsistence ordinarily left to them." Register of Debates, vol. 7, appendix. CXIX.

Plainly, therefore, the Copyright Act of 1831 merely enlarged the benefits of the copyright; it extended the length of the original term and gave the author's widow and children that which theretofore they did not possess, namely, the right of renewal to

which the author would have been entitled if he had survived the original term. The petitioners attach much significance to a sentence appearing in the report of the committee: "The question is, whether the author or the bookseller should receive the reward." *Ibid.* The meaning of this sentence, read in its context, is quite clear. By providing that, if the author should not survive the original term, his renewal interest should, instead of falling into the public domain, pass to his widow and children, Congress was of course preferring the author to the bookseller. But neither expressly nor impliedly did the Act of 1831 impose any restraints upon the right of the author himself to assign his contingent interest in the renewal. That the Act contained no such limitation was accepted without question both by the courts, see *Pierpont v. Fowle*, 19 Fed. Cas. 652 (C. C. Mass. 1846), and *Paige v. Banks*, 13 Wall. 608, with which compare *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247, 250-53, and by commentators, see Curtis on Copyright (1847) 235; 2 Morgan, Law of Literature (1875) 229-30; Spalding, Law of Copyright (1878) 111; Drone on Copyright (1879) 326-32; Bowker on Copyright (1886) 20, 34; 2 Kent's Commentaries (12th ed. 1873) 510; Solberg, Copyright Protection and Statutory Formalities (1904) 24. Representative Ellsworth,⁴ who submitted the committee report on the bill that became the Copyright Act of 1831, himself stated unequivocally that an agreement to assign the renewal was binding upon the author. See Ellsworth, Copy-Right Manual (1862) 29.

We come, finally, to the Copyright Act of March 4, 1909, 35 Stat. 1075, which, except for some minor amendments not relevant here, is the statute in effect at the present time. In December, 1905, President Theodore Roosevelt urged the Congress to undertake a revision of the copyright laws. H. Doc. 1, 58th Cong., 1st Sess., p. LI. In response to this message the Librarian of Congress, under whose authority the Copyright Office functions, invited persons interested in copyright legislation to attend a conference for the purpose of devising a satisfactory measure. Several conferences were held in 1905 and 1906, resulting in a bill which was introduced in the House and Senate by the chairman of the Committee on Patents in each body. This bill (H. R. 19853 and S. 6330, 59th Cong., 1st Sess.) provided, in the case of books and musical compositions, for

⁴ William Wolcott Ellsworth, the son of Oliver Ellsworth, third Chief Justice of the United States. See Biographical Directory of the American Congress, 1774-1927 (1928) 943.

a single copyright term lasting for the life of the author and for fifty years thereafter. Joint hearings by the House and Senate Committees were held on this bill, but no action was taken by the Fifty-ninth Congress. At the next session of Congress this and other bills to revise the copyright laws were again introduced. Extensive public hearings were held. The result of this elaborate legislative consideration of the problem of copyright was a bill (H. R. 28192; S. 9440) which became the Copyright Act of 1909. As stated in the report of the House committee, this bill "differs in many respects from any of the bills previously introduced. Your committee believes that in all its essential features it fairly meets and solves the difficult problems with which the committee had to deal."

H. Rep. 2222, 60th Cong., 2d Sess., p. 4. Under the bill copyright was given for twenty-eight years, with a renewal period of the same duration. The report of the House committee indicates the reasons for this provision. This section of the report, to which much importance has been attached by the judges of the court below and by the parties, must be read in the light of the specific problem with which the Congress was presented: should there be one long term, as was provided for in the bill resulting from the conferences held by the Librarian of Congress, or should there be two shorter terms? The House and Senate committees chose the latter alternative. They were aware that an assignment by the author of his "copyright" in general terms did not include conveyance of his renewal interest. See *Pierpont v. Fowle*, 19 Fed. Cas. 652 (C. C. Mass. 1846); 2 Morgan, *Law of Literature* (1875) 229-30; Macgillivray, *Law of Copyright* (1902) 267. During the hearings of the Joint Committee, Representative Currier, the chairman of the House committee, referred to the difficulties encountered by Mark Twain:

"Mr. Clemens told me that he sold the copyright for *Innocents Abroad* for a very small sum, and he got very little out of the *Innocents Abroad* until the twenty-eight year period expired, and then his contract did not cover the renewal period, and in the fourteen years of the renewal period he was able to get out of it all of the profits." (Hearings before the Committees on Patents of the Senate and House of Representatives on Pending Bills to Amend and Consolidate the Acts respecting Copyright, 60th Cong., 1st Sess., p. 20.)

By providing for two copyright terms, each of relatively short duration, Congress enabled the author to sell his "copyright"

without losing his renewal interest. If the author's copyright extended over a single, longer term, his sale of the "copyright" would terminate his entire interest. That this is the basic consideration of policy underlying the renewal provision of the Copyright Act of 1909 clearly appears from the report of the House committee which submitted the legislation (the Senate committee adopted the report of the House committee, see Sen. Rep. 1108, 60th Cong., 2d Sess.):

"Section 23 deals with the term of the copyright. Under existing law the copyright term is twenty-eight years, with the right of renewal by the author, or by the author's widow or children if he be dead, for a further term of fourteen years. The act of 1790 provided for an original term of fourteen years, with the right of renewal for fourteen years. The act of 1831 extended the term to its present length. It was urged before the committee that it would be better to have a single term without any right of renewal, and a term of life and fifty years was suggested. Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law [*italics ours*], so that he could not be deprived of that right.

"The present term of twenty-eight years, with the right of renewal for fourteen years, in many cases is insufficient. The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period that there would be no probability of its being taken away from him in his old age, when, perhaps, he needs it the most. A very small percentage of the copyrights are ever renewed. All use of them ceases in most cases long before the expiration of twenty-eight years. In the comparatively few cases where the work survives the original term the author ought to be given an adequate renewal term. In the exceptional case of a brilliant work of literature, art, or musical composition it continues to have a value for a long period, but this value is dependent upon the merit of the composition. Just in proportion as the composition is meritorious and deserving will it continue to be profitable, provided the copyright is extended so long; and it is believed that in all such cases where the merit is very high this term is certainly not too long.

"Your committee do not favor and the bill does not provide for any extension of the original term of twenty-eight years, but it does provide for an extension of the renewal term from fourteen

years to twenty-eight years; and it makes some change in existing law as to those who may apply for the renewal. Instead of confining the right of renewal to the author, if still living, or to the widow or children of the author, if he be dead, we provide that the author of such work, if still living, may apply for the renewal, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or, in the absence of a will, his next of kin. It was not the intention to permit the administrator to apply for the renewal, but to permit the author who had no wife or children to bequeath by will the right to apply for the renewal." (H. Rep. 2222, 60th Cong., 2d Sess., pp. 14-15.)

The report cannot be tortured, by reading it without regard to the circumstances in which it was written, into an expression of a legislative purpose to nullify agreements by authors to assign their renewal interests. If Congress, speaking through its responsible members, had any intention of altering what theretofore had not been questioned, namely, that there were no statutory restraints upon the assignment by authors of their renewal rights, it is almost certain that such purpose would have been manifested. The legislative materials reveal no such intention.

We agree with the court below, therefore, that neither the language nor the history of the Copyright Act of 1909 lend support to the conclusion that the "existing law" prior to 1909, under which authors were free to assign their renewal interests if they were so disposed, was intended to be altered. We agree, also, that there are no compelling considerations of policy which could justify reading into the Act a construction so at variance with its history. The policy of the copyright law, we are told, is to protect the author—if need be, from himself—and a construction under which the author is powerless to assign his renewal interest furthers this policy. We are asked to recognize that authors are congenitally irresponsible, that frequently they are so sorely pressed for funds that they are willing to sell their work for a mere pittance, and therefore assignments made by them should not be upheld. It is important that we distinguish between two problems implied in these situations: whether, despite the contrary direction given to this legislation by the momentum of history, we are to impute to Congress the enactment of an absolute statutory bar against assignments of authors' renewal interests, and secondly, whether, although there be no such statutory bar, a particular assignment should be denied enforcement by the courts because it was

made under oppressive circumstances. The first question alone is presented here, and we make no intimations upon the other. It is one thing to hold that the courts should not make themselves instruments of injustice by lending their aid to the enforcement of an agreement where the author was under such coercion of circumstances that enforcement would be unconscionable. Cf. *Union Pacific R. Co. v. Public Service Comm'n.*, 248 U. S. 67, 70; *Loneragan v. Buford*, 148 U. S. 581, 589-91; *Snyder v. Rosenbaum*, 215 U. S. 261, 265-66; *Post v. Jones*, 19 How. 150, 160; *The Elfrida*, 172 U. S. 186, 193-94. It is quite another matter to hold, as we are asked in this case, that regardless of the circumstances surrounding a particular assignment, no agreements by authors to assign their renewal interests are binding.

It is not for courts to judge whether the interests of authors clearly lie upon one side of this question rather than the other. If an author cannot make an effective assignment of his renewal, it may be worthless to him when he is most in need. Nobody would pay an author for something he cannot sell. We cannot draw a principle of law from the familiar stories of garret poverty of some men of literary genius. Even if we could do so, we cannot say that such men would regard with favor a rule of law preventing them from realizing on their assets when they are most in need of funds. Nor can we be unmindful of the fact that authors have themselves devised means of safeguarding their interests. We do not have such assured knowledge about authorship, and particularly about song writing, or the psychology of gifted writers and composers, as to justify us as judges in importing into Congressional legislation a denial to authors of the freedom to dispose of their property possessed by others. While authors may have habits making for intermittent want, they may have no less a spirit of independence which would resent treatment of them as wards under guardianship of the law.

We conclude, therefore, that the Copyright Act of 1909 does not nullify agreements by authors to assign their renewal interests. We are fortified in this conclusion by reference to the actual practices of authors and publishers with respect to assignments of renewals, as disclosed by the records of the Copyright Office. Since the enactment of the Copyright Act of 1870, 16 Stat. 198, 213, assignments of copyrights must be recorded in the office of the Register of Copyrights. The records of the Copy-

right Office, we are advised, show that during the period from July, 1870, to July, 1871, the first period in which assignments were recorded in the Office, 223 assignments were registered. Of these 14 were assignments of renewal interests. Similarly, during the first six months of 1909, immediately preceding the enactment of the Copyright Act of that year, 304 assignments were recorded, and of these 62 were assignments of renewal interests. In the six-month period following the enactment of the Copyright Act of 1909, there was no significant change: 404 assignments, of which 68 were transfers of renewals. And, to round out the picture, in the most recent complete volume of records (covering the period from January 27, 1943, to February 12, 1943), 135 assignments were recorded, and of these 29 were assignments of renewals. Many assignments have thus been entered into in good faith upon the assumption that they were valid and enforceable.

In addition to all other books and pamphlets relevant to our problem, we have consulted all of the twenty treatises on the American law of copyright available at the Library of Congress. Eight of these state, without qualification, that an author can effectively agree to assign his renewal interest before it has been secured;⁵ two state the rule with some reservations;⁶ ten are either silent or ambiguous.⁷ And the forms of assignment of copyright in treatises and standard form-books generally contain a provision designed to transfer the renewal interest.⁸

⁵ Curtis on Copyright (1847) 235; Drone on Copyright (1879) 226-32; Howell, Copyright Law (1942) 108; 2 Morgan, Law of Literature (1873) 229-30; Spalding, Law of Copyright (1878) 111; Macgillivray, Law of Copyright (1902) 266-67; Wittenberg, Protection and Marketing of Literary Property (1937) 45; Ladas, International Protection of Literary and Artistic Property (1938) 772-73.

⁶ DeWolf, Outline of Copyright Law (1925) 65-66; Weil, American Copyright Law (1917) 365-66.

⁷ Amdur, Copyright Law and Practice (1936) 540-41; Frohlich and Schwartz, Law of Motion Pictures (1918) 548-49; Marchetti, Law of Stage, Screen, and Radio (1936) 67; Bowker, Copyright—Its History and Its Law (1912) 117, 438; Bump, Law of Patents, Trade-marks, Labels, and Copyrights (2d ed. 1884); Elfreth, Patents, Copyrights, and Trade-marks (1913); Graham, Patents, Trade-marks and Copyrights (2d ed. 1921); Law, Copyright and Patent Laws of the United States, 1780-1870 (3d ed. 1870); Copinger, Law of Copyright (7th ed. 1936); Shafter, Musical Copyright (2d ed. 1939) 174.

⁸ Wittenberg, Protection and Marketing of Literary Property (1937) 195, 261; Shafter, Musical Copyright (2d ed. 1939) 577; Gordon, Annotated Forms of Agreement (1923) 32; 6 Winslow, Forms of Pleading and Practice (3d ed. 1934) § 2267, pp. 501-02; Birdseye, Encyclopedia of General Business and Legal Forms (1924) 280-81; Amdur, Copyright Law and Practice (1936) 836; Church, Legal and Business Forms (2d ed. 1925) 344.

The available evidence indicates, therefore, that renewal interests of authors have been regarded as assignable both before and after the Copyright Act of 1909. To hold at this late date that, as a matter of law, such interests are not assignable would be to reject all relevant aids to construction.

Affirmed.

Mr. Justice RUTLEDGE took no part in the consideration or decision of this case.

Mr. Justice BLACK, Mr. Justice DOUGLAS, and Mr. Justice MURPHY conclude that the analysis of the language and history of the copyright law in the dissenting opinion of Judge Frank in the court below, 125 F. 2d 949, 954, demonstrates a Congressional purpose to reserve the renewal privilege for the personal benefit of authors and their families. They believe the judgment below should be reversed.